

ESTTA Tracking number: **ESTTA410175**Filing date: **05/20/2011**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92049926
Party	Plaintiff Penthouse Digital Media Productions Inc.
Correspondence Address	FLOYD A. MANDELL ESQ KATTEN MUCHIN ROSENMAN LLP 525 W. MONROE ST CHICAGO, IL 60661 UNITED STATES floyd.mandell@kattenlaw.com, kristin.holland@kattenlaw.com, cathay.smith@kattenlaw.com
Submission	Other Motions/Papers
Filer's Name	Becky A. Williams
Filer's e-mail	becky.williams@kattenlaw.com, dana.thompson@kattenlaw.com, kristin.holland@kattenlaw.com, cathay.smith@kattenlaw.com, floyd.mandell@kattenlaw.com
Signature	/baw/
Date	05/20/2011
Attachments	Motion to Compel Depositions.pdf (8 pages)(312103 bytes) Certificate of Service.pdf (1 page)(32630 bytes) Exhibit A.pdf (6 pages)(179380 bytes) Exhibit B.pdf (4 pages)(83960 bytes) Exhibit C.pdf (16 pages)(411651 bytes) Exhibit D.pdf (54 pages)(2698600 bytes) Exhibit E.pdf (6 pages)(177136 bytes) Exhibit F.pdf (7 pages)(218717 bytes) Exhibit G.pdf (4 pages)(75052 bytes) Exhibit H.pdf (56 pages)(4734486 bytes) Exhibit I.pdf (7 pages)(239329 bytes)

seven hours of testimony. Petitioner requests that Mr. Hallam be compelled to appear for deposition on June 1, 2 or 3 for up to seven hours of testimony.

II. Summary of Relevant Facts and Law

A. Registrant's Failure to Comply with the 30(b)6 Discovery Deposition Notice

Petitioner noticed the deposition of Registrant Cloudstreet, Inc. dba Roxbury Entertainment ("Registrant") for April 25, 2011 at 10:00 a.m. A request for production was included with the notice of deposition. (Declaration of Kristin L. Holland ("Holland Decl."), Exhibit A.)

Registrant failed to designate a person or persons pursuant to Fed. R. Civ. P. 30(b)(6) and failed to appear for the duly noticed deposition. Registrant also failed to respond to the document requests or produce documents as requested in the deposition notice. (Holland Decl. ¶¶ 4-6, Exh. C.) Additionally, Registrant failed to serve any formal objections to the duly noticed deposition.

On May 10, 2011, counsel for Petitioner, Kristin L. Holland, met and conferred by telephone with counsel for Registrant, Kirk M. Hallam, in an effort to resolve these issues. Mr. Hallam was not willing to provide an unconditional date certain for deposition, nor did he agree to provide any documents. The parties exchanged some emails on these issues, but unfortunately, the meet and confer was unsuccessful. (Holland Decl. ¶ 7.)

Mr. Hallam contends that discovery is closed in this case based on a stipulation of counsel. (Holland Decl. ¶ 8.) There is no such written stipulation on file, nor has any been provided by Mr. Hallam despite Petitioner's numerous requests that he do so. (Holland Decl. ¶ 8.) Although the parties originally discussed limitations on duplicative discovery and, early in this case, Petitioner's counsel hoped that no discovery in this matter would be necessary because

extensive discovery had been conducted in the district court action, due to changes in the operative petition and the fact that certain issues were not covered by discovery in the district court action, Petitioner does require discovery in this proceeding. (Holland Decl. ¶ 8.) The issue regarding Petitioner's need for discovery, especially with respect to Mr. Hallam's deposition, has already been extensively briefed in this matter. (Holland Decl. ¶ 8; Exh. D.)

Indeed, at the same time that Registrant is opposing its own deposition, Registrant is seeking extensive discovery from Petitioner, including the 30(b)6 deposition of Petitioner, document demands and the deposition of several of Petitioner's counsel, including its in-house counsel Larry Sutter. (Holland Decl. ¶ 9, Exh. E and F.) Petitioner has served objections to the improper 30(b)6 notice and met and conferred so that Registrant could cure the various defects in the notice, but those attempts have been unsuccessful. (Holland Decl. Exh. G.)

Further belying Registrant's claim that no discovery is allowed, Registrant has asked questions at a discovery deposition of Paul Supnik, a witness subpoenaed by Petitioner. (Holland Decl. ¶ 10, Exh. H.) Although Petitioner has proposed a stipulation simplifying discovery in this case and to allow discovery from the district court matter to be used in this proceeding, to date, Registrant refused to sign the stipulation. (Holland Decl. ¶ 11, Exh. I.)

Petitioner now files this motion, pursuant to 37 CFR § 2.120(e) and TBMP 523.01(1) in order to compel Registrant's designation and attendance at a deposition and to compel the production of documents. Petitioner requests that Registrant be compelled to designate a representative or representatives and appear for deposition at the offices of Katten Muchin Rosenman, LLP, 2029 Century Park East, Suite 2600, Los Angeles, CA 90067 on June 1, 2 or 3, 2011 at 10:00 a.m. Petitioner requests that Registrant be compelled to produce documents on May 31, 2011.

Discovery closes on June 10, 2011. Petitioner requests an expedient ruling so that the trial deadlines are not impacted by Registrant's blatant failure to comply with discovery.

B. Kirk M. Hallam's Failure, as Registrant's Officer and Counsel of Record, to Appear for Deposition

Petitioner noticed the deposition of Registrant's officer, Kirk M. Hallam, for April 26, 2011 at 10:00 a.m. (Holland Dec., Exh. B.) Mr. Hallam did not appear, nor did he serve any formal objections to the duly noticed deposition. (Holland Decl. ¶¶ 5-6, Exh. C.) Mr. Hallam is Registrant's officer, its counsel of record in this case and likely to be Registrant's 30(b)6 designee. He is a key witness for Petitioner and his failure to make himself available for a discovery deposition in this proceeding is prejudicial to Petitioner's case. (Holland Decl. ¶ 5.)

For the same reasons identified in Section II. A. above, Petitioner now moves to compel Mr. Hallam's attendance at deposition. Petitioner requests that Mr. Hallam be compelled to appear for deposition at the offices of Katten Muchin Rosenman, LLP, 2029 Century Park East, Suite 2600, Los Angeles, CA 90067 on June 1, 2 or 3, 2011 at 10:00 a.m.

III. Conclusion.

Registrant and Registrant's officer, Kirk M. Hallam, should both be compelled to appear for deposition immediately. Petitioner is in need of this discovery and it would be prejudicial not to allow this discovery to be completed. As counsel of record in this case, Mr. Hallam is well aware of his client's and his own discovery obligations. His refusal to appear for any deposition

and refusal to produce any documents are particularly egregious given his dual role and the upcoming deadlines in this case.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'K. Holland', written over a horizontal line.

Kristin L. Holland
KATTEN MUCHIN ROSENMAN LLP
2029 Century Park East, Suite 2600
Los Angeles, CA 90067-3012
Telephone: (310) 788-4400
Facsimile: (310) 788-4471

Dated: May 20, 2011

DECLARATION OF KRISTIN L. HOLLAND

1. I am a partner with the law firm of Katten Muchin Rosenman LLP and am one of the attorneys for Petitioner Penthouse Digital Media Productions, Inc. ("Petitioner") in this proceeding. I make the statements in this declaration of my own personal knowledge.

2. Petitioner noticed the deposition of Registrant Cloudstreet, Inc. dba Roxbury Entertainment ("Registrant") for April 25, 2011 at 10:00 a.m. A request for production was included with the notice of deposition. A true and correct copy of the deposition notice for Registrant is attached hereto as Exhibit A.

3. Petitioner noticed the deposition of Registrant's officer, Kirk M. Hallam, for April 26, 2011 at 10:00 a.m. A true and correct copy of the deposition notice for Mr. Hallam is attached hereto as Exhibit B.

4. Registrant failed to designate a person pursuant to Fed. R. Civ. P. 30(b)(6) and failed to attend the discovery deposition. Registrant also failed to respond to the document requests or produce documents as requested in the deposition notice. Additionally, Registrant failed to serve any formal objections to the duly noticed deposition.

5. Mr. Hallam failed to appear for deposition as noticed. In addition, Mr. Hallam failed to serve any formal objections to the duly noticed deposition. Mr. Hallam is Registrant's officer, its counsel of record in this case, and likely to be Registrant's 30(b)(6) designee. He is a key witness for Petitioner and his failure to make himself available for a discovery deposition is prejudicial to Petitioner's case.

6. On April 26, 2011, Petitioner made a record of Mr. Hallam's failure to appear and noted that Registrant had also failed to appear or produce documents. A true and correct copy of the transcript of the non-appearance statement is attached hereto as Exhibit C.

7. On May 10, 2011, I met and conferred by telephone with Mr. Hallam, who is also counsel for Registrant, in an effort to resolve these issues. Mr. Hallam was not willing to provide an unconditional date certain for deposition, nor did he agree to provide any documents in response to the document demands to Registrant. Unfortunately, the meet and confer was unsuccessful.

8. Mr. Hallam contends that discovery is closed in this case based on a stipulation of counsel. I am not aware of any such written stipulation on file, nor has any been provided by Mr. Hallam despite my numerous requests that he do so. Although the parties originally discussed limitations on duplicative discovery and, early in this case, Petitioner's counsel hoped that no discovery in this matter would be necessary, due to changes in the operative pleadings and the fact that certain issues were not covered by discovery in the district court action, Petitioner does require discovery in this proceeding. Docket #15 in this proceeding entitled "P's Motion to Reopen Discovery" details the status of discovery in the district court action, previous motions to compel related to Mr. Hallam's refusal to testify and/or answer pertinent questions in that proceeding and the reasons that discovery is necessary in this proceeding, at least with respect to issues Mr. Hallam improperly supported by declaration after the close of discovery in the district court matter and new issues raised in this case. A true and correct copy of Docket #15 is attached hereto as Exhibit D.

9. At the same time Registrant is denying Petitioner's right to take discovery, Registrant is simultaneously seeking extensive discovery from Petitioner, including the 30(b)6

deposition of Petitioner, document demands and the deposition of Petitioner's in-house counsel, Larry Sutter. True and correct copies of the 30(b)6 notice, objections by Registrant to that notice, and the notice of the deposition of Mr. Sutter are attached hereto as Exhibits E, F and G respectively.

10. Also belying its contention that no discovery is available in this matter, Registrant participated in the deposition of Paul Supnik, a witness subpoenaed by Petitioner. Mr. Hallam asked questions at Mr. Supnik's deposition. A copy of Mr. Supnik's deposition transcript showing Mr. Hallam's participation and questioning is attached hereto as Exhibit H.

11. Petitioner has circulated a proposed stipulation simplifying discovery in this case and allowing discovery from a related District Court matter to be used in this proceeding. However, to date, Registrant failed to sign the stipulation. A copy of the email to Mr. Hallam with the proposed stipulation is attached hereto as Exhibit I.

I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct. Executed this 20th day of May, 2011 at Los Angeles, California.

A handwritten signature in black ink, appearing to read 'Kristin L. Holland', written over a horizontal line.

Kristin L. Holland

CERTIFICATE OF SERVICE

I hereby certify that on May 20, 2011 I served the foregoing document described as **MOTION TO COMPEL THE DEPOSITIONS OF (1) REGISTRANT CLOUDSTREET, INC. D.B.A. ROXBURY ENTERTAINMENT AND (2) REGISTRANT'S OFFICER, KIRK M. HALLAM; DECLARATION OF KRISTIN L. HOLLAND IN SUPPORT THEREOF** on the interested parties in this action .by placing the document listed above in sealed envelopes with postage thereon fully prepaid, in the United States mail at Los Angeles, California addressed as set forth below.

Kirk M. Hallam, Esq.
Law Offices of Kirk M. Hallam
201 Wilshire Boulevard, 2nd Floor
Santa Monica, CA 90401-1219
Tel. (310) 393-4006
Fax (310) 393-4662
Email kmhallam@aol.com

Paul D. Supnik, Esq.
Law Office of Paul D. Supnik
9401 Wilshire Boulevard, Suite 1250
Beverly Hills, CA 90212-2945
Tel. (310) 859-0100
Fax (310) 388-5645
Email pds@supnik.com

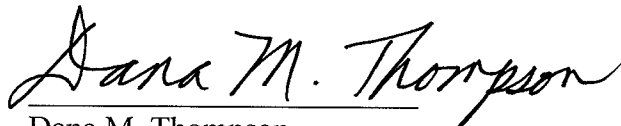

Dana M. Thompson

EXHIBIT A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

PENTHOUSE DIGITAL MEDIA
PRODUCTIONS INC.,

Petitioner,

v.

CLOUDSTREET, INC.
d/b/a ROXBURY ENTERTAINMENT,

Registrant.

Cancellation No. 92049926

**NOTICE OF DEPOSITION OF CLOUDSTREET, INC.
dba ROXBURY ENTERTAINMENT**

TO: Mr. Paul D. Supnik
9401 Wilshire Boulevard, Suite 1250
Beverly Hills, CA 90212

Mr. Kirk M. Hallam
201 Wilshire Blvd, 2nd Floor
Santa Monica, CA 90401

PLEASE TAKE NOTICE that pursuant to Rule 30(b)(6) of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice, Petitioner Penthouse Digital Media Productions Inc. ("Petitioner"), by its attorneys, will take the deposition upon oral examination of Registrant Cloudstreet, Inc. dba Roxbury Entertainment ("Registrant"), who shall designate one or more representatives to testify on its behalf in regard to the following subject areas that are known or reasonably available to Registrant. The deposition will commence on April 25, 2011 at 10:00 a.m. and, if necessary, will continue from day-to-day thereafter until completed or adjourned. The deposition will be taken at the offices of Katten Muchin Rosenman LLP, 2029 Century Park East, Suite 2900, Los Angeles, CA 90067. The deposition will be conducted before a certified court reporter and may be recorded by sound, sound-and-visual, videotape and/or stenographic means. The deposition may be used for all purposes contemplated under the Federal Rules of Civil Procedure and U.S. Trademark Rules.

SUBJECT AREAS OF TESTIMONY

1. Trademark Application Serial Nos. 78977114, 78977115, and 78664154 filed on behalf of Cloudstreet, Inc. dba Roxbury Entertainment (the "Registrant") in the U.S. Patent and Trademark Office ("USPTO").

2. The Office Action issued by the USPTO on May 18, 2006 relating to Application Serial No. 78664154 (now Registration No. 3291736).

3. The Statement of Use filed on May 22, 2007 relating to Application Serial No. 78664154 (now Registration No. 3291736).

4. The Amendment to Allege Use filed on July 14, 2006 relating to Application Serial No. 78977114 (now Registration No. 3189543).

5. The use-based application filed on July 6, 2005 relating to Application Serial No. 78977115 (now Registration No. 3194255).

6. Registrant's use, as of May 22, 2007, of the ROUTE 66 mark in commerce on or in connection with a "motion picture film series."

7. Registrant's production of a ROUTE 66 "motion picture film series."

8. Registrant's use, as of July 14, 2006, of the ROUTE 66 mark in commerce on or in connection with "pre-recorded DVD's and videocassettes featuring drama, action and adventure."

9. Registrant's use, as of July 6, 2005, of the ROUTE 66 mark in commerce on or in connection with an "on-going television program."

10. Registrant's use, as of July 6, 2005, of the ROUTE 66 mark in commerce on or in connection with "television production services."

11. "ROUTE 66" DVDs.

12. "ROUTE 66" videocassettes.

13. "ROUTE 66" television series.

14. "ROUTE 66" film and/or movie and/or film series.

15. "ROUTE 66" trademark assignments and/or transfers.

16. Third-party uses of "Route 66."

17. Any facts and documents supporting any declarations by an officer and/or managing agent of Registrant filed in *Roxbury Entertainment v. Penthouse Media Group, Inc. et al.*, 2:08-cv-3872, in the Central District of California, including any declarations by Kirk M. Hallam.


**PETITIONER'S REQUEST FOR PRODUCTION OF DOCUMENTS PURSUANT TO
RULE 34 OF THE FEDERAL RULES OF CIVIL PROCEDURE**

In accordance with Rule 34 of the Federal Rules of Civil Procedure, Petitioner requests that Registrant produce any and all Documents which relate or refer to each of the fourteen (14) categories set forth above at above noticed deposition, to the extent such documents have not already been produced in the related civil action between the parties, *Roxbury Entertainment v. Penthouse Media Group Inc. et al.*, Case No. CV 08-03872, in the Central District of California.

As used herein, "Document" and "Documents" shall mean and include all written, recorded, or graphic matters, however produced or reproduced, whether or not privileged, pertaining in any way to the subject matter of this action, including but not limited to all those documents within the scope of the term "documents" under Rule 1001 of the Federal Rules of Evidence. This definition includes, but is not limited to, any and all originals, copies, or drafts of any and all of the following: records; notes; summaries; contracts or agreements; drawings; sketches; invoices, orders or acknowledgments; labels, tags, advertising and promotional materials, CAD images; diaries, reports, forecasts or appraisals; memoranda or telephone or in-person conversations by or with any person, or any other memoranda; letters, telegrams, telexes, or cables prepared, drafted, received or sent; tapes, transcripts or recordings; electronic data; photographs, pictures or films; computer programs or data or other graphic symbolic, recorded or written materials of any nature whatsoever. Without limiting the scope of the definition of "Document", "Document" includes, without limitation, labels, tags, and samples of products. Any document which contains any comments, notation, addition, insertion or marking of any kind which is not part of another document or document which does not contain any comment, notation, addition, insertion, or marking of any kind which is part of another document, is to be considered a separate document.

Dated: March 23, 2011

Petitioner Penthouse Digital Media Productions Inc.

By: 
One of its attorneys

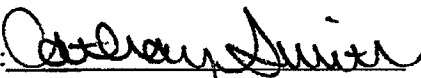
Floyd A. Mandell
Cathay Y. N. Smith
KATTEN MUCHIN ROSENMAN LLP
525 West Monroe Street
Chicago, Illinois 60661
(312) 902-5200

Kristin L. Holland
KATTEN MUCHIN ROSENMAN LLP
2029 Century Park East, Suite 2600
Los Angeles, California
(310) 788-4400

EXHIBIT B

Dated: March 23, 2011

Petitioner Penthouse Digital Media Productions Inc.

By: 
One of its attorneys

Floyd A. Mandell
Cathay Y. N. Smith
KATTEN MUCHIN ROSENMAN LLP
525 West Monroe Street
Chicago, Illinois 60661
(312) 902-5200

Kristin L. Holland
KATTEN MUCHIN ROSENMAN LLP
2029 Century Park East, Suite 2600
Los Angeles, California
(310) 788-4400

EXHIBIT C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

PENTHOUSE DIGITAL MEDIA
PRODUCTIONS, INC.,

Petitioner,

VS.

CLOUDSTREET, INC. d/b/a ROXBURY
ENTERTAINMENT,

Registrant.

ORIGINAL

CANCELLATION NO.

92049926

STATEMENT OF COUNSEL

RE DEPOSITION OF

KIRK M. HALLAM

PAGES 1 - 5

STATEMENT OF COUNSEL RE
DEPOSITION OF KIRK M. HALLAM

TAKEN ON

TUESDAY, APRIL 26, 2011

REPORTED BY: KIMBERLY WILDISH

CSR NO. 8078

1 STATEMENT OF COUNSEL RE DEPOSITION OF KIRK M.
2 HALLAM, TAKEN ON BEHALF OF THE PETITIONER, AT 2029
3 CENTURY PARK EAST, SUITE 2600, LOS ANGELES, CALIFORNIA,
4 90067, AT 10:00 A.M. ON TUESDAY, APRIL 26, 2011,
5 BEFORE KIMBERLY WILDISH, CSR NO. 8078, PURSUANT TO
6 NOTICE.

7

8 APPEARANCES:

9

10

11 FOR THE PETITIONER:

12 KATTEN, MUCHIN, ROSENMAN, LLP
13 BY: KRISTIN L. HOLLAND, ESQ.
14 2029 CENTURY PARK EAST
15 SUITE 2600
16 LOS ANGELES, CALIFORNIA 90067
17 310.788.4400

18

19

20

21

22 FOR THE REGISTRANT:

23

24 ROXBURY ENTERTAINMENT
25 BY: KIRK M. HALLAM, ESQ.
 201 WILSHIRE BOULEVARD
 SECOND FLOOR
 SANTA MONICA, CALIFORNIA 90401
 310.393.4006
 (NOT PRESENT)

26

27

28

1 LOS ANGELES, CALIFORNIA; TUESDAY, APRIL 26, 2011

2 10:00 A.M.

3
4
5 S T A T E M E N T O F C O U N S E L
6
7

8 MS. HOLLAND: Let's go on the record.

9 All right. My name is Kristin
10 Holland, and I am counsel for Petitioner, Penthouse
11 Digital Media Productions, Inc., in the Cancellation
12 Proceeding 92049926.

13 I am appearing today in order to take
14 the deposition of Kirk M. Hallam, pursuant to what
15 we've marked as Exhibit 14, the Notice of Deposition
16 of Kirk M. Hallam.

17 (THE DOCUMENT REFERRED TO WAS
18 MARKED AS EXHIBIT 14 AND IS
19 ATTACHED HERETO)

20 MS. HOLLAND: This deposition was scheduled to
21 commence today at 10:00 A.M. in my offices.

22 Mr. Hallam is not present, and has
23 indicated via e-mail that he does not plan to appear,
24 even though last week, during the deposition of
25 Mr. Supnik, he was agreeable to appearing for at

1 least one day of the two days noticed.

2 Exhibit 14 was served on Paul Supnik
3 and Mr. Hallam on March 23rd, 2011.

4 We have received no formal written
5 objections, nor have we been served with a motion for
6 protective order, or any other motion for relief from
7 the obligation to appear at deposition today.

8 I've also marked as Exhibit 15 the
9 Notice of Deposition of Cloudstreet, Inc., dba
10 Roxbury Entertainment.

11 This notice included subject areas of
12 testimony, Numbers 1 through 17, and also a request
13 for production of documents.

14 (THE DOCUMENT REFERRED TO WAS
15 MARKED AS EXHIBIT 15 AND IS
16 ATTACHED HERETO)

17 MS. HOLLAND: We have received no documents,
18 nor has anyone appeared for deposition on behalf of
19 Cloudstreet, Inc., dba Roxbury Entertainment.

20 Exhibit 15 was served on Mr. Supnik
21 and Mr. Hallam on March 23rd, 2011, and no one has
22 appeared for deposition as of today, April 26th.

23 This concludes my statement.

24 (AT 10:03 A.M. THE
25 STATEMENT WAS CONCLUDED)


1 I, KIMBERLY WILDISH, CSR NO. 8078, A
2 CERTIFIED SHORTHAND REPORTER FOR THE STATE OF
3 CALIFORNIA DO HEREBY CERTIFY:

4 THAT SAID STATEMENT OF COUNSEL WAS TAKEN
5 BEFORE ME AT THE TIME AND PLACE THEREIN SET FORTH,
6 AND WAS TAKEN DOWN BY ME IN SHORTHAND, AND WAS
7 THEREAFTER REDUCED TO TYPEWRITING VIA COMPUTER-AIDED
8 TRANSCRIPTION UNDER MY DIRECTION;

9 I FURTHER CERTIFY THAT I AM NEITHER COUNSEL
10 FOR, NOR RELATED TO, ANY PARTY TO SAID ACTION, NOR IN
11 ANYWISE INTERESTED IN THE OUTCOME THEREOF;

12 IN WITNESS WHEREOF, I HAVE HEREUNTO
13 SUBSCRIBED MY NAME THIS 26TH DAY OF APRIL, 2011.

14
15
16
17
18
19
20
21
22
23
24
25


KIMBERLY WILDISH
CSR NO. 8078

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

PENTHOUSE DIGITAL MEDIA
PRODUCTIONS INC.,

Petitioner,

v.

CLOUDSTREET, INC.
d/b/a ROXBURY ENTERTAINMENT,

Registrant.

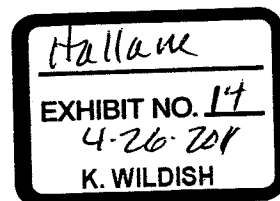
Cancellation No. 92049926

NOTICE OF DEPOSITION OF KIRK M. HALLAM

TO: Mr. Paul D. Supnik
9401 Wilshire Boulevard, Suite 1250
Beverly Hills, CA 90212

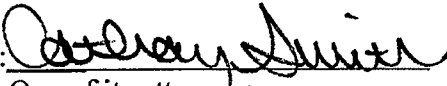
Mr. Kirk M. Hallam
201 Wilshire Blvd, 2nd Floor
Santa Monica, CA 90401

PLEASE TAKE NOTICE that pursuant to Rules 26, 30, and 37 of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice, Petitioner Penthouse Digital Media Productions Inc. ("Petitioner"), by its attorneys, will take the deposition upon oral examination of Mr. Kirk M. Hallam. The deposition will commence on April 26, 2011 at 10:00 a.m. and, if necessary, will continue from day-to-day thereafter until completed or adjourned. The deposition will be taken at the offices of Katten Muchin Rosenman LLP, 2029 Century Park East, Suite 2900, Los Angeles, CA 90067. The deposition will be conducted before a certified court reporter and may be recorded by sound, sound-and-visual, videotape and/or stenographic means. The deposition may be used for all purposes contemplated under the Federal Rules of Civil Procedure and U.S. Trademark Rules.



Dated: March 23, 2011

Petitioner Penthouse Digital Media Productions Inc.

By: 
One of its attorneys

Floyd A. Mandell
Cathay Y. N. Smith
KATTEN MUCHIN ROSENMAN LLP
525 West Monroe Street
Chicago, Illinois 60661
(312) 902-5200

Kristin L. Holland
KATTEN MUCHIN ROSENMAN LLP
2029 Century Park East, Suite 2600
Los Angeles, California
(310) 788-4400

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

PENTHOUSE DIGITAL MEDIA
PRODUCTIONS INC.,

Petitioner,

v.

CLOUDSTREET, INC.
d/b/a ROXBURY ENTERTAINMENT,

Registrant.

Cancellation No. 92049926

CERTIFICATE OF SERVICE

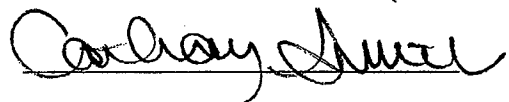
I hereby certify that on this 23rd day of March, 2011, I caused a true and correct copy of the foregoing to be served upon:

Mr. Paul D. Supnik
9401 Wilshire Boulevard, Suite 1250
Beverly Hills, CA 90212

via Hand Delivery and E-Mail, and

Mr. Kirk M. Hallam
201 Wilshire Blvd, 2nd Floor
Santa Monica, CA 90401

via First Class Mail and E-Mail.


Cathay Y. N. Smith

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

PENTHOUSE DIGITAL MEDIA
PRODUCTIONS INC.,

Petitioner,

v.

CLOUDSTREET, INC.
d/b/a ROXBURY ENTERTAINMENT,

Registrant.

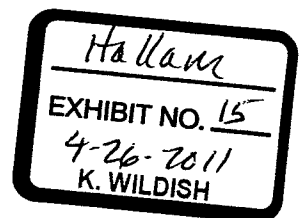
Cancellation No. 92049926

**NOTICE OF DEPOSITION OF CLOUDSTREET, INC.
dba ROXBURY ENTERTAINMENT**

TO: Mr. Paul D. Supnik
9401 Wilshire Boulevard, Suite 1250
Beverly Hills, CA 90212

Mr. Kirk M. Hallam
201 Wilshire Blvd, 2nd Floor
Santa Monica, CA 90401

PLEASE TAKE NOTICE that pursuant to Rule 30(b)(6) of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice, Petitioner Penthouse Digital Media Productions Inc. ("Petitioner"), by its attorneys, will take the deposition upon oral examination of Registrant Cloudstreet, Inc. dba Roxbury Entertainment ("Registrant"), who shall designate one or more representatives to testify on its behalf in regard to the following subject areas that are known or reasonably available to Registrant. The deposition will commence on April 25, 2011 at 10:00 a.m. and, if necessary, will continue from day-to-day thereafter until completed or adjourned. The deposition will be taken at the offices of Katten Muchin Rosenman LLP, 2029 Century Park East, Suite 2900, Los Angeles, CA 90067. The deposition will be conducted before a certified court reporter and may be recorded by sound, sound-and-visual, videotape and/or stenographic means. The deposition may be used for all purposes contemplated under the Federal Rules of Civil Procedure and U.S. Trademark Rules.



SUBJECT AREAS OF TESTIMONY

1. Trademark Application Serial Nos. 78977114, 78977115, and 78664154 filed on behalf of Cloudstreet, Inc. dba Roxbury Entertainment (the "Registrant") in the U.S. Patent and Trademark Office ("USPTO").
2. The Office Action issued by the USPTO on May 18, 2006 relating to Application Serial No. 78664154 (now Registration No. 3291736).
3. The Statement of Use filed on May 22, 2007 relating to Application Serial No. 78664154 (now Registration No. 3291736).
4. The Amendment to Allege Use filed on July 14, 2006 relating to Application Serial No. 78977114 (now Registration No. 3189543).
5. The use-based application filed on July 6, 2005 relating to Application Serial No. 78977115 (now Registration No. 3194255).
6. Registrant's use, as of May 22, 2007, of the ROUTE 66 mark in commerce on or in connection with a "motion picture film series."
7. Registrant's production of a ROUTE 66 "motion picture film series."
8. Registrant's use, as of July 14, 2006, of the ROUTE 66 mark in commerce on or in connection with "pre-recorded DVD's and videocassettes featuring drama, action and adventure."
9. Registrant's use, as of July 6, 2005, of the ROUTE 66 mark in commerce on or in connection with an "on-going television program."
10. Registrant's use, as of July 6, 2005, of the ROUTE 66 mark in commerce on or in connection with "television production services."
11. "ROUTE 66" DVDs.
12. "ROUTE 66" videocassettes.
13. "ROUTE 66" television series.
14. "ROUTE 66" film and/or movie and/or film series.
15. "ROUTE 66" trademark assignments and/or transfers.
16. Third-party uses of "Route 66."
17. Any facts and documents supporting any declarations by an officer and/or managing agent of Registrant filed in *Roxbury Entertainment v. Penthouse Media Group, Inc. et al.*, 2:08-cv-3872, in the Central District of California, including any declarations by Kirk M. Hallam.

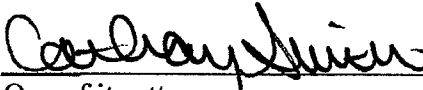
**PETITIONER'S REQUEST FOR PRODUCTION OF DOCUMENTS PURSUANT TO
RULE 34 OF THE FEDERAL RULES OF CIVIL PROCEDURE**

In accordance with Rule 34 of the Federal Rules of Civil Procedure, Petitioner requests that Registrant produce any and all Documents which relate or refer to each of the fourteen (14) categories set forth above at above noticed deposition, to the extent such documents have not already been produced in the related civil action between the parties, *Roxbury Entertainment v. Penthouse Media Group Inc. et al.*, Case No. CV 08-03872, in the Central District of California.

As used herein, "Document" and "Documents" shall mean and include all written, recorded, or graphic matters, however produced or reproduced, whether or not privileged, pertaining in any way to the subject matter of this action, including but not limited to all those documents within the scope of the term "documents" under Rule 1001 of the Federal Rules of Evidence. This definition includes, but is not limited to, any and all originals, copies, or drafts of any and all of the following: records; notes; summaries; contracts or agreements; drawings; sketches; invoices, orders or acknowledgments; labels, tags, advertising and promotional materials, CAD images; diaries, reports, forecasts or appraisals; memoranda or telephone or in-person conversations by or with any person, or any other memoranda; letters, telegrams, telexes, or cables prepared, drafted, received or sent; tapes, transcripts or recordings; electronic data; photographs, pictures or films; computer programs or data or other graphic symbolic, recorded or written materials of any nature whatsoever. Without limiting the scope of the definition of "Document", "Document" includes, without limitation, labels, tags, and samples of products. Any document which contains any comments, notation, addition, insertion or marking of any kind which is not part of another document or document which does not contain any comment, notation, addition, insertion, or marking of any kind which is part of another document, is to be considered a separate document.

Dated: March 23, 2011

Petitioner Penthouse Digital Media Productions Inc.

By: 
One of its attorneys

Floyd A. Mandell
Cathay Y. N. Smith
KATTEN MUCHIN ROSENMAN LLP
525 West Monroe Street
Chicago, Illinois 60661
(312) 902-5200

Kristin L. Holland
KATTEN MUCHIN ROSENMAN LLP
2029 Century Park East, Suite 2600
Los Angeles, California
(310) 788-4400

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

PENTHOUSE DIGITAL MEDIA
PRODUCTIONS INC.,

Petitioner,

v.

CLOUDSTREET, INC.
d/b/a ROXBURY ENTERTAINMENT,

Registrant.

)
)
)
)
)
)
)
)
)
)
)

Cancellation No. 92049926

CERTIFICATE OF SERVICE

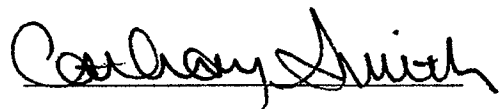
I hereby certify that on this 23rd day of March, 2011, I caused a true and correct copy of the foregoing to be served upon:

Mr. Paul D. Supnik
9401 Wilshire Boulevard, Suite 1250
Beverly Hills, CA 90212

via Hand Delivery and E-Mail, and

Mr. Kirk M. Hallam
201 Wilshire Blvd, 2nd Floor
Santa Monica, CA 90401

via First Class Mail and E-Mail.



Cathay Y. N. Smith

EXHIBIT D

ESTTA Tracking number: **ESTTA345006**

Filing date: **04/30/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92049926
Party	Plaintiff Penthouse Digital Media Productions Inc.
Correspondence Address	Floyd A. Mandell, Esq. Katten Muchin Rosenman LLP 525 W. Monroe St. Chicago, IL 60661 UNITED STATES floyd.mandell@kattenlaw.com, lisa.shebar@kattenlaw.com, cathay.smith@kattenlaw.com
Submission	Motion to Reopen
Filer's Name	Cathay Y. N. Smith
Filer's e-mail	floyd.mandell@kattenlaw.com, cathay.smith@kattenlaw.com, lisa.shebar@kattenlaw.com
Signature	/s/
Date	04/30/2010
Attachments	Petitioner's Request to Reopen Proceeding and For Telephone Conference.pdf (52 pages)(2625959 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

PENTHOUSE DIGITAL MEDIA
PRODUCTIONS INC.,

Petitioner,

v.

CLOUDSTREET, INC.
d/b/a ROXBURY ENTERTAINMENT,

Registrant.

Cancellation No. 92049926

**PETITIONER'S REQUEST TO REOPEN PROCEEDING
AND FOR TELEPHONE CONFERENCE**

Petitioner Penthouse Digital Media Productions Inc. ("Petitioner") respectfully requests the Board to resume this proceeding in light of the stay of the U.S. District Court civil action that occasioned the suspension of this proceeding, and respectfully requests a telephone conference to be scheduled with the Interlocutory Attorney in order to resolve certain scheduling issues in this proceeding.

1. On February 19, 2009, the Board suspended this proceeding (the "Cancellation Proceeding") pursuant to the parties' stipulation filed in the U.S. District Court, Central District of California, Civil Action No. CV-08-03872 FMXC (JWJx) (the "Civil Action"). (See Docket No. 10.)

2. On April 22, 2010, the District Court ordered the Civil Action stayed in its entirety in order to permit the Board to first resolve this Cancellation Proceeding. The District Court's "Order To Stay Case" is attached hereto as Exhibit A.

3. Petitioner's views concerning the scheduling and status of this Cancellation Proceeding, which were filed with the District Court, are attached hereto as Exhibit B; and

Registrant's views concerning the scheduling and status of this Cancellation Proceeding, which were filed with the District Court, are attached hereto as Exhibit C.

4. From these filings it appears that Petitioner and Registrant agree that: (1) Registrant's reply to Petitioner's counterclaim in the Civil Action should serve as Registrant's responsive pleading in this Cancellation Proceeding, and (2) the discovery period should be closed in this Cancellation Proceeding.

5. Nevertheless, as described in Exhibit B, Petitioner believes that there are issues remaining concerning the status and scheduling of this Cancellation Proceeding and, accordingly, believes the most effective and efficient manner to deal with such issues is a telephone conference with the Interlocutory Attorney and counsel for the parties in order to seek resolution of these issues and to set a scheduling order in this Cancellation Proceeding.

Date: April 30, 2010

Respectfully submitted,

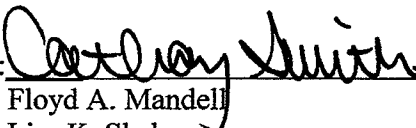
By: 
Floyd A. Mandell
Lisa K. Shebar
Cathay Y. N. Smith
Attorneys for Petitioner
Katten Muchin Rosenman LLP
525 West Monroe Street
Chicago, Illinois 60661
(312) 902-5200

Exhibit A

*Penthouse Digital Media Productions Inc. v. Cloudstreet, Inc. d/b/a
Roxbury Entertainment, Cancellation No. 92049926*

Petitioner's Exhibit

JS-5

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

CIVIL MINUTES - GENERAL

Case No. 2:08-cv-03872-JHN-FMOx Date April 22, 2010
Title Roxbury Entertainment v. Penthouse Media Group, Inc. et al

Present: The Honorable JACQUELINE H. NGUYEN

Alicia Mamer

Not Reported

N/A

Deputy Clerk

Court Reporter / Recorder

Tape No.

Attorneys Present for Plaintiffs:

Attorneys Present for Defendants:

Not present

Not present

Proceedings: ORDER TO STAY CASE (In Chambers)

The Court has read and considered the parties' responses to the Order to Show Cause ("OSC") issued by the Court on March 25, 2010, as to whether the Court should stay this litigation in order to permit the Trademark Trial and Appeal Board ("TTAB") to resolve the cancellation proceedings initiated by Defendants.

The only claims that remain pending in this litigation involve the validity of Plaintiff's trademark registrations, which Defendants seek to cancel. As such, the Court agrees with the parties' determination that a stay is appropriate in this case. However, the Court declines to rule on the evidentiary objections Defendants mention in their responsive briefing, and the Court is not persuaded that it can, or should, attempt to direct the TTAB's handling of substantive or procedural matters presented in connection with Defendants' cancellation claims. Cf., e.g., *Howsam v. Dean Witter Reynolds, Inc.*, 537 U.S. 79, 81-85 (2002) (considering the interpretation and application of a section of the National Association of Securities Dealers ("NASD") Code of Arbitration Procedure and finding that the applicability of the NASD time limit rule presented the type of "procedural" question that "grow[s] out of the dispute and bear[s] on its final disposition," rendering it a matter for the arbitrator, not the court, to decide). Accordingly, the Court hereby ORDERS that this case is STAYED in its entirety in order to permit the TTAB to resolve the cancellation proceedings initiated by Defendants. The Court also ORDERS the parties to meet and confer and to file a joint status report with the Court every 90 days until the stay is lifted by the Court.

IT IS SO ORDERED.

Initials of Preparer

AM

: N/A

Exhibit B

*Penthouse Digital Media Productions Inc. v. Cloudstreet, Inc. d/b/a
Roxbury Entertainment, Cancellation No. 92049926*

Petitioner's Exhibit

Kristin L. Holland (SBN 187314)
David M. Newman (SBN 246351)
KATTEN MUCHIN ROSENMAN LLP
2029 Century Park East, Suite 2600
Los Angeles, CA 90067-3012
Telephone: 310.788.4400
Facsimile: 310.788.4471

Floyd A. Mandell (admitted *pro hac vice*)
Cathay Y. N. Smith (admitted *pro hac vice*)
KATTEN MUCHIN ROSENMAN LLP
525 W. Monroe Street
Chicago, IL 60661-3693
Telephone: 312.902.5200
Facsimile: 312.902.1061

Ira P. Rothken (SBN 160029)
ROTHKEN LAW FIRM LLP
3 Hamilton Landing, Suite 280
Novato, CA 94949-8271
Telephone: 415.924.4250
Facsimile: 415.924.2905

Attorneys for Defendants and Counterclaimants

**UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
WESTERN DIVISION (Los Angeles)**

ROXBURY ENTERTAINMENT, a
California corporation,

Plaintiff,

vs.

PENTHOUSE MEDIA GROUP, INC., a
Nevada corporation; PENTHOUSE
DIGITAL MEDIA PRODUCTIONS,
INC., a New York corporation; PULSE
DISTRIBUTION, LLC, a California
LLC; and DOES 1-10, inclusive,

Defendants.

AND RELATED COUNTERCLAIM.

CASE NO. 2:08-cv-03872 JHN (FMOx)

**DEFENDANTS' RESPONSE TO
ORDER TO SHOW CAUSE RE:
STAY OF LITIGATION AND
TRANSFER TO TTAB;
DECLARATION OF KRISTIN
HOLLAND; PROPOSED ORDER**

Katten
MUCHIN ROSENMAN LLP

2029 Century Park East, Suite 2600
Los Angeles, CA 90067-3012
310.788.4400 tel. 310.788.4471 fax

RESPONSE TO ORDER TO SHOW CAUSE

Defendants hereby respond to the March 25, 2010 Order to Show Cause regarding whether the Court should stay this litigation in order to permit the Trademark Trial and Appeal Board ("TTAB") to first resolve the cancellation proceedings initiated by Defendants.

I. The Court Should Stay This Litigation To Allow The TTAB To First Resolve The Cancellation Proceeding Initiated By Defendants

On April 8, 2010, counsel for the parties met and conferred pursuant to the Court's Order. The parties agreed to a stay of this litigation pending the TTAB resolving the cancellation proceeding initiated by Defendants in the TTAB.¹ (Declaration of Kristin Holland ("Holland Decl."), ¶ 2.)

Accordingly, this Court should exercise its discretion to stay this litigation in order to permit the TTAB to first resolve the cancellation proceeding initiated by Defendants. *See, e.g., Citicasters Co. v. Country Club Communications*, 44 U.S.P.Q. 2d 1223, 1223-24 (C.D. Cal. 1997); *Microchip Technology, Inc. v. Motorola, Inc.*, No. Civ. A. 01-264-JJF, 2002 WL 32332753, at *3 (D. Del. May 28, 2002); *Kemin Industries, Inc. v. Watkins Products, Inc.*, 183 U.S.P.Q. 799 (D. Minn. 1974).

II. Defendants Will Be Prejudiced If The Court Does Not Resolve Certain Discovery Issues Prior To Stay Of This Litigation

Counsel for the parties discussed several additional issues during the April 8, 2010 meet and confer, and further in an April 15, 2010 E-Mail. Defendants believe they would be prejudiced should these issues not be resolved by this Court before a stay is imposed. The parties were not able to reach a consensus on all of these issues. (Holland Decl., ¶¶ 2-3.) In order to prevent prejudice to Defendants, Defendants

¹ The Complaint in this case was dismissed on December 21, 2009, when this Court granted Defendants' motion for summary judgment. (Docket ## 189, 195.) That decision is currently being appealed by Plaintiff. At this time, only Defendants' Counterclaims, Plaintiff's Motion for Summary Judgment, and Defendants' motions for fees, sanctions, and costs (Docket ## 199, 201) remain pending.

Kristin L. Holland (SBN 187314)
David M. Newman (SBN 246351)
KATTEN MUCHIN ROSENMAN LLP
2029 Century Park East, Suite 2600
Los Angeles, CA 90067-3012
Telephone: 310.788.4400
Facsimile: 310.788.4471

Floyd A. Mandell (admitted *pro hac vice*)
Cathay Y. N. Smith (admitted *pro hac vice*)
KATTEN MUCHIN ROSENMAN LLP
525 W. Monroe Street
Chicago, IL 60661-3693
Telephone: 312.902.5200
Facsimile: 312.902.1061

Ira P. Rothken (SBN 160029)
ROTHKEN LAW FIRM LLP
3 Hamilton Landing, Suite 280
Novato, CA 94949-8271
Telephone: 415.924.4250
Facsimile: 415.924.2905

Attorneys for Defendants and Counterclaimants

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
WESTERN DIVISION (Los Angeles)

ROXBURY ENTERTAINMENT, a
California corporation,

Plaintiff,

vs.

PENTHOUSE MEDIA GROUP, INC., a
Nevada corporation; PENTHOUSE
DIGITAL MEDIA PRODUCTIONS,
INC., a New York corporation; PULSE
DISTRIBUTION, LLC, a California
LLC; and DOES 1-10, inclusive,

Defendants.

AND RELATED COUNTERCLAIM.

CASE NO. 2:08-cv-03872 JHN (FMOx)

**DEFENDANTS' RESPONSE TO
ORDER TO SHOW CAUSE RE:
STAY OF LITIGATION AND
TRANSFER TO TTAB;
DECLARATION OF KRISTIN
HOLLAND; PROPOSED ORDER**

Katten
MUCHIN ROSENMAN LLP

2029 Century Park East, Suite 2600
Los Angeles, CA 90067-3012
310.788.4400 tel. 310.788.4471 fax

RESPONSE TO ORDER TO SHOW CAUSE

Defendants hereby respond to the March 25, 2010 Order to Show Cause regarding whether the Court should stay this litigation in order to permit the Trademark Trial and Appeal Board ("TTAB") to first resolve the cancellation proceedings initiated by Defendants.

I. The Court Should Stay This Litigation To Allow The TTAB To First Resolve The Cancellation Proceeding Initiated By Defendants

On April 8, 2010, counsel for the parties met and conferred pursuant to the Court's Order. The parties agreed to a stay of this litigation pending the TTAB resolving the cancellation proceeding initiated by Defendants in the TTAB.¹ (Declaration of Kristin Holland ("Holland Decl."), ¶ 2.)

Accordingly, this Court should exercise its discretion to stay this litigation in order to permit the TTAB to first resolve the cancellation proceeding initiated by Defendants. *See, e.g., Citicasters Co. v. Country Club Communications*, 44 U.S.P.Q. 2d 1223, 1223-24 (C.D. Cal. 1997); *Microchip Technology, Inc. v. Motorola, Inc.*, No. Civ. A. 01-264-JJF, 2002 WL 32332753, at *3 (D. Del. May 28, 2002); *Kemin Industries, Inc. v. Watkins Products, Inc.*, 183 U.S.P.Q. 799 (D. Minn. 1974).

II. Defendants Will Be Prejudiced If The Court Does Not Resolve Certain Discovery Issues Prior To Stay Of This Litigation

Counsel for the parties discussed several additional issues during the April 8, 2010 meet and confer, and further in an April 15, 2010 E-Mail. Defendants believe they would be prejudiced should these issues not be resolved by this Court before a stay is imposed. The parties were not able to reach a consensus on all of these issues. (Holland Decl., ¶¶ 2-3.) In order to prevent prejudice to Defendants, Defendants

¹ The Complaint in this case was dismissed on December 21, 2009, when this Court granted Defendants' motion for summary judgment. (Docket ## 189, 195.) That decision is currently being appealed by Plaintiff. At this time, only Defendants' Counterclaims, Plaintiff's Motion for Summary Judgment, and Defendants' motions for fees, sanctions, and costs (Docket ## 199, 201) remain pending.

respectfully request that the Court consider, and resolve, the following issues before it stays this litigation:

1. Use Of Discovery From This Litigation In The TTAB Cancellation Proceeding.

Discovery is now closed in this litigation. Accordingly, in order to avoid the duplication of efforts concerning discovery of the same factual and legal issues, and to avoid any unnecessary costs and delay, discovery should be closed in the TTAB cancellation proceeding, and the parties should be permitted to use all discovery obtained by them in this litigation, including documents, disclosures, and testimony, in the TTAB cancellation proceeding. Defendants believe that Plaintiff agrees to this position.

2. Defendants Should Be Permitted To Supplement Their Response to Plaintiff's Motion for Summary Judgment.

On October 5, 2009, Plaintiff filed a Motion for Summary Judgment ("MSJ"), and Defendants responded on October 26, 2009. (Docket ## 147, 166.) On November 9, 2009, the Court took Plaintiff's MSJ off calendar. (Docket # 186.) Indeed, if the Court stays this litigation, and if Plaintiff's MSJ is to be decided by the TTAB, Defendants would be prejudiced if they do not have the opportunity to supplement and/or file a new opposition brief with applicable law from the TTAB and the Federal Circuit. The current briefing assumes that the law of the 9th Circuit and of this District controls.

3. Evidence Not Produced During Discovery Should Be Barred

The parties should be barred from presenting any evidence in the TTAB cancellation proceeding that they did not produce by the close of discovery pursuant to a timely request and/or mandated by Rule 26 disclosures in this litigation, including, without limitation, documents, disclosures, and testimony.

For instance, in support of its Motion for Summary Judgment ("MSJ"), and *after* the close of discovery, Plaintiff submitted two declarations: one of Kirk Hallam

Katten

2000 Century Park East, Suite 2600
Los Angeles, CA 90067-1493
310.784.4000 tel. 310.782.4711 fax

(Plaintiff's principal owner and primary officer and agent, as well as its legal counsel) and one of Paul Supnik (Plaintiff's trademark counsel). (Docket # 147-2.) These declarations were used to purportedly demonstrate that Plaintiff did not engage in fraudulent conduct when it secured three trademark registrations for the mark "Route 66" – an issue at the heart of Defendants' cancellation proceeding in the TTAB, and its Counterclaims in this case.

In opposition to the MSJ, Defendants timely submitted Evidentiary Objections to both declarations. (Docket ## 166-5 and 166-6.) Defendants objected on numerous grounds, including that Plaintiff refused during the discovery period to produce the specific information contained in the two declarations or related information, although it was requested as part of a Fed. R. Civ. P. 36(b) notice and as part of written discovery.²

Specifically, Defendants had deposed Mr. Hallam personally, and as a Fed. R. Civ. P. 30(b)(6) witness after Magistrate Judge Olguin ordered him to appear pursuant to a Motion to Compel, filed after he failed to appear at a previously noticed deposition. (Holland Decl., ¶ 7.) Mr. Hallam was questioned regarding the very facts asserted in those declarations. Mr. Hallam *instructed himself* not to answer these questions and refused to provide such information during his deposition on the grounds that it would violate the attorney-client privilege and the attorney work-product doctrine. Mr. Hallam's conduct forced Defendants to file numerous discovery motions (Docket ## 118, 119, 142) to compel Plaintiff to provide this necessary testimony. Those discovery motions, however, have not been resolved. (Holland Decl., ¶¶ 4-12.)

As a result, Defendants were not able to reopen Mr. Hallam's deposition nor were they on notice that Mr. Supnik would be a witness. To date, the Court has not

² Defendants also objected to the Declaration of Paul Supnik on the grounds that he had never been identified as a potential witness for Plaintiff in Plaintiff's Initial Rule 26 Disclosure, its discovery responses, or at the deposition of Mr. Hallam. As such, Defendants were not on notice that Mr. Supnik would be a witness and did not depose him.

1 ruled on Defendants' Evidentiary Objections (filed concurrently with Defendants'
 2 Opposition) because it deferred its ruling on the MSJ. Therefore, despite the fact that
 3 Defendants timely objected to the declarations (*see Pfingston v. Ronan Engineering*
 4 *Co.*, 284 F. 3d 999, 1003 (9th Cir. 2002)), and had attempted to compel Mr. Hallam's
 5 testimony prior to the discovery cut-off, the issue of whether the declarations are
 6 admissible evidence remains unresolved.

7 Allowing the admission of such untimely "evidence" in the TTAB cancellation
 8 proceeding would prejudice Defendants, especially where, as here, Defendants are
 9 foreclosed from examining the declarants of such evidence. Indeed, Plaintiff should
 10 not be able to refuse to provide information when sought by Defendants during
 11 discovery, but then provide it in support of Plaintiff's case in the TTAB cancellation
 12 proceeding. Accordingly, Defendants respectfully request that the Court strike Mr.
 13 Hallam's and Mr. Supnik's Declarations, and/or bar either party from presenting any
 14 evidence in the TTAB cancellation proceeding that they did not produce by the close
 15 of discovery pursuant to a timely request and/or mandated by Rule 26 disclosures in
 16 this litigation, including, without limitation, documents, disclosures, and testimony.

17 Alternatively, if the Court declines to do so, Defendants respectfully request
 18 that the Court permit Defendants to depose Mr. Hallam and Mr. Supnik on the limited
 19 issues relating to the facts contained in their Declarations.³ Given Mr. Hallam's past

20
 21 ³ During the meet and confer, Plaintiff objected to this as a "reopening of discovery"
 22 after the discovery deadline has passed. That characterization is incorrect.
 23 Defendants do not seek to reopen discovery and do not intend to pursue discovery on
 24 any additional facts beyond those that Plaintiff improperly prevented Defendants from
 25 obtaining. Defendants seek only to discover facts that Plaintiff improperly prevented
 26 them from doing so before the close of discovery. In any event, even if this were an
 27 issue regarding the "modification" of the standing discovery schedule in this action,
 28 Defendants' predicament clearly establishes "good cause" for the Court to permit
 Defendants to depose Mr. Hallam and Mr. Supnik on very limited topics relating to
 their testimony offered in the Declarations. F.R.C.P. 16(b) (Adv. Comm. Notes on
 1983 Amendment to Rule 16(b).) While testimony of these witnesses can be obtained
 by calling them as adverse witnesses during this testimony period, at that stage, it
 would be after the consideration of a summary judgment motion, and thus, would

conduct of refusing to respond to questions on the ground of privilege after it is clear that he has opened to door to facts by virtue of his filing self-serving declarations, this Court should retain jurisdiction to enforce any discovery order. This will ensure that Mr. Hallam and Mr. Supnik do not refuse to answer questions directly related to their declarations. Plaintiff should not be allowed to use the attorney-client privilege when it suits its purposes, while affirmatively giving testimony on the identical subject areas.

III. Defendants Believe The Anticipated Duration Of The TTAB Cancellation Proceeding Will Be Approximately 12 Months

The depositions of Mr. Hallam and Mr. Supnik can be completed within two consecutive business days. (Holland Decl., ¶ 13.) Thereafter, absent any extensions of time or motions for summary judgment, a typical TTAB cancellation proceeding lasts 6 ½ months from the day discovery closes to the end of the parties' trial periods when the case is ready for decision. (Holland Decl., ¶ 14.) Additionally, according to the TTAB's website, the TTAB presently renders decisions in proceedings approximately 24 weeks after the case is ready for decision. (Holland Decl., ¶ 14.) Accordingly, if discovery is closed in the TTAB cancellation proceeding, Defendants believe that the TTAB cancellation proceeding will likely last approximately 12 ½ months absent any extensions and/or stays.

///

///

///

///

///

///

///

prejudice Defendants unless the declarations are stricken pursuant to the objections on file.

1 Accordingly, Defendants agree that the Court should exercise its discretion to
2 stay this litigation in order to permit the TTAB to first resolve the cancellation
3 proceedings.

4
5 Dated: April 19, 2010

KATTEN MUCHIN ROSENMAN LLP

6
7 By: s/Kristin L. Holland
Attorneys for Defendants and Counterclaimants

8
9 KATTEN MUCHIN ROSENMAN LLP

10
11 By: s/Floyd A. Mandell
Attorneys for Defendants and Counterclaimants

12
13 ROTHKEN LAW FIRM LLP

14
15 By: s/ Ira P. Rothken
Attorneys for Defendants and Counterclaimants

Katten

Katten Muchin Rosenman LLP
2000 Century Park East, Suite 5600
Los Angeles, CA 90067-2022
310.281.4400 tel. 310.281.4411 fax

DECLARATION

DECLARATION OF KRISTIN HOLLAND

I, Kristin Holland, hereby declare:

1. I am an attorney licensed in all the courts of the State of California and before this Court, and I am a partner at the law firm of Katten Muchin Rosenman LLP, attorneys of record for defendants and counterclaimants Penthouse Media Group Inc., n/k/a FriendFinder Networks Inc., Penthouse Digital Media Productions Inc., and Pulse Distribution, LLC (collectively, "Defendants"). I make this Declaration in support of Defendants' Response to Order to Show Cause.

2. On April 8, 2010, I, along with my colleagues Floyd Mandell and David Newman, met and conferred telephonically with Kirk Hallam, counsel for plaintiff Roxbury Entertainment ("Plaintiff"). A court reporter was present to transcribe the proceeding. As a general matter, the parties agreed to a stay of this action while the matter is transferred to the TTAB.

3. On April 15, 2010, after considering Mr. Hallam's position and wishing to compromise and clarify our position, I further sent an e-mail to Plaintiff's counsel, inviting Plaintiff to agree on certain discovery related issues. A true and correct copy of this e-mail is attached hereto as Exhibit A.

4. One of the issues that was not resolved during the meet and confer was whether the Court should strike Mr. Hallam's and Mr. Supnik's declarations in support of Plaintiff's Motion for Summary Judgment ("MSJ"), or whether Defendants should be able to depose Mr. Hallam and Mr. Supnik regarding the statements they made in their declarations. This requires a brief explanation of the background of Defendants' attempts to depose Plaintiff and ascertain the facts asserted in those declarations.

5. Pursuant to an agreement of the parties in early July, Defendants noticed Plaintiff's 30(b)(6) deposition for July 29, 2009. However, neither Mr. Hallam, nor any witness(es) for Plaintiff, appeared at this deposition, nor did Plaintiff seek a timely protective order.

Katten
Muchin Rosenman LLP

3000 Century Park East, Suite 5600
Los Angeles, CA 90067-2021
310.281.4400 tel. 310.281.4471 fax

6. As a result, Defendants filed a Motion to Compel and For Sanctions to force Plaintiff to appear for its deposition and to reimburse Defendants the costs and fees that were needlessly incurred in light of Plaintiff's unilateral "cancellation" of the deposition just 36 hours before it was set to proceed. Just a few days later, Plaintiff filed a Motion for Protective Order in an attempt to avoid having to produce a witness to appear for any deposition, which Defendants opposed.

7. After reviewing the parties' respective motions, Magistrate Judge Olguin issued an "Order re: Discovery Motion" on August 17, 2009. The Order compelled Plaintiff to appear for its 30(b)(6) deposition on August 26, 2009 and to provide substantive testimony. Judge Olguin determined that Plaintiff's purported grounds for refusing to appear were "meritless" and thwarted Defendants' right to discover facts about Plaintiff and Plaintiff's allegations in the Complaint. (Docket # 138.)

8. Among the areas of testimony for which Plaintiff was required to produce a witness pursuant to Fed. R. Civ. P. 30(b)(6) were Plaintiff's "first use and alleged continuous use of the Route 66 Mark," "Plaintiff's acquisition of its claimed rights in the Route 66 Mark," "any and all allegations contained in ... Defendants' First Amended Counterclaim, and Plaintiff's Answer and Affirmative Defenses to Defendants' First Amended Counterclaim," "all facts relating to the federal trademark applications and registrations for the Route 66 Mark," "information relating to any and all alleged motion pictures produced, distributed, sold, marketed, and/or advertised under the Route 66 Mark," "the evidence Plaintiff intends to introduce at trial," "the witnesses Plaintiff intends to call to testify at trial," and "information relating to ownership of the Route 66 Mark." A true and correct copy of the Amended Notice of Deposition of Roxbury Entertainment is attached hereto as Exhibit B.

9. On August 26 and 27, 2009, Mr. Hallam appeared as the sole designated witness for Plaintiff's 30(b)(6) deposition. At the deposition, Mr. Hallam was either unprepared or unwilling to answer questions about basic elements of Plaintiff and Plaintiff's claims; improperly refused to answer questions; failed to produce

Katten
Katten Muchin Rosenman LLP

2009 Century Park East, Suite 2600
Los Angeles, CA 90067-3012
310.788.4400 tel. 310.788.4471 fax

responsive documents; and instructed himself not to answer questions that pertained to factual issues in this action on the grounds of attorney-client privilege and attorney work-product doctrine. This includes questions bearing directly on grounds for canceling Plaintiff's fraudulent trademark registrations.

10. As a result of Mr. Hallam's evasive and non-responsive testimony, Defendants filed a Motion for Sanctions (Docket # 142) seeking to prevent Plaintiff from producing any evidence at trial or otherwise on the numerous topics that Plaintiff failed to provide substantive, factual testimony. The transcript of the 30(b)(6) deposition is attached as an exhibit to that motion, as well as multiple appendices that list all of the unanswered questions for which Mr. Hallam refused to provide any substantive testimony.

11. On October 5, 2009, Plaintiff filed its MSJ. In support of the MSJ, Mr. Supnik submitted an eleven (11) page Declaration purporting to testify to a number of topics related to Plaintiff's trademarks and trademark applications. (Docket # 147-2.) Mr. Supnik was never identified as a potential witness at any stage in the litigation – not in Plaintiff's Initial Disclosures, not in Plaintiff's discovery responses, and not during Plaintiff's 30(b)(6) deposition. Accordingly, Defendants objected to Mr. Supnik's testimony on the grounds that Defendants had been improperly prevented from discovering the very facts that he asserted in his Declaration.

12. Mr. Hallam also submitted a Declaration in support of the MSJ purporting to provide evidence on a wide range of topics. (Docket # 147-2, attached hereto as Exhibit C.) Notably, Mr. Hallam "testifies" to factual matters that he was specifically asked during Plaintiff's 30(b)(6) deposition but for which he refused to provide any substantive answers. For instance, during Mr. Hallam's deposition, Defendants sought information regarding Plaintiff's alleged continuous use of its trademark since 1960. Mr. Hallam hid behind the attorney-client and attorney-work product doctrine. Below is an excerpt from Mr. Hallam's deposition transcript, a true and correct copy of which is attached hereto as Exhibit D.

Katten
Katten Muchin Rosenman LLP
2025 Century Park East, Suite 5600
Los Angeles, CA 90067-9022
310.441.4400 tel. 310.441.4471 fax

1 Q. Do you have evidence showing continued use of
2 "Route 66" by you or by your predecessors in interest for the
3 last 48 years?

4 A. Yes.

5 Q. What is that evidence?

6 A. That, you're asking me for my opinions and
7 conclusions and knowledge as the litigator handling this
8 case on behalf of Roxbury Entertainment and as counsel for
9 Roxbury Entertainment, I have to assert attorney-client and
10 workplace *[sic]* privileges not to answer.

11 Remarkably, in support of Plaintiff's MSJ, Mr. Hallam provides extensive
12 testimony regarding the first use, and continuous use, of "Route 66" in paragraphs 9-
13 11 of his Declaration. Thus, on the one hand, he refused to disclose this information
14 on the basis of "privilege" during his deposition, but then freely provides this
15 information in support of Plaintiff's MSJ. Plaintiff should not be able to refuse to
16 provide this information when sought by Defendants during Mr. Hallam's deposition,
17 but then provide it in support of Plaintiff's MSJ or as evidence in support of Plaintiff's
18 case in the TTAB cancellation proceeding.

19 13. Based on Mr. Hallam's past conduct, Defendants are concerned that any
20 order that Mr. Hallam and Mr. Supnik submit to a deposition may be futile unless this
21 Court retains jurisdiction to ensure compliance with such order. If the witnesses are
22 straightforward and cooperative, their depositions can be completed in less than two
23 business days.

24 14. I am informed and believe, based upon my review of several TTAB
25 orders scheduling trial dates and conversations with TTAB specialists in my firm, that
26 a typical TTAB proceeding lasts 6 ½ months from the date discovery closes through
27 the end of the parties' trial periods when the case is ready for decision. Furthermore,
28 the TTAB website, located at <http://www.uspto.gov/trademarks/process/>

Katten
Katten Muchin & Zeman LLP

300 Century Park East, Suite 5600
Los Angeles, CA 90067-9005
310.581.4400 tel. 310.581.4710 fax

1 [appeal/guidelines/ttabfaq.jsp](#)>, states that “[p]resently, the TTAB is rendering
2 decisions in proceedings approximately 24 weeks after the case is ready for decision.”
3 Accordingly, it is my belief that the TTAB cancellation proceeding will last
4 approximately 12 ½ months absent any extensions of time or motions for summary
5 judgment.

6 I declare under penalty of perjury under the laws of the United States that the
7 foregoing is true and correct. Executed this 19th day of April, 2010, at Los Angeles,
8 California.

9
10 s/ Kristin Holland
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

Katten

Katten Muchin Rosenman LLP
2020 Century Park East, Suite 1600
Los Angeles, CA 90067-1011
310.782.4400 tel. 310.782.4711 fax

EXHIBIT A

Newman, David M

From: Holland, Kristin L.
Sent: Thursday, April 15, 2010 10:06 AM
To: 'kmhallam@aol.com'
Cc: Mandell, Floyd A.; Newman, David M
Subject: Roxbury/Penthouse – Proposed Order Regarding Transfer/Stay of Case
Attachments: Penthouse - Proposed Order on Transfer to TTAB (3).DOC

Kirk,

We attach a proposed order regarding the stay of the case which plan to submit to the Court with our brief on Monday. We invite you to agree to the attached order, or suggest any changes to the order for our consideration on or before Noon tomorrow (12 p.m. on April 16, 2010), as briefs are due on April 19, 2010. You are also welcome to call us if you would prefer to speak with us over the phone.

Kristin

KRISTIN L. HOLLAND

Partner

Katten Muchin Rosenman LLP

2029 Century Park East, Suite 2600 / Los Angeles, CA 90067-3012

p / (310) 788-4647 f / (310) 712-8424

kristin.holland@kattenlaw.com / www.kattenlaw.com

EXHIBIT B

Katten
Katten Muchin Rosenman LLP

209 Century Park East, Suite 2600
Los Angeles, CA 90067-3012
310.788.4400 tel 310.788.4471 fax

1 Kristin L. Holland (SBN 187314)
David M. Newman (SBN 246351)
2 **KATTEN MUCHIN ROSENMAN LLP**
2029 Century Park East, Suite 2600
3 Los Angeles, CA 90067-3012
Telephone: 310.788.4400
4 Facsimile: 310.788.4471
kristin.holland@kattenlaw.com
5 david.newman@kattenlaw.com

6 Floyd A. Mandell (admitted *pro hac vice*)
Cathay Y. N. Smith (admitted *pro hac vice*)
7 **KATTEN MUCHIN ROSENMAN LLP**
525 W. Monroe Street
8 Chicago, IL 60661-3693
Telephone: 312.902.5200
9 Facsimile: 312.902.1061

10 Ira P. Rothken (SBN 160029)
11 **ROTHKEN LAW FIRM LLP**
3 Hamilton Landing, Suite 280
Novato, CA 94949-8271
12 Telephone: 415.924.4250
Facsimile: 415.924.2905

13 Attorneys for Defendants and Counterclaimants

14
15 **UNITED STATES DISTRICT COURT**
16 **CENTRAL DISTRICT OF CALIFORNIA**
17 **WESTERN DIVISION (Los Angeles)**

18 **ROXBURY ENTERTAINMENT, a**
California corporation,

19 Plaintiff,

20 vs.

21 **PENTHOUSE MEDIA GROUP INC.,**
22 n.k.a. FriendFinder Network Inc., a
Nevada corporation; **PENTHOUSE**
23 **DIGITAL MEDIA PRODUCTIONS**
INC., a New York corporation; **PULSE**
24 **DISTRIBUTION, LLC, a California**
LLC; and DOES 1-10, inclusive,

25 Defendants.

26
27 **AND RELATED COUNTERCLAIM.**
28

CASE NO. 2:08-CV-03872 FMC (JWJx)

**AMENDED NOTICE OF
DEPOSITION OF ROXBURY
ENTERTAINMENT**

DATE: July 29, 2009

TIME: 9:00 a.m.

PLACE: Katten Muchin Rosenman LLP
2029 Century Park East
Suite 2600
Los Angeles, CA 90067-3012

1 6. Products and/or services created, produced, engineered, marketed,
2 advertised, promoted, distributed, sold and/or offered for sale, by, for or on behalf of
3 Plaintiff, for, under, on or in connection with the Route 66 Mark (collectively,
4 "Plaintiff's ROUTE 66 Products/Services").

5 7. Investigations, surveys, studies, market research or other analyses
6 regarding (a) the familiarity of consumers with Plaintiff and/or the Route 66 Mark; (b)
7 the respective services, products and/or marks of Plaintiff or Defendants; (c) any
8 confusion or likelihood of confusion resulting from Defendants' activities as alleged
9 in the Complaint; and/or (c) Defendants' activities as alleged in the Complaint.

10 8. Advertising, promotion and marketing of the Route 66 Mark and/or
11 Plaintiff's ROUTE 66 Products/Services, including the dollar amounts expended by
12 Plaintiff or on behalf of Plaintiff on such advertising, promotion and marketing.

13 9. Distribution and/or sale and/or attempted distribution and/or sales of
14 goods and/or services by Plaintiff under the Route 66 Mark.

15 10. The demographic characteristics of the consumer group to which
16 Plaintiff's ROUTE 66 Products/Services are sold, advertised, marketed and/or
17 promoted and any evidence supporting such.

18 11. Communications with customers, licensees, consumers, potential
19 customers, licenses and/or consumers regarding the Route 66 Mark, Plaintiff's Route
20 66 Products/Services, and/or Defendants.

21 12. Grants, licenses, permissions, agreements and/or assignments obtained
22 and/or issued by Plaintiff, and any negotiations thereof, with respect to the Route 66
23 Mark and/or Plaintiff's ROUTE 66 Products/Services, including, without limitation,
24 Plaintiff's claimed acquisition of rights, assignments to it, consideration paid, and
25 each predecessor's claims to title.

26 13. Any instances of actual confusion and/or reverse confusion among
27 members of the relevant public regarding any possible relationship between Plaintiff
28

Katten

2009 Century Park East, Suite 500
Chicago, Illinois 60601
Tel: 312.577.0800
Fax: 312.577.0801
www.katten.com

1 and Defendants or the respective services, products or marks of Plaintiff and
2 Defendants.

3 14. Opinions, advice, reports, studies, facts, or information about
4 Defendants' activities as alleged in the Complaint.

5 15. Past, present or future business plans for the creation, dissemination,
6 distribution, marketing, advertisement, promotion, sale and/or offering for sale of
7 Plaintiff's ROUTE 66 Products/Services.

8 16. Cease and desist demands, objections, lawsuits, and/or proceedings
9 against third parties involving the Route 66 Mark and/or Plaintiff's ROUTE 66
10 Products/Services, other than this action.

11 17. Any investigation by Plaintiff into third parties' use of the Route 66
12 Mark.

13 18. The action, if any, Plaintiff has taken to stop any person from using a
14 mark that Plaintiff claims, or has claimed, is confusingly similar to the Route 66
15 Mark.

16 19. Plaintiff's awareness and first awareness of Defendants' and/or
17 Defendants' use of any word or mark that Plaintiff contends infringes its alleged rights
18 in the Route 66 Mark.

19 20. All monetary relief Plaintiff seeks in this action, including the
20 computation of each item of monetary relief Plaintiff seeks and the basis of each such
21 computation.

22 21. Plaintiff's document retention policy.

23 22. Plaintiff's decision to bring this lawsuit.

24 23. The location, custody, and identity of the documents requested in
25 Defendants' First and Second Set of Document Requests.

26 24. Any and all search reports or opinions relating to use of the term
27 "ROUTE 66" alone or as part of a trade name, trademark or service mark in
28 connection with Plaintiff's business at any time.

Katten

2009 CenturyLink Inc. Suite 500
San Diego, CA 92101
Tel: 619.594.1000
Fax: 619.594.1001

1 25. Communications of any kind with any third party using "ROUTE 66" as
2 part of a trade name, trademark, or service mark.

3 26. Any and all allegations contained in the Complaint, proposed Amended
4 Complaint, Defendants' Answer and Affirmative Defenses, Defendants' Amended
5 Answer, Affirmative Defenses, and Counterclaim, Defendants' First Amended
6 Counterclaim, and Plaintiff's Answer and Affirmative Defenses to Defendants' First
7 Amended Counterclaim.

8 27. Plaintiff's responses to the First Set of Requests for Admission
9 propounded by Defendants.

10 28. Knowledge of any or all third party uses of "Route 66" in connection
11 with entertainment products or services.

12 29. All facts relating to the federal trademark applications and registrations
13 for the Route 66 Mark, including, without limitation, information relating to the
14 specimens of use submitted to the United States Patent and Trademark Office.

15 30. Information relating to any and all alleged motion pictures produced,
16 distributed, sold, marketed, and/or advertised under the Route 66 Mark.

17 31. Information or documents in which any or all of the defendants in this
18 action are referenced and/or mentioned.

19 32. Information or documents relating to any communications with any third
20 party, including, without limitation, the press, concerning this lawsuit and/or
21 concerning Defendants.

22 33. Information, documents, or communications relating to Plaintiff's efforts
23 to purchase the *Penthouse: Route 66* film and/or any other product or service offered
24 by any of the defendants in this action.

25 34. Information or documents relating to Plaintiff's claim that its Route 66
26 Mark is famous among members of the general public and/or has acquired a
27 secondary meaning.
28

Katten

2009 Oct 10 PM 1:00 PM, 10/10/09
10/10/09 1:00 PM, 10/10/09
10/10/09 1:00 PM, 10/10/09
10/10/09 1:00 PM, 10/10/09

1 35. Information, documents, or communications relating to any press releases
2 issued and/or authorized by Plaintiff and/or any licensee of Plaintiff regarding
3 Plaintiff, the Route 66 Mark and/or Plaintiff's ROUTE 66 Products/Services.

4 36. Plaintiff's responses to the Interrogatories propounded by Defendants.

5 37. The channels of distribution of Plaintiff's ROUTE 66 Products/Services.

6 38. The corporate structure of Plaintiff.

7 39. The officers and directors of Plaintiff.

8 40. The evidence Plaintiff intends to introduce at trial.

9 41. The witnesses Plaintiff intends to call to testify at trial.

10 42. The relationship between Plaintiff and Cloudstreet.

11 43. The job duties and responsibilities of Kirk Hallam as an officer of
12 Plaintiff.

13 44. Information relating to any exhibition at the Fort Lauderdale Film
14 Festival of film(s) entitled "Route 66".

15 45. Information relating to ownership of the Route 66 Mark.

16 46. Any evidence that any of Defendants' activities have tarnished the Route
17 66 Mark.

18 47. Customer complaints of Plaintiff.

19
20 Dated: July 21, 2009

KATTEN MUCHIN ROSENMAN LLP

21
22 By: 
23 Kristin L. Holland

Attorneys for Defendants and Counterclaimants

PROOF OF SERVICE

STATE OF CALIFORNIA)
) ss
COUNTY OF LOS ANGELES)

I am a resident of the State of California, over the age of eighteen years, and not a party to the within action. My business address is Katten Muchin Rosenman, 2029 Century Park East, Suite 2600, Los Angeles, CA 90067-3012. On July 21, 2009, I served the within documents:

AMENDED NOTICE OF DEPOSITION OF ROXBURY ENTERTAINMENT

X BY FACSIMILE - I sent such document from facsimile machine 310.788.4471 on July 21, 2009. I certify that said transmission was completed and that all pages were received and that a report was generated by facsimile machine 310.788.4471 which confirms said transmission and receipt. I, thereafter, mailed a copy to the interested party(ies) in this action by placing a true copy thereof enclosed in sealed envelope(s) addressed to the parties listed below.

BY U.S. MAIL - by placing the document(s) listed above in a sealed envelope with postage thereon fully prepaid, in the United States mail at Los Angeles, addressed as set forth below.

X BY ELECTRONIC MAIL - by transmitting electronically to the parties at the email address indicated below. To the best of my knowledge the transmission was reported as complete and I did not receive a notice of failure of receipt of each such document

Kirk M. Hallam, Esq.
Law Offices of Kirk M. Hallam
201 Wilshire Boulevard, 2nd Floor
Santa Monica, CA 90401
Email: kmhallam@aol.com

I am readily familiar with the firm's practice of collection and processing correspondence for mailing. Under that practice it would be deposited with the U.S. Postal Service on that same day with postage thereon fully prep aid in the ordinary course of business. I am aware that on motion of the party served, service is presumed invalid if postal cancellation date or postage meter date is more than on day after the date of deposit for mailing in affidavit.

I declare that I am employed in the office of a member of the bar of this court whose direction the service was made.

Executed on July 21, 2009, at Los Angeles, California.


KATHY CORNEJO

EXHIBIT C

DECLARATION OF KIRK M. HALLAM

I, Kirk M. Hallam, declare as follows:

1. I am an attorney licensed to practice before all the courts in the State of California. I am a sole practitioner and am counsel of record for plaintiff Roxbury Entertainment ("Roxbury" or "Plaintiff"). I have personal knowledge of the following facts. If called to testify under oath, I could and would competently testify to those facts of my own personal knowledge.

2. I am the President and Co-Founder of Roxbury Entertainment, and the person who principally communicated with Paul Supnik on behalf of Roxbury Entertainment during Mr. Supnik's preparation of Roxbury's filings with the Patent and Trademark Office ("the PTO") for registration of Roxbury's trademarks in "Route 66."

3. Due to my lack of any experience with the filing and processing of applications for trademark registration with the PTO, I retained Mr. Supnik on behalf of Roxbury sometime in 2005 to handle trademark applications for Route 66. Throughout the process of applying for and obtaining Trademark Registrations for Roxbury in Route 66, I relied upon Mr. Supnik's extensive knowledge and expertise in preparing and pursuing such trademark registrations, since I knew Mr. Supnik to be a very experienced and knowledgeable trademark lawyer who previously had handled trademark applications for other of my clients.

4. From April or May of 2005, when Roxbury first retained Mr. Supnik to prepare and file its applications for the Route 66 Trademark Registrations, through the issuance of those Trademark Registrations in January and September of 2007, I provided Mr. Supnik with the best and most accurate information that I had or could obtain to assist him in preparing and processing those applications. I was not at all personally knowledgeable with respect to the intricate and esoteric procedures and

1 terminology involved in applying for trademark registrations. For that, I relied
2 exclusively on Mr. Supnik.

3 5. I have reviewed Defendants' First Amended Counterclaim for
4 Cancellation of Roxbury's DVD/Videocassette Registration based on fraud, and I am
5 not aware of any false or misleading statements or information which was provided to
6 the PTO either by Roxbury or Mr. Supnik in connection with that application. I
7 certainly never provided any false statements or information in that regard, nor am I
8 aware of any false or fraudulent statements being made to the PTO by Mr. Supnik or
9 Roxbury. (A true and correct copy of Defendants' First Amended Counterclaims is
10 attached hereto as Exhibit A.)

11 6. In June or July of 2006, I researched at Mr. Supnik's request the first date
12 when Roxbury's predecessor-in-interest, Sony Pictures Entertainment ("Sony"), had
13 released the Route 66 Television Program on videocassette, and obtained the date of
14 February 28, 1995 from Sony's legal department. I then provided that information to
15 Mr. Supnik who included that date as the "date of first use" in Roxbury's filing for the
16 DVD/Videocassette Registration. I believed then and I believe now that this
17 information was and is correct.

18 7. At no point did I intend to indicate to the PTO, through Roxbury's filings,
19 that the Route 66 Television Program had been distributed on DVD in 1995, or any
20 other date prior to the actual DVD distribution commencing in 2005. I had never
21 heard any suggestion prior to this litigation that Roxbury was obligated by PTO rules
22 or guidelines to differentiate between the first date of distribution on Videocassette
23 and on DVD, and I have no reason to believe that any of Roxbury's filings in this
24 regard, prepared by Mr. Supnik, contained any false or misleading information
25 regarding the legal term "dates of first use."

26 8. I also have reviewed Defendants' Second Counterclaim for Cancellation
27 of the TV Program Registration (Ex. A), and I am not aware of any false or
28 misleading statements or information which was provided to the PTO either by

1 Roxbury or Mr. Supnik in connection with that application. Specifically, I have read
2 Defendants' allegations of fraud on the PTO in relation to the "dates of first use" and
3 "current use in commerce," and although I had no knowledge regarding the meaning
4 of those legal phrases until the filing of Defendants' Counterclaims, I do not believe
5 that either Mr. Supnik or Roxbury in its application or filings for the Television
6 Program Registration made any false or misleading statements to the PTO or the
7 examining attorney.

8 9. In April or May of 2005, I obtained at Mr. Supnik's request and provided
9 to him the most reliable information I had access to, describing the first dates for
10 broadcast of the 116 episodes of the original Route 66 Television Program. To the
11 best of my knowledge, the Route 66 Television Program originally aired on CBS from
12 1960-1964. Exhibit 2 to Mr. Supnik's Declaration in support of this Motion for
13 Summary Judgment is a true and correct copy of the document I located and provided
14 to Mr. Supnik with this information.

15 10. To the best of my knowledge, this information regarding the first use of
16 "Route 66" in connection with the broadcast of the original Television Program was
17 and is entirely accurate, and nothing in the filings which Mr. Supnik prepared on
18 Roxbury's behalf and pertaining to the Television Program Registration is in the least
19 bit false or misleading.

20 11. I am also aware of Defendants' contention that the Route 66 Television
21 Program was not broadcast between 1964 and 1985, and again in the late 1990's. And
22 although I was never asked to research the issue of any periods of non-use of the
23 Route 66 Mark during the 1960's, 70's, 80's or 90's, I did believe in 2005, when the
24 Television Program Application was submitted, and I believe now, that the Route 66
25 Television Program aired on local television stations for many years after it was
26 cancelled on CBS, and that it also aired again on national television in the 1980's, and
27 that a remake of the Series was produced and distributed in the 1990's. My
28 knowledge in this regard was based on conversations I had with the original creator

1 and producer of the Route 66 Television Program, Herbert Leonard, and on
2 information I read on the Internet.

3 12. In July of 2005, when Mr. Supnik prepared the initial application for
4 Roxbury's filing of the DVD/Videocassette Registration, I was personally involved in
5 Roxbury's efforts to produce a remake of the original Television Program, having
6 been approached by Ford Motor Company's entertainment marketing division, who
7 proposed a corporate sponsorship to produce the Series due to Roxbury's ownership of
8 the Program and its common law trademark in Route 66.

9 13. Also in July of 2005, I believed that the Route 66 Television Program
10 was still being broadcast by some foreign licensees of Sony, and Sony's licensee for
11 video distribution was continuing to "sell off" its remaining inventory of the Program
12 in the United States.

13 14. I also have reviewed Defendants' Third Counterclaim for Cancellation of
14 the Motion Picture Registration (Ex. A), and I am not aware of any false or misleading
15 statements or information which was provided to the PTO either by Roxbury or Mr.
16 Supnik in connection with that application. Specifically, I am aware Defendants are
17 alleging that Roxbury or Mr. Supnik made false statements to the PTO regarding the
18 date of "first use" and "actual use" in connection with the Motion Picture Registration.
19 I had no knowledge of any distinction between "a single work" and a "series of works"
20 under the trademark rules until the filing of Defendants' Counterclaim for Cancellation
21 (Ex. A), and I had no knowledge of any false statement being made to the PTO in this
22 regard. Nor do I believe that Mr. Supnik had any intention to mislead the PTO or the
23 examining attorney in describing Roxbury's goods as "motion picture film series
24 featuring action, drama or adventure."

25 15. I was involved in setting up the public exhibition of multiple episodes of
26 Route 66, edited together as movies, which were publicly exhibited in Ft. Lauderdale,
27 Florida, in 2005, 2006 and again in 2007, based on an idea given to me years earlier
28 by the original creator and producer of Route 66, Herbert Leonard. Although I was

1 not present during the theatrical exhibition of Roxbury's motion picture film series in
2 Ft. Lauderdale in May of 2007, I understand from my review of photographs taken
3 during this theatrical exhibition, that approximately 30 members of the public attended
4 each showing, and that several episodes of the Route 66 Television Program were
5 shown in this motion picture film series.

6 16. Sometime during the application process for the Motion Picture
7 Registration, Mr. Supnik asked me whether the Route 66 Television Programs were
8 on film or tape. I informed Mr. Supnik that I knew for a fact that all 116 episodes of
9 Route 66 were shot and maintained on either 16 or 35 millimeter film, because I
10 personally had seen the reels of film which were in Roxbury's constructive possession.

11 17. I never knowingly or intentionally made any false statement to the PTO
12 or to Mr. Supnik in reviewing and electronically signing Roxbury's applications for its
13 Route 66 Trademark Registrations, and I do not believe that Mr. Supnik knowingly or
14 intentionally ever made any false or fraudulent statements to the PTO or the
15 examining attorney.

16 18. On April 3, 2009, the Court entered its Order Denying Plaintiff's Motion
17 to Dismiss First Amended Counterclaim and Strike Portions of Amended Answer. (A
18 true and correct copy of that Order is attached hereto as Exhibit B.)

19 I declare under penalty of perjury under the laws of the United States that the
20 foregoing is true and correct.

21 Executed this 5th day of October, 2009, at Santa Monica, California.

22
23
24
25
26
27
28

/s/
KIRK M. HALLAM

EXHIBIT D

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
WESTERN DIVISION (Los Angeles)

ROXBURY ENTERTAINMENT, a)	
California corporation,)	Case No.
)	
Plaintiff,)	2:08-CV-03872 FMC
)	(JWJx)
vs.)	
)	
PENTHOUSE MEDIA GROUP INC.,)	
n.k.a. FriendFinder Network)	
Inc., a Nevada corporation;)	Volume 1
PENTHOUSE DIGITAL MEDIA)	(Pages 1-229)
PRODUCTIONS INC., a New York)	
corporation; PULSE DISTRIBUTION,)	
LLC, a California LLC, and)	
DOES 1-10, inclusive,)	
)	
Defendants.)	
-----)	
AND RELATED COUNTERCLAIM.)	
-----)	

VIDEOTAPED DEPOSITION OF:

KIRK M. HALLAM

WEDNESDAY, AUGUST 26, 2009

10:01 A.M.

REPORTED BY:

SUSAN NELSON

C.S.R. No. 3202

1

12:13:08 1	And I am entitled under the rules, if you	12:15:55 1	Q. It — it has —
12:13:16 2	continue to ask questions that have no relevance to	12:15:56 2	A. — its client.
12:13:18 3	this litigation whatsoever and are designed solely to	12:15:57 3	Q. — everything to do with our defenses.
12:13:23 4	harass me and my client, I am entitled to discontinue	12:15:59 4	If the plaintiff lacks standing to pursue
12:13:25 5	this deposition and seek an order of the court, which	12:16:02 5	these claims, it's something we're entitled to
12:13:30 6	I will do if you persist.	12:16:04 6	explore. I don't know why there's a controversy over
12:13:32 7	Q. Again, disagree completely, but I'll move on	12:16:07 7	this. But your position is stated and so is mine.
12:13:36 8	to my next question. And I just want to point out	12:16:09 8	We can just move on.
12:13:56 9	that category 38 required you to come today prepared	12:16:09 9	A. Where is that raised, that issue, where is
12:14:02 10	to testify about the corporate structure of	12:16:12 10	it raised? In your — in your answer or your
12:14:05 11	Plaintiff.	12:16:15 11	cross-complaint? It's not.
12:14:06 12	Category 39 requires testimony about the	12:16:17 12	Q. We don't have to have a — we don't have to
12:14:10 13	officers and directors of Plaintiff.	12:16:20 13	reach an agreement right now. You're refusing to
12:14:12 14	A. Hm-hm.	12:16:22 14	answer these questions on privilege. The record
12:14:12 15	Q. And that within both of those categories,	12:16:24 15	reflects that. And I'll — I'll move on to my next
12:14:16 16	questions about corporate formalities and other	12:16:28 16	category.
12:14:19 17	issues associated with the corporate structure and	12:16:28 17	A. And I'm also asking you to explain how it's
12:14:22 18	identity of the plaintiff in this case would — would	12:16:30 18	relevant to the issues that are in the case, that are
12:14:23 19	be well within the bounds of those categories.	12:16:32 19	in the pleadings, and you've not been able to do
12:14:27 20	Also, you did not object to this notice.	12:16:35 20	that.
12:14:28 21	You never filed any sort of objection indicating that	12:16:35 21	Q. It's — it is in the case, and I have, so
12:14:31 22	you'd have any reticence to testify about something	12:16:39 22	that's my position. I understand you disagree with
12:14:36 23	as simple as whether there have been board of	12:16:42 23	it.
12:14:40 24	directors meetings at the company. But I — I will	12:16:43 24	I forgot to ask one question at the
12:14:41 25	move on.	12:16:45 25	beginning that I just want to cover now. Is there.
86		88	
12:14:42 1	A. Yeah. And, please, I think it would be	12:16:48 1	any reason why you can't give your best testimony
12:14:44 2	in — in everyone's best interest because your	12:16:51 2	today?
12:14:48 3	30(b)(6) notice and its staying -- saying that you	12:16:53 3	A. No.
12:14:52 4	wanted to ask questions about corporate structure,	12:16:53 4	Q. You're not on any medications or drugs that
12:14:57 5	corporate structure is what kind of a corporation is	12:16:56 5	would impact your ability to testify truthfully
12:14:59 6	it. And the questions about the board of directors,	12:16:58 6	today?
12:15:03 7	who are on the board — who's on the board and the	12:16:59 7	A. No.
12:15:07 8	shareholders, I answered those questions and those	12:16:59 8	Q. Have you watched the Penthouse Route 66 DVD
12:15:08 9	are the only questions that relate to those two	12:17:07 9	from beginning to end?
12:15:10 10	categories.	12:17:09 10	A. Yes. As painful as it was to see Route 66
12:15:10 11	But, secondly, merely because you state	12:17:17 11	desecrated in that way.
12:15:14 12	something in a 30(b)(6) doesn't mean that we're	12:17:19 12	MS. HOLLAND: Move to strike everything
12:15:16 13	obligated to answer or that I'm obligated to waive	12:17:20 13	after "yes" as nonresponsive.
12:15:19 14	attorney-client or work product privilege anymore	12:17:43 14	Q. Are there any other DVDs or videos being
12:15:21 15	than our 30(b)(6) notice for your deponents obligates	12:17:45 15	sold in the United States which contain "Route 66" in
12:15:26 16	them to waive what they believe are their legitimate	12:17:49 16	the title other than Plaintiff's product and other
12:15:31 17	privileges and — and rights not to answer questions.	12:17:51 17	than that which is being claimed the defendant sold?
12:15:34 18	And I've heard —	12:17:54 18	A. That have "Route 66" anywhere in the title?
12:15:37 19	Q. We disagree. It has been heard.	12:17:56 19	Q. Yes.
12:15:38 20	A. I've heard no — I've heard no offer of	12:17:57 20	A. Or that are solely titled "Route 66"?
12:15:41 21	proof or explanation as to what issues that are in	12:17:59 21	Q. Which contain "Route 66" in the title.
12:15:43 22	your pleadings, your answer or your cross-complaint,	12:18:05 22	A. I believe that there are, yes.
12:15:46 23	this issue relates to. Clearly it isn't, and it's	12:18:09 23	Q. Do you have evidence showing continued use
12:15:50 24	solely for purposes of trying to harass and annoy and	12:18:15 24	of "Route 66" by you or by your predecessors in
12:15:53 25	intimidate opposing counsel and —	12:18:18 25	interest for the last 48 years?
87		89	

12:18:22 1	A. Yes.	12:25:07 1	BY MS. HOLLAND:
12:18:25 2	Q. What is that evidence?	12:25:09 2	Q. Okay. Before the break we were talking
12:18:26 3	A. That, you're asking me for my opinions,	12:25:16 3	about the 48 years of use of the "Route 66" mark.
12:18:28 4	conclusions and knowledge as the litigator handling	12:25:21 4	Isn't it a fact that after the show was
12:18:32 5	this case on behalf of Roxbury Entertainment, and as	12:25:23 5	cancelled in 1964, the show did not appear on
12:18:37 6	counsel for Roxbury Entertainment, I have to assert	12:25:26 6	television again until 1985?
12:18:40 7	attorney-client and workplace privileges not to	12:25:32 7	A. I don't know that to be the case. I don't
12:18:43 8	answer.	12:25:34 8	know, frankly.
12:18:43 9	Q. Has the evidence been produced in discovery?	12:25:35 9	Q. Do you have any documents or other evidence
12:18:46 10	A. What evidence?	12:25:41 10	reflecting use of the "Route 66" mark between 1964
12:18:46 11	Q. The evidence that you say you have showing	12:25:45 11	and 1985?
12:18:50 12	continued use of "Route 66" by you or your	12:25:49 12	A. Other than anything that we produced in this
12:18:52 13	predecessors in interest for the last 48 years?	12:25:51 13	litigation, no.
12:18:55 14	A. Any -- any evidence that was called for by	12:25:52 14	Q. Isn't it true that for several years during
12:18:58 15	Defendants' request for productions or	12:25:57 15	that period the "Route 66" trademark was not used by
12:19:01 16	interrogatories on those questions has been produced.	12:26:00 16	you or your predecessors in interest?
12:19:05 17	You served, I think, over a hundred	12:26:03 17	A. I don't know.
12:19:09 18	interrogatories and requests for productions, so I	12:26:04 18	MS. HOLLAND: Marking as Exhibit 4 the
12:19:10 19	can't remember them all as I sit here or every	12:26:15 19	document entitled "Plaintiff Roxbury Entertainment's
12:19:14 20	document that was produced. But if you asked for it	12:26:18 20	Amended Answer and Affirmative Defenses to
12:19:16 21	in your written discovery and we had it, we provided	12:26:22 21	Defendants' First Amended Counterclaim."
12:19:19 22	it.	12:26:24 22	(The document referred to was
12:19:19 23	Q. That wasn't quite my question. You said you	12:26:42 23	marked as Exhibit 4.)
12:19:26 24	had evidence showing continued use of "Route 66" for	12:26:42 24	BY MS. HOLLAND:
12:19:29 25	the last 48 years. I can represent that it's not in	12:26:43 25	Q. Okay. Did you prepare this document,
90		92	
12:19:32 1	the documents that Plaintiff produced, but that it is	12:26:45 1	Mr. Hallam?
12:19:35 2	called for by our discovery.	12:26:46 2	A. Yes, I did.
12:19:37 3	So I'm asking, has it been produced?	12:26:47 3	Q. Did anyone assist you in preparing the
12:19:40 4	A. We have produced all evidence in our	12:26:50 4	document?
12:19:42 5	possession or control that related to any	12:26:52 5	A. Miss Eichhorn.
12:19:48 6	interrogatory or request for production that you	12:26:52 6	Q. In the document there are many references to
12:19:51 7	posed. And if you posed interrogatories or request	12:27:08 7	Plaintiff is without sufficient information, or
12:19:55 8	for production on that question, we provided you with	12:27:12 8	Plaintiff has on information and belief, et cetera.
12:19:58 9	all documentary and other evidence that would respond	12:27:20 9	Where did you get the information used to
12:20:03 10	to your discovery request.	12:27:25 10	draft Exhibit 4?
12:20:06 11	Q. Are you withholding any documents that you	12:27:27 11	A. I think you need to be more specific. I --
12:20:11 12	believe show continued use of "Route 66" for the last	12:27:30 12	I -- I don't know how to begin answering that kind of
12:20:15 13	48 years?	12:27:33 13	a compound question.
12:20:15 14	A. No. But, again, I don't know whether you've	12:27:34 14	Q. Okay. We can go topic by topic.
12:20:21 15	asked for it, because you've not shown me your	12:27:44 15	A. But I can tell you that generally -- well,
12:20:24 16	interrogatories or requests for production, but we're	12:27:51 16	if you will stipulate that by answering the question
12:20:26 17	not withholding anything.	12:27:55 17	in terms of sources that I can recall utilizing in
12:20:27 18	I'm going to take a five-minute break, if I	12:28:01 18	preparing this document does not waive the work
12:20:29 19	may.	12:28:05 19	product privilege or the attorney-client privilege
12:20:29 20	MS. HOLLAND: Okay. That's fine.	12:28:08 20	with respect to any other questions, then I will do
12:20:32 21	THE VIDEOGRAPHER: Going off the record.	12:28:10 21	my best to answer it.
12:20:33 22	The time is 12:20 p.m.	12:28:12 22	I do think it calls for my work product and
12:20:35 23	(Recess taken.)	12:28:17 23	perhaps attorney-client communications, but in an
12:25:03 24	THE VIDEOGRAPHER: Back on the record. The	12:28:20 24	effort to expedite things and assist you as best I
12:25:05 25	time is 12:25 p.m.	12:28:24 25	can, I will try to provide you with information if
91		93	

17:21:06 1 the last four years.
 17:21:08 2 Q. But when did you have the conversations that
 17:21:10 3 you're now stating are related to the deposition we
 17:21:13 4 noticed -
 17:21:14 5 When, David? On Monday?
 17:21:17 6 A. Oh, prior to that. I think the first
 17:21:22 7 conversation I had with Mr. Buchler pertaining to the
 17:21:30 8 Penthouse litigation was probably six months ago.
 17:21:35 9 Maybe -- probably -- no, I take that back. Probably
 17:21:37 10 much earlier than that because we filed the
 17:21:39 11 litigation in June of 2008, and I certainly wanted to
 17:21:46 12 keep my distributor informed of what we were doing to
 17:21:50 13 protect the "Route 66" mark.
 17:21:52 14 Q. So you're refusing to answer the question
 17:22:00 15 has Roxbury made inquiries to Infinity regarding
 17:22:02 16 whether consumers have expressed confusion to
 17:22:05 17 Infinity about the Penthouse DVD?
 17:22:12 18 A. Well, I'm trying to remember whether I've
 17:22:14 19 ever asked Mr. Buchler that and if it was in the
 17:22:17 20 context of discussing his potential deposition. And,
 17:22:22 21 frankly, I don't recall. But Mr. Buchler would be
 17:22:38 22 your best witness on that.
 17:22:42 23 MS. HOLLAND: It's 5:23. I'm sorry, I went
 17:22:44 24 over a few minutes. If you'd like to end now, that's
 17:22:47 25 fine with me. We can resume tomorrow at 9:00.

226

17:22:47 1 THE WITNESS: Okay. That's fine.
 17:22:47 2 I will give these back to you.
 17:22:54 3 THE REPORTER: Thank you so much.
 17:22:54 4 THE VIDEOGRAPHER: This concludes Volume 1
 17:22:55 5 of the deposition of Kirk Hallam. The number of
 17:22:57 6 tapes used was four.
 17:22:58 7 The original videotapes will be retained by
 17:23:00 8 Merrill Legal Solutions at 20750 Ventura Boulevard,
 17:23:04 9 Woodland Hills, California.
 17:23:04 10 Going off the record. The time is 5:23 p.m.
 17:23:49 11 (Whereupon, at 5:23 P.M., the
 17:23:49 12 deposition of KIRK M. HALLAM was
 13 adjourned.)
 14
 15
 16
 17
 18
 19
 20
 21
 22
 23
 24
 25

227

1 STATE OF CALIFORNIA)
 2 COUNTY OF LOS ANGELES) ss.
 3
 4
 5 I, KIRK M. HALLAM, hereby declare under the
 6 penalties of perjury of the laws of the United States
 7 that the foregoing is true and correct.
 8 Executed this _____ day of
 9 _____, 2009, at
 10 _____, California.

KIRK M. HALLAM

228

1 STATE OF CALIFORNIA)
 2 COUNTY OF LOS ANGELES) ss.
 3 I, SUSAN NELSON, C.S.R. 3202, in and for the
 4 State of California, do hereby certify:
 5 That, prior to being examined, the witness named
 6 in the foregoing deposition was by me duly sworn to
 7 testify the truth, the whole truth and nothing but
 8 the truth;
 9 That said deposition was taken down by me
 10 stenographically at the time and place therein named,
 11 and thereafter transcribed via computer-aided
 12 transcription under my direction, and the same is a
 13 true, correct and complete transcript of said
 14 proceedings;
 15 Before completion of the deposition, review of
 16 the transcript [] was [] was not requested. If
 17 requested, any changes made by the deponent (and
 18 provided to the reporter) during the period allowed
 19 are appended hereto.
 20 I further certify that I am not interested in
 21 the event of the action.
 22 Witness my hand this 1st day of September, 2009.
 23
 24 Susan Nelson, C.S.R. No. 3202
 25 Certified Shorthand Reporter
 State of California

229

Exhibit C

*Penthouse Digital Media Productions Inc. v. Cloudstreet, Inc. d/b/a
Roxbury Entertainment, Cancellation No. 92049926*

Petitioner's Exhibit

1 KIRK M. HALLAM (SBN 108975)
2 LAW OFFICES OF KIRK M. HALLAM
3 201 Wilshire Boulevard, 2nd Floor
4 Santa Monica, California 90401
5 Tel: (310) 393-4006
6 Fax: (310) 393-4662
7 Email: KMHallam@aol.com

8
9 Attorney for Plaintiff and Counter-Defendant
10 ROXBURY ENTERTAINMENT
11

12
13 **UNITED STATES DISTRICT COURT**
14 **CENTRAL DISTRICT OF CALIFORNIA**
15

16 ROXBURY ENTERTAINMENT, a
17 California corporation,

18 Plaintiff,

19 vs.

20 PENTHOUSE MEDIA GROUP, INC., a
21 Nevada corporation; PENTHOUSE
22 DIGITAL MEDIA PRODUCTIONS,
23 INC., a New York corporation; PULSE
24 DISTRIBUTION LLC, a California
25 LLC; and DOES 1 -10, inclusive,

26 Defendants.
27
28

29
30
31
32
33
34
35
36
37
38
39
40
41
42
43
44
45
46
47
48
49
50
51
52
53
54
55
56
57
58
59
60
61
62
63
64
65
66
67
68
69
70
71
72
73
74
75
76
77
78
79
80
81
82
83
84
85
86
87
88
89
90
91
92
93
94
95
96
97
98
99
100
101
102
103
104
105
106
107
108
109
110
111
112
113
114
115
116
117
118
119
120
121
122
123
124
125
126
127
128
129
130
131
132
133
134
135
136
137
138
139
140
141
142
143
144
145
146
147
148
149
150
151
152
153
154
155
156
157
158
159
160
161
162
163
164
165
166
167
168
169
170
171
172
173
174
175
176
177
178
179
180
181
182
183
184
185
186
187
188
189
190
191
192
193
194
195
196
197
198
199
200
201
202
203
204
205
206
207
208
209
210
211
212
213
214
215
216
217
218
219
220
221
222
223
224
225
226
227
228
229
230
231
232
233
234
235
236
237
238
239
240
241
242
243
244
245
246
247
248
249
250
251
252
253
254
255
256
257
258
259
260
261
262
263
264
265
266
267
268
269
270
271
272
273
274
275
276
277
278
279
280
281
282
283
284
285
286
287
288
289
290
291
292
293
294
295
296
297
298
299
300
301
302
303
304
305
306
307
308
309
310
311
312
313
314
315
316
317
318
319
320
321
322
323
324
325
326
327
328
329
330
331
332
333
334
335
336
337
338
339
340
341
342
343
344
345
346
347
348
349
350
351
352
353
354
355
356
357
358
359
360
361
362
363
364
365
366
367
368
369
370
371
372
373
374
375
376
377
378
379
380
381
382
383
384
385
386
387
388
389
390
391
392
393
394
395
396
397
398
399
400
401
402
403
404
405
406
407
408
409
410
411
412
413
414
415
416
417
418
419
420
421
422
423
424
425
426
427
428
429
430
431
432
433
434
435
436
437
438
439
440
441
442
443
444
445
446
447
448
449
450
451
452
453
454
455
456
457
458
459
460
461
462
463
464
465
466
467
468
469
470
471
472
473
474
475
476
477
478
479
480
481
482
483
484
485
486
487
488
489
490
491
492
493
494
495
496
497
498
499
500
501
502
503
504
505
506
507
508
509
510
511
512
513
514
515
516
517
518
519
520
521
522
523
524
525
526
527
528
529
530
531
532
533
534
535
536
537
538
539
540
541
542
543
544
545
546
547
548
549
550
551
552
553
554
555
556
557
558
559
560
561
562
563
564
565
566
567
568
569
570
571
572
573
574
575
576
577
578
579
580
581
582
583
584
585
586
587
588
589
590
591
592
593
594
595
596
597
598
599
600
601
602
603
604
605
606
607
608
609
610
611
612
613
614
615
616
617
618
619
620
621
622
623
624
625
626
627
628
629
630
631
632
633
634
635
636
637
638
639
640
641
642
643
644
645
646
647
648
649
650
651
652
653
654
655
656
657
658
659
660
661
662
663
664
665
666
667
668
669
670
671
672
673
674
675
676
677
678
679
680
681
682
683
684
685
686
687
688
689
690
691
692
693
694
695
696
697
698
699
700
701
702
703
704
705
706
707
708
709
710
711
712
713
714
715
716
717
718
719
720
721
722
723
724
725
726
727
728
729
730
731
732
733
734
735
736
737
738
739
740
741
742
743
744
745
746
747
748
749
750
751
752
753
754
755
756
757
758
759
760
761
762
763
764
765
766
767
768
769
770
771
772
773
774
775
776
777
778
779
780
781
782
783
784
785
786
787
788
789
790
791
792
793
794
795
796
797
798
799
800
801
802
803
804
805
806
807
808
809
810
811
812
813
814
815
816
817
818
819
820
821
822
823
824
825
826
827
828
829
830
831
832
833
834
835
836
837
838
839
840
841
842
843
844
845
846
847
848
849
850
851
852
853
854
855
856
857
858
859
860
861
862
863
864
865
866
867
868
869
870
871
872
873
874
875
876
877
878
879
880
881
882
883
884
885
886
887
888
889
890
891
892
893
894
895
896
897
898
899
900
901
902
903
904
905
906
907
908
909
910
911
912
913
914
915
916
917
918
919
920
921
922
923
924
925
926
927
928
929
930
931
932
933
934
935
936
937
938
939
940
941
942
943
944
945
946
947
948
949
950
951
952
953
954
955
956
957
958
959
960
961
962
963
964
965
966
967
968
969
970
971
972
973
974
975
976
977
978
979
980
981
982
983
984
985
986
987
988
989
990
991
992
993
994
995
996
997
998
999
1000

1 TO THE COURT, ALL PARTIES, AND THEIR ATTORNEYS OF RECORD:

2 Pursuant to the Court's March 25, 2010 Order, Plaintiff Roxbury Entertainment
3 ("Plaintiff") submits this brief regarding Defendants' and the Court's suggestion that
4 Defendants' counterclaims be referred to the TTAB for resolution, and these
5 counterclaims be stayed pending the outcome of those proceedings.

6
7 **I. THE COURT SHOULD REFER THE COUNTERCLAIMS TO THE**
8 **TTAB WITHOUT RULING ON ANY OF THE LEGAL, FACTUAL OR**
9 **EVIDENTIARY ISSUES RELATED THERETO**

10
11 After meeting and conferring in an effort to resolve these issues between
12 themselves, Plaintiff and Defendants have agreed that this Court should in fact refer
13 the counterclaims for cancellation of Plaintiff's Route 66 Registered Trademarks back
14 to the TTAB (where they originally were filed) along with Plaintiff's pending motion
15 for summary judgment, for resolution of all the factual and legal issues raised thereby.

16 Plaintiff and Defendants do not agree, however, on the terms of such referral,
17 since Defendants are insisting that this Court first resolve Defendants' evidentiary
18 objections to certain of the evidence proffered by Plaintiff last October in support of
19 its Motion for Summary Judgment, and even suggesting the need to reopen discovery
20 and reconsider those discovery issues of Defendants' choosing. Such an approach by
21 this Court, amounting to a one-sided, piece-meal ruling on the evidentiary issues
22 raised in response to Plaintiff's pending Motion for Summary Judgment, or a
23 reopening of those discovery disputes on which Defendants would like to take belated
24 discovery six months after the close of all discovery, would be manifestly unfair to
25 Plaintiff, and would permit Defendant to gain an unfair advantage from this stay.

26 Were the Court instead to issue the Order in the form proposed by Plaintiff and
27 attached hereto, referring the counterclaims to the TTAB for resolution pursuant to the
28 Board's rules and procedures, this action by the Court would cause no prejudice, and

1 would provide no advantage, to either Plaintiff or Defendants, leaving each in the
2 same position as they were last October when discovery concluded and the Motion for
3 Summary Judgment was fully briefed and ready for resolution by the Court.
4 Plaintiff's position in this regard is simple: either the Court should refer the
5 counterclaims to the TTAB without ruling on any of its related issues, or the Court
6 should retain the counterclaims and rule on Plaintiff's pending Motion for Summary
7 Judgment and *all* of the factual and legal issues raised by the Motion and the
8 supporting and opposing papers.

9
10 **II. PIECEMEAL CONSIDERATION OF THE EVIDENTIARY**
11 **OBJECTIONS RAISED BY DEFENDANTS IN OPPOSITION TO**
12 **PLAINTIFF'S SUMMARY JUDGMENT MOTION WOULD UNFAIRLY**
13 **PREJUDICE PLAINTIFF AND PREVENT A FULL AND COMPLETE**
14 **RESOLUTION OF ALL ISSUES IN ONE PROCEEDING**

15
16 This Court's Order of March 25, 2010 noted that Defendants in a footnote to
17 their Opposition to Plaintiff's Motion for Summary Judgment suggested sua sponte
18 that referral of Defendants' counterclaims to the TTAB would be appropriate. The
19 Court asked the parties, therefore, to Show Cause "why this Court should not exercise
20 its discretion to permit Defendants' counterclaims for cancellation to proceed before
21 the TTAB." Specifically, the Court asked the parties to address in their briefing "(a)
22 the anticipated duration of the TTAB proceedings and (b) the effect or prejudice, if
23 any, that the timing of the TTAB proceedings may have on the parties if the Court
24 were to stay this action pending TTAB's adjudication of the cancellation issues,"
25 ordering the parties to meet and confer on these questions not later than April 12,
26 2010.

27 Instead of addressing these issues in the meeting of counsel, however,
28 Defendants instead sought to convert the Court's order into an opportunity for a

1 belated discussion of discovery disputes more than 6 months after the close of
 2 discovery, asserting that this meeting of counsel was a "discovery conference" under
 3 Rule 34, and insisting on a court reporter's transcription of the conference. Yet
 4 Plaintiff's counsel refused then, and refuses now, to accept Defendants' invitation to
 5 relitigate discovery disputes more than six months after the close of discovery, and in
 6 the absence of a timely discovery motion or even a request for an extension of the
 7 discovery cutoff. Counsel were not asked by this Court to discuss any of the
 8 evidentiary, factual or legal issues raised by Defendants' counterclaims or Plaintiff's
 9 pending Motion for Summary Judgment.

10 Suffice to say, Plaintiff has its own list of discovery grievances, evidentiary and
 11 procedural objections, including, to name just one, defense counsel Kristin Holland's
 12 blatant violation of Judge Johnson's last order in this case which clearly compelled
 13 Defendants' counsel to submit a declaration verifying as an officer of the Court the
 14 completeness and accuracy of Defendants' court-ordered supplemental discovery
 15 responses. Were discovery to be reopened, and additional discovery motions to be
 16 permitted, Plaintiff would file its own motions on this and a variety of other issues.
 17 Nowhere in the Court's OSC, however, was there an invitation to relitigate discovery
 18 or evidentiary issues. Instead, Plaintiff will address the issues on which the Court *did*
 19 ask for briefing.

20
 21 **III. NO REASON EXISTS FOR THE COURT NOT TO EXERCISE ITS**
 22 **DISCRETION TO REFER DEFENDANTS' COUNTERCLAIMS BACK**
 23 **TO THE TTAB FOR RESOLUTION**
 24

25 At this juncture in the proceedings, neither side in this litigation would suffer
 26 any prejudice from the referral of the Defendants' retaliatory cancellation claims back
 27 to the TTAB for resolution, and to the Federal Circuit for any appeal thereof.
 28 Defendants originally filed their cancellation claims with the TTAB, and again

1 suggested in their Opposition to Plaintiff's Summary Judgment Motion that such
2 referral back to the TTAB would be appropriate, making no mention of any prejudice
3 from such a referral. Defendants' suggestion now that this referral would be
4 appropriate *only* if the Court first were to rule on some of the evidentiary issues raised
5 by Defendants in their Opposition to Plaintiff's Summary Judgment, is an overt
6 attempt to extract from the Court one-sided concessions for Defendants as a condition
7 of this referral, advantages which Defendants otherwise do not enjoy in the current
8 posture of the case.

9 Defendants chose for tactical reasons not to take the deposition of Plaintiff's
10 trademark lawyer, Paul Supnik, despite knowing full well that Mr. Supnik was the
11 attorney preparing, filing and administering Plaintiff's applications for registration of
12 its Route 66 marks, and that he was the *only* person responsible for *all* of Plaintiff's
13 communications with the PTO examining attorney, the purported factual basis for all
14 of Defendants' retaliatory counterclaims. Any suggestion by Defendants now that
15 they were unaware of Mr. Supnik's essential and material testimony in regard to their
16 counterclaims (on which Defendants' bear the heavy burden to prove Mr. Supnik's
17 allegedly fraudulent intent) is absolute rubbish, as Plaintiff easily would demonstrate
18 were this issue properly before the Court.

19 Defendants' counsel, experts in trademark cancellation matters, not only
20 obtained at the inception of the case all of the filings prepared and filed by Mr. Supnik
21 with the PTO (even quoting some of them in their counterclaims), but repeatedly
22 referenced and disparaged Mr. Supnik in discovery conferences with Plaintiff's
23 counsel, derogatorily referring to Mr. Supnik as Plaintiff's "purported trademark
24 counsel." But when Defendants refused to make their own general counsel
25 (Mr. Bressler) available for any questioning regarding his "factual" statements,
26 Defendants made the tactical decision not to depose Mr. Supnik, apparently for fear
27 of being caught in an inconsistent legal position regarding the right to depose legal
28 counsel, thereby exposing Mr. Bressler to interrogation.

1 Similarly, Defendants' suggestion that Plaintiff's sole litigation counsel, Kirk
2 Hallam, should be ordered by this Court to submit to further deposition testimony in
3 this case, 7 months after the two days and two hundred and twenty-nine pages of his
4 deposition testimony, is equally preposterous and one-sided. Over this two day/14
5 hour deposition, Plaintiff's counsel answered literally hundreds of questions calling
6 for his personal knowledge of facts or events related to Plaintiff's claims and
7 Defendants' counterclaims. Only where Hallam genuinely felt that his opposing
8 counsel was asking for his legal conclusions and opinions, rather than his knowledge
9 of factual events, did he respond with an assertion of privilege. An example of just
10 two of the hundreds of factual questions on which Mr. Hallam provided his full and
11 complete testimony, without assertion of privilege, is the following which appears at
12 pages 94-97 of his deposition transcript:

13
14 "Q: Do you recall what year was provided to the trademark
15 office associated with Plaintiff's first use of the "Route 66" trademark on
16 DVDs?

17 A: I believe that the classification is not limited to DVDs. It's
18 DVD and VHS and other formats. I believe that the date that was
19 submitted to the PTO for the class of goods as the date of first use was
20 sometime in 1995.

21 Q: And isn't it true that Plaintiff didn't use the "Route 66"
22 trademark on DVDs until 2005?

23 A: That we did not? Or Roxbury Entertainment?

24 Q: Correct.

25 A: I think that's correct."
26

27 In response to the countless questions on which Plaintiff's counsel was asked
28 for factual narratives, rather than his assessment of the evidence or his legal opinions,

1 Hallam provided his full and complete recollection of the facts, without objection or
2 assertion of privilege, such as his testimony which appears on pages 157 through 170
3 of his deposition transcript, beginning with the following question and answer:

4
5 "Q: What efforts has Roxbury Entertainment undertaken to
6 develop its own 'Route 66 film and television program?

7 A: Hm. That question definitely calls for a narrative. And I
8 will try to give it to you in synopsis form, but it's something that I have
9 been personally involved in for I guess seven, eight years on behalf of
10 Roxbury Entertainment. We have expended an enormous amount of time
11 and money seeking to develop a script for a feature film based on Route
12 66, the television program, or at least loosely based on that. [Hallam's

13 answers and follow up questions and answers continuing for 13 pages
14 without objection]."

15
16 "Only where Defendants' counsel insisted on asking questions clearly calling for
17 counsel's legal conclusions and opinions did Hallam assert the appropriate objections
18 and refuse to answer the questions. For example, the following question and answer
19 appear at page page 179 through 180 of the Hallam deposition transcript:

20
21 "Q: Did Roxbury own all right, title and interest in and to the
22 "Route 66" trademark in 2004?

23 A: Well, you're clearly asking me for a legal conclusion. And
24 because I am the litigation counsel in this case, and I'm also an ongoing
25 lawyer for Roxbury Entertainment, I cannot opine on that legal question
26 you just asked me without disclosing my work product and attorney-
27 client privileged communications...

28

1 As you know, ownership of a trademark, there [are] various
2 elements to it. There's ownership of registrations. There's
3 ownerships that accrue by virtue of secondary meaning. And
4 ownership is in itself a legal question."

5
6 The Court obviously cannot and should not rule on any of the specific
7 assertions of privilege, or any of the evidentiary issues raised by Defendants in
8 Opposition to the Summary Judgment Motion, without considering all of the
9 questions and answers one by one, and all in the context of the entire deposition
10 transcript, and in the context of the entire Motion for Summary Judgment and all of
11 the supporting and opposing papers. In addition, this Court simply could not make
12 such isolated and belated discovery or evidentiary rulings in the undisputed absence
13 here of: (1) a timely motion for discovery, or even a timely motion for an extension
14 of discovery (2) a full and complete consideration of all of the legal and factual issues
15 involved in such a discovery dispute (3) an opportunity by Plaintiff to brief each of the
16 relevant issues, and (4) an equal opportunity being afforded to Plaintiff to take
17 additional discovery or seek judicial relief with respect to numerous deficiencies in
18 Defendants' discovery responses.

19 Moreover, Defendants' suggested "piecemeal" approach to the resolution of
20 evidentiary or legal issues pertaining to Plaintiff's Motion for Summary Judgment
21 (asking this Court to rule on some issues but leaving the remainder of the issues for
22 the TTAB) unfairly would deprive Plaintiff of a simultaneous determination by one
23 tribunal on all evidentiary, factual and legal issues raised in connection with the
24 Summary Judgment Motion, including issues raised by Plaintiff pertaining to bad faith
25 and improper conduct by Defendants' counsel in prosecution of their retaliatory
26 cancellation counterclaims. Just to name a few: (1) Defendants' counsel in their
27 counterclaims and again in their Opposition to Plaintiff's Motion repeatedly quoted a
28 rule from the Trademark Manual of Examining Procedure in arguing that Plaintiff

1 defrauded the PTO, *but purposely omitted from that quote the language of the rule*
 2 *which explicitly approved Mr. Supnik's method of completing the application,* (2)
 3 Defendants falsely asserted that purported "abandonment" of a mark prior to the date
 4 of registration was a legal basis for cancellation of that registration, despite clear and
 5 unambiguous authority to the contrary, (3) Defendants astonishingly argued that
 6 recent Federal Circuit authority on the standards of proof for cancellation claims based
 7 on fraud was *irrelevant* in the district courts.

8 Simply put, Defendants cannot be allowed to gain an advantage from the
 9 Court's referral of this matter to the TTAB, and the Court's Order should be a neutral
 10 one which refrains from making or suggesting any rulings on evidentiary or discovery
 11 matters, and leaves such matters for determination by the TTAB, as set forth in the
 12 form of the Proposed Order which is attached hereto:

13
 14 **IV. THE ANTICIPATED DURATION OF THE CANCELLATION**
 15 **PROCEEDINGS AND THE LACK OF ANY PREJUDICE BY VIRTUE**
 16 **OF THAT TIMING**
 17

18 At this juncture in the proceedings, with extensive discovery having been
 19 conducted and the parties' respective positions have been fully briefed, the time
 20 required for resolution of Defendants' cancellation claims by the TTAB should be a
 21 matter of months, not years. In fact, other than Defendants' insistence on raising
 22 discovery or evidentiary issues for this Court to resolve, counsel for Plaintiff and
 23 Defendants have agreed in principle to expedite the procedures for resolution of the
 24 matter before the TTAB, as outlined in the provisions of Plaintiff's Proposed Order.

25 And, since Plaintiff's trademark infringement and dilution claims against
 26 Defendants are on appeal to the Ninth Circuit for the next 2 years or more, the
 27 necessity for a simultaneous determination of the counterclaims is far less apparent.
 28 than it was when Defendants' originally sought to bifurcate the determination of those

1 issues by filing their cancellation counterclaims with the PTO. Consequently,
2 Plaintiff agrees with Defendants that no prejudice would result from the Court's
3 referral of the counterclaims to the TTAB and a stay of the cancellation counterclaims
4 pending the TTAB's determination of those issues. Further, since an appeal to the
5 Federal Circuit Court of Appeals undoubtedly will result from any ruling by the
6 TTAB in this regard, reference of the matter to the TTAB and the Federal Circuit most
7 likely will result in a more expedited final determination, and the elimination of any
8 need by this Court or the Ninth Circuit to revisit these counterclaims.

9 Plaintiff respectfully requests, therefore, that the Court enter its form of the
10 Proposed Order, and immediately refer Defendants' counterclaims to the TTAB for a
11 determination of all issues related thereto.

12
13 Dated: April 19, 2010 Respectfully submitted,

14 By: /s/ KIRK M. HALLAM
15 KIRK M. HALLAM (SBN 108975)
16 Attorney for Plaintiff and Counter-Defendant
17 Law Offices of Kirk M. Hallam
18 201 Wilshire Boulevard, 2nd Floor
19 Santa Monica, California 90401
20 Telephone: (310) 393-4006
21 Facsimile: (310) 393-4662
22
23
24
25
26
27
28

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

PENTHOUSE DIGITAL MEDIA
PRODUCTIONS INC.,

Petitioner,

v.

CLOUDSTREET, INC.
d/b/a ROXBURY ENTERTAINMENT,

Registrant.

Cancellation No. 92049926

CERTIFICATE OF SERVICE

I hereby certify that on this 30th day of April, 2010, I caused a true and correct copy of the foregoing to be served upon:

Mr. Paul D. Supnik
9401 Wilshire Boulevard, Suite 1012
Beverly Hills, CA 90212

via First Class Mail, postage prepaid.

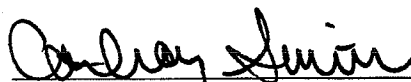

Cathay Y. N. Smith

EXHIBIT E

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<p>PENTHOUSE DIGITAL MEDIA PRODUCTIONS, INC.,</p> <p style="text-align: center;">Petitioner,</p> <p style="text-align: center;">v.</p> <p>CLOUDSTREET, INC. DBA ROXBURY ENTERTAINMENT,</p> <p style="text-align: center;">Registrant.</p>	<p>Cancellation No. 92049926</p> <p>Registration Nos. 3189543; 3194255; 3291736</p> <p>Mark: ROUTE 66</p> <p>Issued: December 26, 2006; January 2, 2007; September 11, 2007</p>
---	---

**NOTICE OF DEPOSITION OF
PENTHOUSE DIGITAL MEDIA PRODUCTIONS, INC.**

TO: Kristin L. Holland
Katten Muchin Rosenman LLP
2029 Century Park East
Suite 2600
Los Angeles, California 90067

Floyd A. Mandell
Cathay Y. N. Smith
Katten Muchin Rosenman LLP
525 West Monroe Street
Chicago, Illinois 60661

PLEASE TAKE NOTICE that pursuant to Rule 30(b)(6) of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice, Cloudstreet, Inc. dba Roxbury Entertainment ("Registrant"), by its attorneys, will take the deposition upon oral examination of Petitioner Penthouse Digital Media Productions Inc. ("Petitioner"), who shall designate one or more representatives to testify on its behalf in regard to the following subject areas that are known or reasonably available to Petitioner. The deposition will commence on Friday, May 20, 2011 at 10:00 a.m. and, if necessary, will

continue from day-to-day thereafter until completed or adjourned. The deposition will be taken at the offices of Kirk M. Hallam, 201 Wilshire Boulevard, 2nd Floor, Santa Monica, California 90401. The deposition will be conducted before a certified court reporter and may be recorded by sound, sound-and-visual, videotape and/or stenographic means. The deposition may be used for all purposes contemplated under the Federal Rules of Civil Procedure and U.S. Trademark Rules.

SUBJECT AREAS OF TESTIMONY

1. Any facts and documents supporting Petitioner's allegations contained in Petitioner's Consolidated Petition to Cancel in the instant action filed with the TTAB on September 12, 2008.
2. Any facts and documents supporting Petitioner's allegations contained in Petitioner's Amended Consolidated Petition to Cancel in the instant action filed with the TTAB on June 14, 2010.
3. Any facts and documents supporting any declarations by an officer and/or managing agent of Petitioner filed in *Roxbury Entertainment v. Penthouse Media Group, Inc., et al.*, United States District Court for the Central District of California, Case No. 2:08-cv-3872, including but not limited to any declarations by Kelly Holland, Anthony Previte, James Sullivan, Lawrence Sutter and/or Robert Brackett.
4. Any facts and documents supporting any declarations by counsel for Petitioner with the firm of Katten, Muchin, Rosenman filed in *Roxbury Entertainment v. Penthouse Media Group, Inc., et al.*, United States District Court for the Central District

of California, Case No. 2:08-cv-3872, including but not limited to any declarations by Floyd A. Mandell, Kristin L. Holland, Cathay Y.N. Smith and/or David Newman.

**REGISTRANT'S REQUEST FOR PRODUCTION OF DOCUMENTS PURSUANT TO
RULE 34 OF THE FEDERAL RULES OF CIVIL PROCEDURE**

In accordance with Rule 34 of the Federal Rules of Civil Procedure, Petitioner requests that Registrant produce any and all Documents which relate or refer to each of the six (6) categories set forth above at above noticed deposition, to the extent such documents have not already been produced in the related civil action between the parties, *Roxbury Entertainment v. Penthouse Media Group Inc. et al.*, Case No. CV 08-03872, in the Central District of California.

As used herein, "Document" and "Documents" shall mean and include all written, recorded, or graphic matters, however produced or reproduced, whether or not privileged, pertaining in any way to the subject matter of this action, including but not limited to all those documents within the scope of the term "documents" under Rule 1001 of the Federal Rules of Evidence. This definition includes, but is not limited to, any and all originals, copies, or drafts of any and all of the following: records; notes; summaries; contracts or agreements; drawings; sketches; invoices, orders or acknowledgments; labels, tags, advertising and promotional materials, CAD images; diaries, reports, forecasts or appraisals; memoranda or telephone or in-person conversations by or with any person, or any other memoranda; letters, telegrams, telexes, or cables prepared, drafted, received or sent; tapes, transcripts or recordings; electronic data; photographs, pictures or films; computer programs or data or other

graphic symbolic, recorded or written materials of any nature whatsoever. Without limiting the scope of the definition of "Document", "Document" includes, without limitation, labels, tags, and samples of products. Any document which contains any comments, notation, addition, insertion or marking of any kind which is not part of another document or document which does not contain any comment, notation, addition, insertion, or marking of any kind which is part of another document, is to be considered a separate document.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Kirk M. Hallam", written over a horizontal line.

Kirk M. Hallam
201 Wilshire Blvd., 2nd Floor
Santa Monica, CA 90401
Telephone: (310) 393-4006
Facsimile: (310) 393-4662

Dated: May 4, 2011

CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing **NOTICE OF DEPOSITION OF PENTHOUSE DIGITAL MEDIA PRODUCTIONS, INC.** was served by first class mail, postage prepaid, on this 4th day of May 2011, upon counsel for Petitioner:

Floyd A. Mandell, Esq.
Cathay Y. N. Smith, Esq.
Katten Muchin Rosenman LLP
525 West Monroe Street
Chicago, IL 60661-3693

Kristin L. Holland
Katten Muchin Rosenman LLP
2029 Century Park East, Suite 2600
Los Angeles, California 90067

STEPHANIE EICHHORN

EXHIBIT F

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

PENTHOUSE DIGITAL MEDIA
PRODUCTIONS, INC.,

Petitioner,

v.

CLOUDSTREET, INC. D.B.A.
ROXBURY ENTERTAINMENT,

Registrant.

)
)
) Cancellation No. 92049926

)
) Registration Nos. 3189543; 3194255; 3291736

)
) Mark: ROUTE 66

)
) Issued: December 26, 2006; January 2, 2007;
) September 11; 1007
)
)
)
)

**OBJECTIONS TO NOTICE OF DEPOSITION OF
PENTHOUSE DIGITAL MEDIA PRODUCTIONS, INC.**

Petitioner PENTHOUSE DIGITAL MEDIA PRODUCTIONS, INC., ("Petitioner") hereby objects to the Notice of Deposition served by Cloudstreet, Inc. dba Roxbury Entertainment ("Registrant"), and, as has been already communicated to Registrant's counsel on May 10 by telephone and May 15 in writing, will not produce a witnesses or documents at the location or on the date noticed on the following grounds:

(1) **The Noticed Location Is Improper:** The Notice sets the deposition for Santa Monica, California. Petitioner is a New York corporation with operations in California, New York and Florida. Although it is impossible to determine, due to the lack of specificity of the notice, it is entirely possible that designees from each of these states would be required. Thus, the noticed location is not proper. Registrant has not agreed to another location or locations.

(2) The Rule 34 Demand for Production of Documents Provides Insufficient Notice:

The Notice demands the production of documents but was served on less than 30 days notice. Under FRCP 34 and related TTAB rules, a minimum of 30 days' notice is required. *See* FRCP 34(b)(2)(A); FRCP 30(b)(2). On May 18, 2011, by email, Registrant withdrew the document demands, acknowledging that notice was defective, but did not cure any of the other defects or reserve a proper notice without document demands.

(3) The Categories of Requested Testimony Are Impermissibly Vague, Overbroad and Harassing: A deposition notice to a corporate entity must "describe with reasonable particularity the matters on which examination is requested." FRCP 30(b)(6); *see also* *Sprint Communications Co., L.P. v. Theglobe.com, Inc.* 236 FRD 524, 528 (D. Ks. 2006) (requiring description with "painstaking specificity"). The categories in the notice are so overbroad that Petitioner is unable to produce a designee or designees without further clarification and limitation. Moreover, the production of each of the individuals named in the notice, as well as others potentially sought by the categories, would be unduly disruptive to Petitioner's business.

Categories 1 and 2 seek a designee or designee on every allegation in the original and amended Cancellation Petitions. These categories make no attempt at specificity, other than to confine questions to every legal issue in this case, which is of no assistance in determining appropriate designees. Indeed, the Categories are not even limited to factual allegations, nor do they reference any specific allegations in particular. Accordingly, they are not reasonably particular in their scope and are grossly overbroad.

Moreover, by seeking a designee on legal allegations, like elements of claims and legally available remedies, the Categories impermissibly seek conclusions of law and legal opinions, which necessarily involve the testimony of in-house and outside litigation counsel for Petitioner. This testimony is protected by numerous privileges, including the attorney-client and work-product privileges.

Categories 3 & 4 seek designees on numerous declarations filed in the course of two years of litigation in a district court proceeding, without any expressed relation whatsoever to the issues asserted in this cancellation proceeding. Accordingly, they lack reasonable particularity, are overly broad, and are harassing. It is also impermissible for Registrant to use this proceeding to reopen discovery in the district court case, in which summary judgment was granted against Registrant.

(4) The Notice Impermissibly Seeks the Depositions of Litigation Counsel: Category 4 impermissibly seeks the depositions of outside litigation counsel for Petitioner on issues in the district court matter. This is an improper attempt to depose litigation counsel, none of whom are employees of Petitioner, and all of whom work for Katten Muchin Rosenman LLP, counsel of record in this matter and in the district court matter. The information sought is clearly protected by the attorney client and work product doctrines. Registrant's attempt to depose litigation counsel is patently harassing and improper.

Accordingly, Petitioner will not produce a designee or designees for deposition on May 20, 2011. Petitioner has attempted to meet and confer on these issues by telephone on May 10

and in writing on May 15, in an effort to reach an agreement for a date, location and more narrowly tailored categories of testimony, but to date, the only concession made by Registrant is a withdrawal of the defective document demand. This does not resolve the serious issues discussed above and is not acceptable to Petitioner.



Kristin L. Holland
KATTEN MUCHIN ROSENMAN LLP
2029 Century Park East, Suite 2600
Los Angeles, CA 90067-3012
Telephone: (310) 788-4400
Facsimile: (310) 788-4471

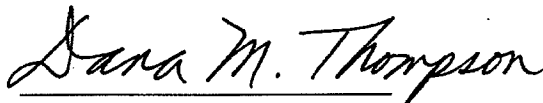
Dated: May 19, 2011

CERTIFICATE OF SERVICE

I hereby certify that on May 19, 2011 I served the foregoing document described as **OBJECTIONS TO NOTICE OF DEPOSITION OF PENTHOUSE DIGITAL MEDIA PRODUCTIONS, INC.** on the interested parties in this action electronically by attaching an electronic copy of the document to an email addressed to the parties listed below at their most recent email address of record in this action. I did not receive, within a reasonable time after the transmission, any electronic message or other indication that the transmission was unsuccessful.

Kirk M. Hallam, Esq.
Law Offices of Kirk M. Hallam
201 Wilshire Boulevard, 2nd Floor
Santa Monica, CA 90401-1219
Tel. (310) 393-4006
Fax (310) 393-4662
Email kmhallam@aol.com

Paul D. Supnik, Esq.
Law Office of Paul D. Supnik
9401 Wilshire Boulevard, Suite 1250
Beverly Hills, CA 90212-2945
Tel. (310) 859-0100
Fax (310) 388-5645
Email pds@supnik.com


Dana M. Thompson

CERTIFICATE OF PERSONAL SERVICE

I hereby certify that on May 19, 2011 I served the foregoing document described as
**OBJECTIONS TO NOTICE OF DEPOSITION OF PENTHOUSE DIGITAL MEDIA
PRODUCTIONS, INC.** on counsel for Registrant by personally delivering the document listed
above to the person at the address set forth below.

Kirk M. Hallam, Esq.
Law Offices of Kirk M. Hallam
201 Wilshire Boulevard, 2nd Floor
Santa Monica, CA 90401-1219
Tel. (310) 393-4006
Fax (310) 393-4662
Email kmhallam@aol.com

Chris Jahn
PRINT NAME



SIGNATURE

EXHIBIT G

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

<p>PENTHOUSE DIGITAL MEDIA PRODUCTIONS, INC.,</p> <p>Petitioner,</p> <p>v.</p> <p>CLOUDSTREET, INC. DBA ROXBURY ENTERTAINMENT,</p> <p>Registrant.</p>	<p>Cancellation No. 92049926</p> <p>Registration Nos. 3189543; 3194255; 3291736</p> <p>Mark: ROUTE 66</p> <p>Issued: December 26, 2006; January 2, 2007; September 11, 2007</p>
---	---

NOTICE OF DEPOSITION OF
LAWRENCE SUTTER

TO: Kristin L. Holland
Katten Muchin Rosenman LLP
2029 Century Park East
Suite 2600
Los Angeles, California 90067

Floyd A. Mandell
Cathay Y. N. Smith
Katten Muchin Rosenman LLP
525 West Monroe Street
Chicago, Illinois 60661

PLEASE TAKE NOTICE that pursuant to Rules 26, 30 and 37 of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice, Registrant Cloudstreet, Inc. dba Roxbury Entertainment ("Registrant"), by its attorneys, will take the deposition upon oral examination of Lawrence Sutter, Counsel of Penthouse Media Group, Inc. n/k/a FriendFinder Networks Inc. The deposition will commence on Tuesday, May 31, 2011 at 10:00 a.m. EDT, and, if necessary, will continue from day-to-day thereafter until completed or adjourned. The deposition will be taken at the offices

of Fulbright & Jaworski, 666 Fifth Avenue, New York, New York, 10103. The deposition will be conducted before a certified court reporter and may be recorded by sound, sound-and-visual, videotape and/or stenographic means. The deposition may be used for all purposes contemplated under the Federal Rules of Civil Procedure and U.S. Trademark Rules.

Respectfully submitted,

A handwritten signature in cursive script, reading "Kirk M. Hallam", written over a horizontal line.

Kirk M. Hallam
201 Wilshire Blvd., 2nd Floor
Santa Monica, CA 90401
Telephone: (310) 393-4006
Facsimile: (310) 393-4662

Dated: May 5, 2011

CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing **NOTICE OF DEPOSITION OF LAWRENCE SUTTER** was served by first class mail, postage prepaid, on this 4th day of May 2011, upon counsel for Petitioner:

Floyd A. Mandell, Esq.
Cathay Y. N. Smith, Esq.
Katten Muchin Rosenman LLP
525 West Monroe Street
Chicago, IL 60661-3693

Kristin L. Holland
Katten Muchin Rosenman LLP
2029 Century Park East, Suite 2600
Los Angeles, California 90067

STEPHANIE EICHHORN

EXHIBIT H

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

PENTHOUSE DIGITAL MEDIA)	
PRODUCTIONS, INC.,)	
)	CANCELLATION NO.
Petitioner,)	92049926
)	
VS.)	VOLUME I
)	PAGES 1 - 215
CLOUDSTREET, INC. d/b/a ROXBURY)	
ENTERTAINMENT,)	
)	
Registrant.)	
)	

DEPOSITION OF PAUL D. SUPNIK

TAKEN ON

TUESDAY, APRIL 19, 2011

REPORTED BY: KIMBERLY WILDISH

CSR NO. 8078

Page 2

1 DEPOSITION OF PAUL D. SUPNIK, TAKEN ON BEHALF
2 OF THE PETITIONER, AT 2029 CENTURY PARK EAST,
3 SUITE 2600, LOS ANGELES, CALIFORNIA, 90067, AT
4 10:17 A.M. ON TUESDAY, APRIL 19, 2011, BEFORE
5 KIMBERLY WILDISH, CSR NO. 8078, PURSUANT TO SUBPOENA.
6

7 **APPEARANCES:**

10 **FOR THE PETITIONER:**

11 KATTEN, MUCHIN, ROSENMAN, LLP
12 BY: KRISTIN L. HOLLAND, ESQ.
13 CATHAY Y.N. SMITH, ESQ.
14 (TELEPHONIC APPEARANCE)
15 2029 CENTURY PARK EAST
16 SUITE 2600
17 LOS ANGELES, CALIFORNIA 90067
18 310.788.4400

19 FRIENDFINDER
20 VP ASSOCIATE COUNSEL
21 BY: JO-JEAN PANTON, ESQ.
22 6800 BROKEN SOUND PARKWAY NW
23 SUITE 100
24 BOCA RATON, FLORIDA 33487
25 561.912.7009
(TELEPHONIC APPEARANCE)

22 **FOR THE REGISTRANT:**

23 ROXBURY ENTERTAINMENT
24 BY: KIRK M. HALLAM, ESQ.
25 201 WILSHIRE BOULEVARD
SECOND FLOOR
SANTA MONICA, CALIFORNIA 90401
310.393.4006

Page 4

1 INDEX (CONTINUED)

EXHIBITS	
(BOUND UNDER SEPARATE COVER)	
PETITIONER'S DESCRIPTION	PAGE
6 - NOVEMBER 13, 2006 E-MAIL CHAIN BETWEEN PAUL SUPNIK AND KIRK HALLAM (2 PAGES)	72
7 - PLAINTIFF ROXBURY ENTERTAINMENT'S PRIVILEGE LOG (9 PAGES)	124
8 - DECLARATION OF PAUL D. SUPNIK (2 PAGES)	130
9 - REGISTRANT'S INITIAL DISCLOSURES (8 PAGES)	132
10 - SUPPLEMENTAL DECLARATION OF PAUL D. SUPNIK IN SUPPORT OF PLAINTIFF'S REPLY TO MOTION FOR SUMMARY JUDGMENT, OR IN THE ALTERNATIVE, SUMMARY ADJUDICATION (3 PAGES)	136
11 - DOCUMENTS PRODUCED AT DEPOSITION 000001 THROUGH 000065 (66 PAGES)	142
12 - ANSWER TO AMENDED CONSOLIDATED PETITION TO CANCEL (28 PAGES)	179
13 - AMENDED CONSOLIDATED PETITION TO CANCEL (20 PAGES)	186

Page 3

1 INDEX

2 **WITNESS: PAUL D. SUPNIK**

6 **EXAMINATION:**

	PAGE
7 BY MS. HOLLAND	6... 82
8 BY MR. HALLAM	202

11 **EXHIBITS**

12 (BOUND UNDER SEPARATE COVER)

PETITIONER'S DESCRIPTION	PAGE
13 1 - SUBPOENA TO TESTIFY AT A DEPOSITION IN A CIVIL ACTION (4 PAGES)	15
14 2 - DECLARATION OF PAUL D. SUPNIK IN SUPPORT OF PLAINTIFF AND COUNTERDEFENDANT'S MOTION FOR SUMMARY JUDGMENT, OR IN THE ALTERNATIVE, SUMMARY ADJUDICATION (55 PAGES)	28
15 3 - MOTION PICTURES AND TELEVISION TITLES BY PAUL D. SUPNIK (2 PAGES)	63
16 4 - 7/17/2006 E-MAIL CHAIN BETWEEN PAUL SUPNIK AND KIRK HALLAM (2 PAGES)	72
17 5 - 8/15/2006 E-MAIL CHAIN BETWEEN PAUL SUPNIK AND KIRK HALLAM (2 PAGES)	72

Page 5

1 INDEX (CONTINUED)

4 **INFORMATION REQUESTED**
5 **(NONE)**

9 **QUESTIONS INSTRUCTED NOT TO ANSWER**

PAGE:	LINE:	PAGE:	LINE:
11	22 12	87	6
12	23 5	138	21
13	82 18	140	5
14	84 15	143	10

18 **UNANSWERED QUESTIONS**

PAGE:	LINE:	PAGE:	LINE:
19	180 15	188	20
20	185 9	189	6
21	186 18	193	6
22	187 19	193	21

Page 6

1 LOS ANGELES, CALIFORNIA; TUESDAY, APRIL 19, 2011
2 10:17 A.M.

3
4
5 PAUL D. SUPNIK,
6 HAVING BEEN FIRST DULY SWORN, WAS
7 EXAMINED AND TESTIFIED AS FOLLOWS:

8
9 EXAMINATION

10
11 BY MS. HOLLAND:

12 Q. Good morning, Mr. Supnik.

13 A. Good morning.

14 Q. My name is Kristin Holland, and I'm
15 counsel for the Petitioner, Penthouse Digital Media
16 Productions, Inc. in this case.

17 You're an attorney right?

18 A. Yes.

19 Q. Have you ever had your deposition
20 taken before?

21 A. Yes.

22 Q. How many times do you think you've
23 been deposed?

24 A. Probably a couple times, but I don't
25 recall specifically.

Page 7

1 Q. All right. Have you also taken or
2 defended depositions?

3 A. Yes.

4 Q. And how many times have you done that?
5 Just roughly.

6 A. Probably somewhere between 10 and 75.

7 Q. Okay. So you're generally familiar
8 with the procedure for a deposition?

9 A. Yes.

10 Q. Okay. And you understand that the
11 oath you took this morning requires you to tell the
12 truth, as though you were in a court of law?

13 A. Yes.

14 Q. Is there any reason why you can't give
15 your best testimony today?

16 A. No.

17 Q. And if today I ask a question that you
18 don't understand, please let me know that and I'll
19 try and clarify that.

20 Is that all right?

21 A. Yes.

22 Q. Are you counsel of record in this
23 proceeding?

24 MR. HALLAM: Objection; vague and ambiguous.
25 Is he one counsel of record, or sole counsel? I'm

Page 8

1 not sure what question is.

2 I think we're both counsel, at this
3 point, aren't we? I think I submitted an association
4 of counsel.

5 THE WITNESS: I think that's an accurate
6 statement.

7 BY MS. HOLLAND:

8 Q. What is?

9 A. That both Mr. Hallam and myself are
10 counsel of record.

11 Q. Okay. Are you also represented by
12 counsel today?

13 A. No -- well -- yes, I am. I am
14 represented by Mr. Hallam.

15 Q. Okay. When did Mr. Hallam become your
16 lawyer?

17 A. I don't have a specific recollection.

18 Q. Was it within the last month?

19 A. I don't have a specific recollection.

20 Q. Do you have a retainer agreement with
21 Mr. Hallam?

22 A. No, I do not.

23 MR. HALLAM: I'll make it easy for you,
24 Kristin. I'm representing Mr. Supnik for purposes of
25 this deposition.

Page 9

1 MS. HOLLAND: Okay.

2 Q. Are you compensating Mr. Hallam for
3 his services as your attorney?

4 A. No.

5 Q. And you testified that you don't have
6 a specific recollection regarding the date that you
7 engaged him as your counsel, but was it sometime in
8 this calendar year? 2011?

9 A. I don't have a specific recollection
10 of a formal engagement arrangement.

11 Q. What is your general recollection of
12 when Mr. Hallam began his representation of you?

13 A. I'm not sure that I can define that.

14 Q. You don't have any idea?

15 A. I'm sure it was at some point after
16 the proceeding began, but I don't have a specific
17 recollection as to any specific events that would
18 begin an attorney/client relationship.

19 Q. Okay. Have you acted as counsel for
20 Mr. Hallam at any time?

21 A. I have acted as counsel for Roxbury
22 Entertainment.

23 Q. And Mr. Hallam is an officer of
24 Roxbury Entertainment?

25 A. That's my understanding.

3 (Pages 6 to 9)

Page 10

1 Q. When did you begin acting as counsel
2 for Roxbury Entertainment?
3 A. Probably at least five or six years
4 ago.
5 Q. Have you handled any litigation
6 matters, other than the proceedings with the
7 Trademark Trial and Appeal Board that we're
8 discussing today, have you handled any litigation
9 matters for Roxbury Entertainment?
10 A. No.
11 Q. How about for Cloudstreet?
12 A. No.
13 Q. Have you handled any litigation
14 matters for Mr. Hallam personally?
15 A. I don't believe so.
16 Q. And the proceeding that we're here
17 today on is a Cancellation Number 92049926.
18 Other than this cancellation
19 proceeding, are you counsel of record for
20 Cloudstreet, Inc. or Roxbury Entertainment in any
21 other proceedings before the Trademark Trial and
22 Appeal Board?
23 A. No.
24 Q. Are you aware of the basic issues in
25 this cancellation proceeding?

Page 11

1 A. I believe I am.
2 Q. What is your understanding of the
3 issues in this proceeding? Just generally.
4 A. My understanding is that Cloudstreet
5 was seeking to cancel one or more registrations of
6 Penthouse, and Penthouse counter claimed to cancel
7 one or more registrations of Roxbury.
8 MR. HALLAM: Can I make a suggestion for
9 clarity of the record?
10 The witness has referred to Roxbury or
11 Roxbury Entertainment and, also, Cloudstreet.
12 And inasmuch as Roxbury is a DBA of
13 Cloudstreet, Inc., I think we should choose one or
14 the other. Whichever you prefer, Kristin. I don't
15 care. But it will leave a very confused record if we
16 use both.
17 MS. HOLLAND: Okay.
18 Q. Are you aware that the plaintiff,
19 Cloudstreet, Inc. DBA Roxbury Entertainment -- which
20 I'll refer to as Cloudstreet or Roxbury
21 alternately -- but the registrant has identified you
22 as a person with factual knowledge regarding certain
23 issues in this case?
24 A. I am not specifically aware, but that
25 makes sense.

Page 12

1 Q. Did you participate in drafting the
2 initial disclosures identifying witnesses that were
3 submitted by the registrant in this case?
4 A. I don't recall if I did or not.
5 Q. Do you know on what areas you've been
6 identified as a witness with percipient knowledge in
7 this case?
8 A. I don't recall. I don't know if I had
9 knowledge of what was stated, nor what is in such
10 document.
11 Q. Okay. How did you prepare for your
12 deposition?
13 A. I conferred with Mr. Hallam yesterday.
14 I also took a look on the Trademark Trial and Appeal
15 Board website -- not the Trademark Trial and Appeal
16 Board -- the TESS website, to take a look at what
17 went on in the various trademark applications.
18 MS. HOLLAND: That's Mr. Hallam's cell phone.
19 We'll give him a minute.
20 MR. HALLAM: Mr. Hallam apologizes on the
21 record.
22 MS. HOLLAND: That's okay.
23 (CELLULAR TELEPHONIC INTERRUPTION)
24 BY MS. HOLLAND:
25 Q. How long did you confer with

Page 13

1 Mr. Hallam yesterday?
2 A. About two hours.
3 Q. Where did that conference take place?
4 A. At my office.
5 Q. Where is your office located?
6 A. 9401 Wilshire Boulevard, Suite 1250,
7 Beverly Hills.
8 Q. Was anyone else present during that
9 conference?
10 A. No.
11 Q. Did you review any documents during
12 the conference?
13 A. Yes.
14 Q. What did you review?
15 A. I reviewed some e-mails.
16 Q. What e-mails did you review?
17 A. There was e-mail correspondence
18 between Mr. Hallam and myself.
19 Q. Did you bring those e-mails with you
20 today?
21 A. I believe I did. And I believe
22 Mr. Hallam has those e-mails.
23 MR. HALLAM: Those are all the ones that I
24 produced here today, Kristin.
25 MS. HOLLAND: Okay.

Page 14

Page 16

1 Q. Were those the only documents that you
2 reviewed in the conference yesterday?
3 A. I also reviewed a declaration that you
4 had attached to the deposition subpoena.
5 Q. That's your declaration?
6 A. Yes.
7 Q. And you mentioned you looked at the
8 TTAB website. Did you review any documents that had
9 been filed with the TTAB?
10 A. Actually, it wasn't the TTAB website.
11 I looked at the TESS, which is part of the trademark
12 office website.
13 Q. Okay. Did you review any documents
14 from the TESS website during the conference
15 yesterday?
16 A. Very briefly, yes.
17 Q. Which ones?
18 A. And I frankly am not sure, but I was
19 trying to locate the communications with the
20 trademark office in connection with filing of
21 statement of use.
22 Q. Were you looking for communications
23 associated with one of the three ROUTE 66 marks in
24 particular?
25 A. I think, generally. But I think I was

Page 15

1 looking at one in particular.
2 Q. Which one?
3 A. It was the one relating to the
4 amendment of the identification of goods relating to
5 a film series.
6 THE REPORTER: Excuse me.
7 When it's convenient, can I take a
8 quick break?
9 MS. HOLLAND: Sure.
10 (WHEREUPON A RECESS WAS HELD
11 FROM 10:28 A.M. TO 10:33 A.M.)
12 MS. HOLLAND: Let's go back on the record.
13 I would like to mark as Exhibit 1 a
14 copy of the deposition subpoena.
15 (THE DOCUMENT REFERRED TO WAS
16 MARKED AS EXHIBIT 1 AND IS
17 BOUND UNDER SEPARATE COVER)
18 MR. HALLAM: You're marking this as
19 Petitioner's 1?
20 (DISCUSSION HELD OFF THE RECORD)
21 MS. HOLLAND: Back on the record.
22 Mr. Supnik, the reporter has just
23 handed you what we've marked as Exhibit 1, which is
24 the Subpoena to Testify at a Deposition in a Civil
25 Action, directed to you and served by Cathay Smith in

1 my Chicago office.
2 Q. Did you receive a copy of the
3 subpoena?
4 A. Yes, I did.
5 Q. Did you review the rider to the
6 subpoena, which is the last page of Exhibit 1?
7 A. I did see it.
8 Q. Okay. Under there, under the title
9 "Rider to Subpoena," are 11 categories of documents.
10 Do you see that?
11 A. Yes.
12 Q. Did you look for documents responsive
13 to each of those 11 categories?
14 A. Generally.
15 Q. All right. What did you do to look
16 for the documents?
17 A. Well, in part, I communicated with
18 Mr. Hallam.
19 Q. Okay.
20 A. And I took a look at my files and I
21 took a look at the trademark office website.
22 MS. HOLLAND: Okay. Thanks.
23 Let's go off the record for just a
24 second.
25 (PAUSE IN THE PROCEEDINGS)

Page 17

1 MS. HOLLAND: Okay. We're back.
2 Q. So did you prepare any written
3 objections to the document requests in the rider to
4 the subpoena?
5 A. No.
6 Q. All right. And the only documents
7 that you are producing are those that your counsel
8 provided to me today?
9 A. Correct.
10 Q. Were there other documents in your
11 file that would be responsive to the categories in
12 the rider that you didn't bring with you today?
13 A. I don't know it that specifically.
14 Q. Okay. For example, the registrations
15 themselves, do you have those in the file?
16 A. Probably I have photocopies of the
17 registrations in the file.
18 Q. Did you bring those today?
19 A. No, I did not.
20 Q. How about the applications for the
21 registrations? Do you have those in the file?
22 A. Probably those should be in the file.
23 I did not specifically look for them.
24 Q. Okay. And the correspondence relating
25 to the applications and registrations, would that

5 (Pages 14 to 17)

Page 18

1 correspondence be in the file?

2 A. Probably copies of those would
3 probably be in the file, yes.

4 Q. And did you bring those with the
5 correspondence you brought today?

6 A. No, I did not bring the file history
7 with me.

8 MR. HALLAM: And, for the record, I have to
9 state now that there is a stipulation between counsel
10 that was filed in the form of a pleading by the
11 petitioner with the TTAB, that there would be no
12 further discovery in this proceeding, and that we
13 would rely upon the discovery taken in the District
14 Court proceeding relating to these issues.

15 Without waiver of that stipulation,
16 and Respondent's position that discovery is
17 effectively closed by that stipulation, we have
18 produced today all of the communications involving
19 this application that were previously withheld on the
20 grounds of privilege.

21 And we previously produced, I believe,
22 in the District Court proceedings all of those
23 documents that you just referred to; the applications
24 and the registrations, which you used at prior
25 depositions in this matter. Mine among others.

Page 19

1 MS. HOLLAND: All right. So I think our
2 positions on the stipulation have been preserved in
3 different writings, e-mails back and forth, from our
4 office.

5 I'm really just exploring right now
6 what other documents might exist in Mr. Supnik's
7 files which might be responsive to the subpoena that
8 you haven't brought to the deposition. Some of which
9 we may already have copies of and some of which I may
10 not have copies of. I don't know.

11 What I do know is I don't have
12 documents that weren't produced but yet identified as
13 coming from your files, other than what was brought
14 today. And so that's what I'm exploring.

15 And we'll just reserve all rights
16 associated with getting your files. And if we have
17 to open up this questioning again, based on those
18 documents, we'll reserve our right to do so, and I'm
19 sure Mr. Hallam will reserve his right to object.

20 MR. HALLAM: And to prevent that from going
21 forward, but because of our stipulation which
22 Petitioner's counsel filed with the court, that there
23 will be no further or no discovery taken in these
24 proceedings because discovery was taken in the
25 District Court proceedings.

Page 20

1 MS. HOLLAND: I don't think that's what we
2 stipulated to.

3 And I think Mr. Supnik is here because
4 we are engaged in discovery in this case and there is
5 a trial schedule that contemplates discovery.

6 And we did not depose Mr. Supnik nor
7 did we subpoena his file in the District Court
8 action. We have never received a copy of what would
9 be his complete file on the three trademark
10 registrations at issue.

11 MR. HALLAM: And you made a tactical decision
12 in the District Court proceedings not to subpoena
13 Mr. Supnik and not to subpoena documents from
14 Mr. Supnik for whatever reason. And you were well
15 aware of Mr. Supnik as a key witness on the issues
16 pertaining to your counterclaims for cancellation of
17 the Roxbury trademarks on ROUTE 66.

18 Having made that tactical decision, I
19 don't understand why you feel that you're entitled to
20 a second bite at the apple now and, in particular,
21 when you did file with the TTAB a pleading which
22 verified and confirmed the stipulation between
23 counsel that there would be no discovery taken in the
24 TTAB proceedings and that we'd rely instead on the
25 discovery taken in the prior proceeding.

Page 21

1 MS. HOLLAND: We disagree with that. Anyway,
2 my position, I think, has been stated.

3 I just want to clarify that Mr. Supnik
4 was not identified in the disclosures in the District
5 Court proceeding as a percipient witness. He has
6 been identified in the initial disclosures in the
7 cancellation proceeding as a percipient witness.

8 He was served with a subpoena. We
9 didn't receive any objections to it. Some documents
10 were produced and others weren't. And that's the
11 record.

12 So we'll just reserve rights to compel
13 further production and to continue the deposition,
14 based on documents that were called for that aren't
15 privileged and weren't brought today.

16 But we can also just go on. I have
17 plenty of documents to ask questions about.

18 And I don't anticipate re-opening your
19 testimony to ask you questions about documents that
20 are matters of public record.

21 I just needed to know that we've got
22 the complete file; including drafts of applications,
23 drafts of registrations if they exist, correspondence
24 which may not have been public record, e-mails,
25 informal notes of telephone conversations, et cetera,

Page 22

Page 24

1 that might be in your files/that might not be in your
2 files, that I reserve the right to question you about
3 once I get the files.

4 **MR. HALLAM:** And incidentally, since you made
5 a statement that Mr. Supnik was not disclosed in the
6 District Court in the initial disclosures, I believe
7 those initial disclosures were done before your
8 counterclaims were filed and before you sought to
9 stay the District Court proceedings and have the
10 matter transferred to the TTAB.

11 **BY MS. HOLLAND:**

12 **Q.** Mr. Supnik, are you willing to go back
13 to your files and gather the documents that are
14 responsive that you didn't bring today, have them
15 copied and brought to my office?

16 **MR. HALLAM:** I am going to object to that
17 question, on the grounds of attorney/client
18 privilege.

19 What Mr. Supnik will or won't do is
20 going to be determined by our conversations. And you
21 can direct any inquiries in that regard to me, as
22 Mr. Supnik's counsel.

23 **MS. HOLLAND:** Are you instructing your client
24 not to answer?

25 **MR. HALLAM:** Yes.

Page 23

Page 25

1 **MS. HOLLAND:** On the grounds of
2 attorney/client privilege?

3 **MR. HALLAM:** Yes.

4 **BY MS. HOLLAND:**

5 **Q.** Mr. Supnik, are you refusing to
6 provide any other documents in response to the
7 subpoena, other than those that your counsel gave me
8 today?

9 **MR. HALLAM:** Same objection. Same
10 instruction.

11 You can direct those to me, if you
12 would please, as a professional courtesy.

13 **BY MS. HOLLAND:**

14 **Q.** Other than Mr. Hallam, did you speak
15 with anyone about your deposition today?

16 **A.** About it? No. But I told my wife and
17 my daughter that my deposition was being taken today.

18 **Q.** What did you discuss with your
19 daughter about your deposition?

20 **A.** I didn't.

21 **Q.** Just the fact that it was happening?

22 **A.** Yes.

23 **Q.** Mr. Supnik, what do you currently do
24 for a living?

25 **A.** I'm a lawyer.

1 **Q.** Do you have any specialties in your
2 practice of law?

3 **A.** Trademark, copyright and
4 entertainment.

5 **Q.** Do you do transactional work?

6 **A.** Transactional and litigation.

7 **Q.** Both?

8 **A.** Yes.

9 **Q.** How long have you been a lawyer?

10 **A.** Since 1972.

11 **Q.** Where did you go to law school?

12 **A.** Hastings.

13 **Q.** And how long would you say you've been
14 a specialist in trademark, copyright and
15 entertainment law issues?

16 **A.** I've practiced in the intellectual
17 property area since 1972.

18 **Q.** When did you begin practicing
19 specifically in the area of trademarks?

20 **A.** I can't give you a specific time. But
21 probably over the past 20 years my practice has moved
22 more and more to that area.

23 **Q.** How many trademark registration
24 applications have you filed?

25 **A.** Applications?

1 **Q.** Yes.

2 **A.** I have been involved in more than 600
3 applications or some aspect of particular
4 applications.

5 **Q.** And of those 600 or so applications,
6 could you estimate how many resulted in
7 registrations?

8 **A.** My guess -- this is only a rough
9 estimate -- I would say somewhere between 25 to
10 75 percent.

11 **Q.** So anywhere from one in four to three
12 out of four?

13 **A.** Yes. I haven't really analyzed it.

14 **Q.** Have you had any other types of jobs
15 as an adult, other than being a lawyer?

16 **A.** Since what point in time?

17 **Q.** Since...

18 **A.** Since I graduated from college?

19 **Q.** Let's just say since you graduated
20 from college. And you know what? Let me just
21 rephrase that.

22 Have you had any other professions
23 besides being a lawyer since you graduated from
24 college?

25 **A.** No.

Page 26

1 Q. Okay. Where did you go to college?
2 A. UCLA. I graduated from UCLA.
3 Q. Did you go to another school in
4 addition to UCLA?
5 A. I also spent several years at
6 San Diego State.
7 Q. What was your undergraduate degree in?
8 A. Engineering.
9 Q. Any specific type of engineering?
10 A. It was an emphasis on electrical
11 engineering. But UCLA at the time did not have a
12 major in specific forms of engineering, so the degree
13 was in engineering.
14 Q. Are you also a patent lawyer?
15 A. I have a registration as a patent
16 lawyer, yes.
17 Q. So you've taken the patent examiner's
18 test?
19 A. Yes.
20 Q. When did you take that test?
21 A. Probably in about 1972 or 1973.
22 Q. And you've kept it current since then?
23 A. There is no way of or no necessity to
24 keep it current.
25 Q. Okay. No annual dues that you have to

Page 27

1 pay or anything?
2 A. No.
3 Q. Have you ever been arrested?
4 A. Yes.
5 Q. What were you arrested for?
6 A. Soliciting.
7 Q. Soliciting what?
8 A. Door-to-door sales.
9 Q. When were you arrested?
10 A. Probably when I was about 16 or 17 or
11 18. I don't recall specifically.
12 Q. Were you convicted of a crime?
13 A. No.
14 Q. Any other arrests?
15 A. No.
16 Q. What were you selling?
17 A. Encyclopedia Britannica's Great Books
18 of the Western World.
19 MS. HOLLAND: I didn't expect any of that. I
20 thought you would say "No." And then when you said
21 "Yes, for soliciting," I did not expect it to be for
22 Encyclopedia Britannica. So thank you for a series
23 of unexpected twists.
24 All right. Let me mark as Exhibit 2
25 one of your declarations.

Page 28

1 (THE DOCUMENT REFERRED TO WAS
2 MARKED AS EXHIBIT 2 AND IS
3 BOUND UNDER SEPARATE COVER)
4 MS. HOLLAND: Mr. Supnik, Exhibit 2 is a
5 55-page document entitled DECLARATION OF PAUL D.
6 SUPNIK IN SUPPORT OF PLAINTIFF AND COUNTERDEFENDANT'S
7 MOTION FOR SUMMARY JUDGMENT, OR IN THE ALTERNATIVE,
8 SUMMARY ADJUDICATION. And it was filed in the
9 District Court proceeding which is called Roxbury
10 Entertainment versus Penthouse Media Group.
11 Q. You mentioned, in preparing for this
12 deposition, you reviewed a declaration. Is this,
13 Exhibit 2, the declaration that you reviewed?
14 A. Yes.
15 Q. Have you had a chance to read
16 Exhibit 2?
17 A. Yes.
18 Q. Would you like additional time now to
19 look at its contents?
20 A. No. Why don't you ask questions and
21 then we'll see if I need any further review.
22 Q. Okay. That's fine.
23 Did you prepare and file on behalf of
24 Roxbury Entertainment the applications for
25 registration identified in Paragraph 3 of Exhibit 2?

Page 29

1 A. Yes.
2 Q. And those included the application for
3 registration number 3,189,543, which I'll refer to as
4 the DVD video registration.
5 Correct?
6 A. I presume that's the correct number.
7 Yes.
8 Q. Okay. Did those also include
9 registration 3,194,255 which I'll refer to as the TV
10 program registration?
11 A. Yes.
12 Q. And did those also include
13 registration 3,291,736, which I'll refer to as the
14 motion picture series registration?
15 A. Yes.
16 Q. Were you the only trademark attorney
17 for Roxbury for each of these three trademark
18 applications?
19 A. Yes.
20 Q. So you were the person with primary
21 contact with the trademark office for these three
22 applications?
23 A. Yes.
24 Q. Were there any other attorneys
25 involved in the communications with the trademark

Page 30

Page 32

1 office for these three registrations?
2 MR. HALLAM: To your knowledge.
3 THE WITNESS: I'm not aware of any.
4 MS. HOLLAND: Okay.
5 Q. Are you still counsel of record for
6 these three registrations, to your knowledge?
7 A. Well, my understanding is that once a
8 registration issues, there is no attorney of record.
9 Q. All right. Were you involved in any
10 office actions associated with any of these three
11 trademark applications?
12 A. Yes.
13 Q. Specifically, were you involved in an
14 office action issued by the U.S. Patent and Trademark
15 office on May 18th, 2006 relating to application
16 serial number 78664154 relating to the motion picture
17 series registration?
18 A. I can't identify it by that serial
19 number. But we're talking about the third
20 registration; is that correct?
21 Q. Yes.
22 A. Yes.
23 Q. And I'm going to reference Exhibit 4
24 to your declaration, which I believe begins on
25 Page 38 of 55 of Exhibit 2.

Page 31

1 A. Yes.
2 Q. What is the date of this office
3 action?
4 A. You mentioned that it was May 18. I
5 don't see the stamp on it that would have a mailing
6 date. But I...
7 MR. HALLAM: If you don't know, please don't
8 speculate, Mr. Supnik.
9 THE WITNESS: I don't know.
10 MS. HOLLAND: Okay. I'm just looking in your
11 declaration to see if we put a date in there.
12 Q. Referring back to your declaration,
13 Page 8 of 55, Paragraph 23, you state,
14 "On May 19th, 2006 or shortly
15 thereafter, I received from the
16 Examining Attorney an Office Action..."
17 et cetera, referencing Exhibit 4.
18 Does that refresh your recollection
19 about the date of the office action?
20 A. It suggests that the office action was
21 probably on or about May 18th or May 19th or
22 something like that. So May 18 would be consistent.
23 Q. Okay. What is an office action?
24 A. An office action is a communication
25 from a trademark office examining attorney, typically

1 raising issues.
2 Q. And what issues were raised by the
3 office action which begins on Page 39 of 55 of
4 Exhibit 2?
5 A. The issue was that the identification
6 of the goods here was considered indefinite. The
7 typical type of response you receive from the
8 trademark office.
9 Q. And what were the goods at issue in
10 this office action?
11 A. Well, according to the office action,
12 it states that the goods were identified as a series
13 of motion pictures featuring drama, action and
14 adventure.
15 Q. Okay. And the examining attorney from
16 the trademark office wrote,
17 "There is no indication in
18 this description as to the physical
19 nature of the goods, making the
20 description indefinite."
21 Correct?
22 A. Yes.
23 Q. And then the examining attorney
24 further wrote, quote,
25 "The examining attorney

Page 33

1 suggests the following: 'Motion
2 picture film series featuring drama,
3 action and adventure.'
4 Do you see that?
5 A. Yes.
6 Q. Was that suggested language adopted by
7 the applicant Cloudstreet in its response to the
8 office action?
9 A. After discussion with the examining
10 attorney.
11 Q. All right. The examining attorney
12 further wrote,
13 "If the actual goods are
14 not on 'film' but some other medium,
15 applicant must amend accordingly."
16 Do you see that?
17 A. Yes.
18 Q. Were the actual goods on film?
19 A. Yes, in the sense that the original
20 series was shot on film.
21 Q. What do you mean by "original series"?
22 A. I mean that the series that was shown
23 on television in the 1960s was on film, so that it
24 had a certain character to it.
25 Q. Who told you that the original

Page 34

Page 36

1 television series was on film?
2 A. I'm not sure if I heard it from
3 Mr. Hallam first or I just made that assumption that
4 it was on film. Because the old television, I guess
5 I was aware, that the old television series were shot
6 on film.

7 MR. HALLAM: And just for the record, I am not
8 going to be asserting the attorney/client privilege
9 with respect to conversations between myself and
10 Mr. Supnik, even though such a privilege does exist,
11 with respect to conversations that related to the
12 prosecution of these applications for Roxbury's
13 trademarks in ROUTE 66.

14 That is without waiver, however, of
15 the attorney/client privilege between myself and
16 Mr. Supnik with regard to any other conversations
17 that we may have had over the past five or six years.

18 MS. HOLLAND: Okay. I think our position will
19 be that anything that's been put at issue in the
20 declaration or in the initial disclosure description
21 of what testimony the registrant plans to obtain from
22 you, we believe that there is no privilege that can
23 apply to that, because if the registrant plans to
24 rely on it in an affirmative way, we're entitled to
25 cross examine and get to the different communications

1 Well, what do you mean by "on film"?

2 Q. I'm just using the words of the
3 trademark office.

4 A. My -

5 MR. HALLAM: Objection; vague and ambiguous.

6 THE WITNESS: My understanding is that the
7 series was shot on film. And that's based on my
8 knowledge that, back in those days, television series
9 were shot on motion picture film.

10 MS. HOLLAND: Okay.

11 THE WITNESS: So...

12 BY MS. HOLLAND:

13 Q. And when you say "a series," you're
14 referring to the television series?

15 MR. HALLAM: Objection; vague and ambiguous.
16 Can you be more specific?

17 Because you've used the word "series"
18 in two different contexts in the last five minutes.
19 So I don't want the witness to be confused.

20 You mean in his answer to the last
21 question?

22 MS. HOLLAND: I'm just going to object to the
23 speaking objections and ask you, Mr. Hallam, to state
24 your objection and then the witness, who is a
25 sophisticated attorney with plenty of deposition

Page 35

Page 37

1 that might be relevant for the prosecution of our
2 case.

3 So let's just see how far we get.

4 MR. HALLAM: Yeah. I'm not asserting -- as I
5 said -- I'm not asserting the attorney/client
6 privilege with regard to any conversations that
7 relate to the subject matter of this petition to
8 cancel.

9 MS. HOLLAND: Okay. All right.

10 Q. Did you ever physically see any
11 episode or episodes of the original ROUTE 66
12 television series on film?

13 A. On film, when I was growing up, I used
14 to watch it on television.

15 Q. All right. Did you ever see like a
16 film canister containing any of the original
17 episodes?

18 A. No.

19 Q. So when you received, as the
20 corresponding attorney for Cloudstreet, this office
21 action, what investigation did you make as to whether
22 the actual goods were on film?

23 A. I'm not sure if I made any actual
24 investigation as to whether or not the... When you
25 say...

1 experience, to let me know if he didn't understand
2 the question, and I'll try to clarify it.

3 He used the word "series" in his
4 answer.

5 Q. And I'm asking, in your answer to the
6 last question, when you referred to "series" were you
7 referring to the television series being shot on
8 film?

9 A. I was referring to the television
10 series that was shot on film. Yes.

11 Q. Now, in response to this office action
12 which relates to a request for a registration of a
13 series of motion pictures, what is the basis for...
14 Let me back up.

15 Do you believe that the series of
16 motion pictures that Cloudstreet or Roxbury was
17 seeking to register was on film?

18 A. My sense is that it was on film. I
19 think there was an issue in my mind, because there is
20 a big ambiguity there.

21 Q. What is the ambiguity?

22 A. Well, the ambiguity is: What do you
23 mean by "a motion picture film series"?

24 Does that mean a motion picture film
25 series that was shot on film? Or does that mean is

Page 38

Page 40

1 it a motion picture that was physically distributed
2 on 35-millimeter film to theaters?
3 And I see that as an ambiguous issue.
4 Q. Okay. Well, let me back up again.
5 Has there been a ROUTE 66 motion
6 picture produced by Roxbury or Cloudstreet, to your
7 knowledge?
8 MR. HALLAM: Objection; vague and ambiguous.
9 THE WITNESS: Do you mean was there a motion
10 picture produced by Cloudstreet other than those
11 which were originally shot during, let's say, the
12 1950s and '60s?
13 MS. HOLLAND: Yes.
14 THE WITNESS: And the answer is: I have no
15 knowledge of them.
16 BY MS. HOLLAND:
17 Q. So what motion picture film series
18 were you asking the trademark office to register with
19 this application for registration?
20 A. The basis were the original '60 series
21 which were shown at various -- or I guess -- several
22 film festivals.
23 Q. So you were asking the trademark
24 office to register as a motion picture series the
25 episodes of the television series which had been

Page 39

1 shown at film festivals?
2 A. Yes.
3 Q. How do you know that they were shown
4 at film festivals?
5 A. I received the specimens from
6 Mr. Hallam or Mr. Hallam's office and verbal
7 conversations.
8 Q. But you didn't attend any of the film
9 festivals yourself?
10 A. No.
11 Q. And do you know if the exhibitions at
12 those film festivals were made using film?
13 And by "film," I mean the same type of
14 film that you referred to as being used for the
15 original television series. Or were they made in
16 some other medium?
17 MR. HALLAM: Objection; vague and ambiguous,
18 as to the meaning of the word "made."
19 THE WITNESS: My understanding is that the
20 films were originally shot on film.
21 MS. HOLLAND: I understand that. I understand
22 that.
23 Q. I'm asking you now: What particular
24 medium was used at the film festivals to display the
25 episodes in the theaters for the people who

1 presumably watched them?
2 A. I do not know the specifics. But my
3 understanding was that it was probably a DVD that was
4 shipped to the theaters.
5 Q. Did you tell the trademark examining
6 attorney that these motion pictures had only been
7 exhibited on DVD?
8 A. Yes.
9 Q. How did you convey that information?
10 A. I had a telephone conversation with
11 the examining attorney, after which I believe an
12 examiner's amendment was sent out.
13 I raised the issue, I didn't get any
14 response, and that was pretty much it.
15 Q. Okay. Let's focus on that telephone
16 conversation for a moment.
17 Did it occur after you received the
18 office action that we've been discussing?
19 A. Yes.
20 Q. Who initiated the call?
21 A. I initiated the call.
22 Q. Who did you speak to?
23 A. I believe the examining attorney,
24 whose name is Jill Alt.
25 Q. Is Ms. Alt's name referenced on the

Page 41

1 office action?
2 A. Yes.
3 Q. Where is it referenced?
4 A. At the bottom of Page 40 on the
5 declaration.
6 Q. Okay. Where it says "/Jill C.
7 Alt/Trademark Attorney," et cetera?
8 A. Yes.
9 Q. Okay. So you called Ms. Alt at the
10 telephone number, the (571) number listed on Page 40?
11 A. Presumably.
12 Q. Okay. Did you send her any e-mails?
13 A. No.
14 Q. And was anyone else on the telephone
15 call between you and Ms. Alt?
16 A. Not to my knowledge.
17 Q. How many times did you call her?
18 MR. HALLAM: Objection; vague and ambiguous.
19 You mean specifically with a request
20 from this office action?
21 MS. HOLLAND: You can start with that.
22 Q. With respect to this office action,
23 how many times did you call Ms. Alt?
24 A. I only have a recollection of one
25 conversation with her, I believe, with respect to

11 (Pages 38 to 41)

Page 42

Page 44

1 this office action.

2 Q. And when approximately, or how long
3 after you received the written office action, would
4 you estimate the call took place?

5 A. I think it was a long time. I think
6 it was just before the expiration of the date to
7 respond.

8 Q. So several months?

9 A. More than several months.

10 Q. What was the deadline to respond to
11 the office action?

12 A. I don't recall specifically, but it's
13 six months. Six months after the office action.

14 Q. Okay. So if the office action came in
15 mid May of '06, you estimate that your conversation
16 with Ms. Alt occurred maybe in November of 2006?

17 A. Wait a minute. Say it again.
18 If the office action was...

19 Q. In May of '06.

20 A. May. So six months would be November.
21 Yes.

22 Q. Okay. How long was that conversation?

23 A. I couldn't tell you. It might not
24 have been very long. It might have been five
25 minutes.

1 reserve our positions on that.

2 At this point, I am looking for the
3 best way to establish the date of your conversation
4 with Ms. Alt. Which might be that time record, if
5 you kept that level of detail. I don't know.

6 Q. All right. So when you called
7 Ms. Alt, what was the purpose of your call?

8 A. It was specifically to deal with this
9 particular issue.

10 Q. The particular issue, which is: Are
11 the actual goods on film?

12 A. That's the issue. Yes.

13 Q. Okay. And what do you recall saying
14 to Ms. Alt during the conversation?

15 A. I don't have a specific recollection
16 of what I said to her and what she said to me. But
17 generally, I remember I called her up. I may have
18 talked to her about the medium of distribution. I'm
19 not sure.

20 But I said, you know, "The specimens
21 that I have shows that the film was distributed at a
22 film festival." I believe I said, "They were on
23 DVDs. Does that matter?"

24 And I didn't get a response from her.

25 Q. Okay. What do you recall Ms. Alt

Page 43

Page 45

1 Q. Would you have recorded the time spent
2 speaking with Ms. Alt on a time sheet?

3 A. It's possible.

4 Q. Did you bring any time sheets with you
5 today?

6 A. No, I did not.

7 Q. For your work on these registrations,
8 did you bill by the hour to Cloudstreet or Roxbury?

9 A. Yes.

10 Q. Do you still have your time records
11 associated with your work on the registrations?

12 A. I don't know if I do or not.

13 MR. HALLAM: For the record, I will have
14 Mr. Supnik -- I'll ask Mr. Supnik -- to review his
15 bills. And I will do likewise, to see if there are
16 any time entries in the bill for November.

17 I don't want nor would I allow
18 Mr. Supnik to generally produce all of his bills to
19 Roxbury Entertainment, but I will have him look for
20 that, and any other specific ones that you have.

21 MS. HOLLAND: Okay.

22 Well, to the extent the bills are
23 responsive to the subpoena and that they relate to
24 the statements that you've made in the declarations,
25 we believe we're entitled to them. But we can both

1 saying during the conversation?

2 A. I heard her say -- I think I remember
3 her saying something about -- pretty much what she
4 said in the office action. That this: "You need to
5 specify whether it's on film or if it's on some other
6 medium."

7 And then I explained the method of
8 distribution, and so I don't think I got a response.

9 Q. Did you have any discussions with
10 Ms. Alt about the fact that the contents of the film
11 consisted of certain episodes of a television series?

12 A. I think I did. I think I said, "This
13 is the old television series, ROUTE 66."

14 Q. Do you recall whether she made any
15 comments or said anything about that?

16 A. I do not recall.

17 Q. Okay.

18 A. What I recall -- what I specifically
19 do recall -- it was a lack of response on her part.

20 Q. And what did you interpret that to
21 mean?

22 A. I wasn't sure.

23 Q. So you couldn't tell if it meant she
24 was concerned or if it meant she wasn't concerned?
25 You have no...

Page 46

1 A. I couldn't tell.
2 Q. Okay. Let me go back to the language
3 of the office action again. In the next paragraph,
4 Ms. Alt writes,
5 "Please note that, while
6 the identification of goods may be
7 amended to clarify or limit the goods,
8 adding to the goods or broadening the
9 scope of the goods is not permitted."
10 Do you see that language?
11 A. Yes.
12 Q. Do you have any opinion or
13 interpretation of what that means?
14 A. Well, it basically means you can't add
15 goods beyond the scope of what's already existing in
16 the original application -- original ITU --
17 application.
18 Q. So give me an example of a good that
19 couldn't be added.
20 A. Computers.
21 Q. Okay. So the original description of
22 the applicant was a "Series of motion pictures
23 featuring drama, action and adventure."
24 A. Yes.
25 Q. That's accurate?

Page 47

1 A. (NO AUDIBLE RESPONSE)
2 Q. A "Series of motion pictures featuring
3 drama, action and adventure."
4 Right?
5 A. Yes.
6 Q. Okay. And then Ms. Alt suggested that
7 it be changed to "Motion picture film series
8 featuring drama, action, and adventure."
9 Right?
10 A. Yes.
11 Q. So she added the word "film" and
12 shifted the position of the word "series," basically?
13 A. Yes.
14 Q. Would you agree that film is a
15 different medium than DVD?
16 A. It depends upon whether you're talking
17 about its original creation.
18 I think it depends upon the context in
19 which you're using that.
20 Q. In this context, the actual goods,
21 meaning the motion pictures as exhibited, were never
22 on film.
23 Correct?
24 A. Well, in the sense it has absolutely
25 no meaning. It has a confusing meaning to begin

Page 48

1 with, because we have a Class 9 series which is for
2 trademarks. But we're talking about something that
3 is exhibited in a motion picture. So it's really
4 somewhat confusing as to just what we're talking
5 about.
6 So if we're talking about a motion
7 picture film series, I associate that...
8 I'm confused. What was the question?
9 Q. Let me try a different question.
10 Let's just approach it differently.
11 So how many motion pictures were there
12 in the series?
13 A. Well, I know that there were at least
14 two.
15 Q. Okay. What were those two?
16 A. I don't know the answer to that.
17 Q. What were the titles of the two motion
18 pictures in the series?
19 A. I don't recall.
20 Q. Do you know if both of the motion
21 pictures used the mark ROUTE 66 in the title?
22 A. My understanding is and my assumption
23 was that, yes, they do have ROUTE 66 in the title.
24 Q. How were the two motion pictures
25 distinguished from one another in the title?

Page 49

1 A. In title? Well, my recollection is I
2 took a look at one or more of a series of ROUTE 66
3 DVDs which were shot on film. And when you saw the
4 series, each time you would see the title credit as
5 ROUTE 66.
6 Q. So each motion picture in a series --
7 each of the two -- was called ROUTE 66?
8 A. That's my understanding. They would
9 have a separate episodic title. And I don't know
10 which ones those were. But each in the series would
11 have ROUTE 66 as the title card.
12 Q. And did either of those two motion
13 pictures contain any newly-shot footage? Meaning any
14 footage that wasn't part of the original television
15 series, to your knowledge?
16 A. Not to my knowledge.
17 Q. Did they include any additional
18 voiceovers or narration that was not part of the
19 original television series, to your knowledge?
20 A. I have no information about that.
21 Q. Did they include any materials at
22 all -- at the beginning, or the end, in the middle,
23 anywhere in the contents -- that were not part of the
24 original television series, to your knowledge?
25 A. I have no knowledge of that.

13 (Pages 46 to 49)

Page 50

1 Q. Did you make any investigation to see
2 if they were at all, in any way -- even in part --
3 consisting of any original material?
4 MR. HALLAM: Objection; vague and ambiguous.
5 What do you mean by "original material"?
6 All the episodes are original
7 material.
8 MS. HOLLAND: I mean original... Let me
9 change the word to "new."
10 New material.
11 THE WITNESS: I have no knowledge of that.
12 BY MS. HOLLAND:
13 Q. Did you receive complete DVD, like
14 playable DVD, versions of the motion pictures?
15 A. What I received was in a package, a
16 shrink-wrap package, that I had to take out of the
17 package to be able to see the DVDs. Yes.
18 Q. Did you play the DVDs?
19 A. Yes. Not all of them, but I played
20 several episodes.
21 Q. Okay. And when you say you played
22 several episodes, do you mean you played one of the
23 motion pictures? Or two? I'm getting confused.
24 So what did you play?
25 A. I played... And I considered each

Page 51

1 episode to be a separate motion picture, for purposes
2 of this particular class. But, yes, I played several
3 of them.
4 And my understanding was that this is
5 what was shown and was exhibited at the film
6 festival.
7 Q. So are you saying that you consider
8 each episode of the television series a separate
9 motion picture?
10 A. Yes, I do.
11 Q. Do you know whether each episode of
12 the television series was exhibited at a film
13 festival?
14 A. I don't have any knowledge of that.
15 Q. So, in your view, would any television
16 series originally shot on film -- 35-millimeter or
17 16-millimeter, for example -- would any television
18 series like that also be a motion picture series?
19 A. It could be.
20 MS. HOLLAND: Can we go off the record for
21 just a moment?
22 (PAUSE IN THE PROCEEDINGS)
23 BY MS. HOLLAND:
24 Q. So referring back to Exhibit 2.
25 Page 29 of 55 of that exhibit is a Trademark/Service

Page 52

1 Mark Application, Principal Register Serial Number:
2 78664154.
3 Do you see that, Mr. Supnik?
4 A. Yes.
5 Q. Does that relate to the motion picture
6 registration that we've been discussing?
7 A. (NO AUDIBLE RESPONSE)
8 Q. My records indicate it does. But I
9 just want to clear that up with you.
10 A. Yes. It looks like it does.
11 Q. So that's an application for
12 registration in International Class 9?
13 A. Yes.
14 Q. And the "DESCRIPTION" there is the
15 original unmodified description: "Series of motion
16 pictures, featuring drama, action and adventure;
17 DVD's; videocassettes"?
18 A. Yes.
19 Q. Do you see that?
20 A. Yes.
21 Q. And on this first use date "FIRST USE
22 ANYWHERE DATE" ...
23 A. Yes.
24 Q. ... "At least as early as 09/30/1960"?
25 A. Yes.

Page 53

1 Q. What does that date represent?
2 A. My understanding was that was a date
3 when the television series was broadcast.
4 Q. In 1960 was it broadcast as a motion
5 picture in theaters? If you know.
6 A. Well, my understanding, it was not
7 exhibited in motion picture theaters. I don't have
8 any knowledge of that, if it was.
9 Q. And the specimens attached to this
10 application for the motion picture series
11 registration were the opening title screen from the
12 television series; is that correct?
13 A. That's what it says here, and that
14 does make sense. Yes.
15 Q. Was this application later divided
16 into three?
17 A. Yes.
18 Q. And how was it divided?
19 A. My recollection is that the child
20 applications were the Class 41 -- well -- I believe
21 the Class 9 applications were divided in two.
22 And I believe the DVD and
23 videocassette application and the Class 41 services
24 were made into child applications, so that they could
25 go forward with the registration.

14 (Pages 50 to 53)

Page 54

Page 56

1 Q. We'll look at some more documents to
2 clarify that.
3 All right. In response to the office
4 action which begins on Page 39 of Exhibit 2, did the
5 applicant amend its description of goods?
6 A. Say that again. In response to this
7 office action was there an amendment?
8 Q. Yes.
9 A. And my recollection was that, I
10 believe, there was an examiner's amendment.
11 Q. All right. Is the examiner's
12 amendment that you're referring to on Page 43 of
13 Exhibit 2?
14 A. Yes.
15 Q. That's an examiner's amendment by
16 Ms. Alt?
17 A. Yes.
18 Q. In which she amends the Class 9 goods
19 description as follows: "Motion picture film series
20 featuring drama, action and adventure"?
21 A. Yes.
22 Q. So after this examiner's amendment,
23 what was the Class 9 goods description for
24 application 78664154?
25 A. It was what was stated in the

Page 55

1 examiner's memo.
2 Q. "Motion picture film series featuring
3 drama, action, and adventure"?
4 A. Yes.
5 Q. What is a notice of allowance?
6 A. A notice of allowance is a document
7 that the trademark office sends after the mark has
8 been published for opposition.
9 Essentially, saying that the trademark
10 application is ready and is available to be issued
11 once there is proof of use.
12 Q. Okay. So if you look at Page 46 of
13 Exhibit 2, it's Trademark/Service Mark Statement of
14 Use.
15 A. Um-hmm.
16 Q. For application serial number
17 78664154, which is International Class 9. And this
18 again relates to the motion picture series
19 registration.
20 Correct?
21 A. Yes.
22 Q. All right. What is the representation
23 in this document regarding the first use anywhere
24 date of the motion picture series mark?
25 A. I believe that means that the mark was

1 used in connection with the goods at least as early
2 as the date stated.
3 Q. All right. So in this document, the
4 first use anywhere date is May 7, 2007, correct?
5 A. Correct.
6 Q. All right. Now, in the original
7 application, the first use date anywhere was 1960,
8 correct?
9 A. For the television series, yes.
10 Q. But you testified earlier that the
11 motion picture series registration was supposed to
12 apply to the entire television series. Or did I
13 misunderstand you?
14 A. Well, the point is that it means that
15 a mark is used in connection with a series. And the
16 series can be more than one of the episodes.
17 So if you have more than one episode
18 that's being exhibited, my understanding would be
19 that that's going to be satisfactory.
20 Q. All right. Let's focus on Page 46,
21 again, of Exhibit 2. The first use anywhere date of
22 May 7, 2007, what does that refer to?
23 MR. HALLAM: Objection; asked and answered.
24 THE WITNESS: My recollection is that it has
25 something to do with the exhibition date.

Page 57

1 BY MS. HOLLAND:
2 Q. Does it relate to the specimens that
3 were attached to the statement of use?
4 A. If we're saying that the specimens
5 would be this image of the two people looking at the
6 lobby card and the photograph from within the
7 screening room? Yes.
8 Q. At Pages 49 and 50 of Exhibit 2?
9 A. Yes.
10 Q. So the May 7, 2007 date refers to the
11 screening date?
12 A. That was my understanding.
13 Q. All right. And what does "use in
14 commerce" mean, with respect to a motion picture
15 series?
16 A. Well, it's another one of those issues
17 that's very vague.
18 It means that... "Use in commerce"
19 means it's something that congress can regulate in
20 some manner.
21 So, for example, if African Americans
22 were excluded from being able to see or to go into
23 that festival and see a motion picture or, you know,
24 some sort of discrimination were involved, then
25 congress could regulate that, based on the part of

15 (Pages 54 to 57)

Page 58

Page 60

1 Atlanta Hotel case.
2 So that probably is enough. It
3 doesn't take very much to establish use in commerce.
4 That's one aspect of use in commerce.
5 The other aspect is the fact that there was some sort
6 of transfer of goods in commerce to get to where the
7 film was exhibited. So that's use in commerce.
8 Also, people most likely came from
9 outside. Out of state. They may not be in very
10 large numbers, I don't know specifically. But I
11 would imagine if you have a film festival in Florida,
12 you would have at least a few people coming from
13 outside of Florida to see that film festival.
14 So all of these types of uses could
15 result in use in commerce.
16 Q. Do you know whether the motion picture
17 series was ever exhibited outside of Florida?
18 A. I don't have any knowledge of that.
19 Q. Do you know how many theaters
20 exhibited the motion pictures?
21 A. I don't have knowledge of that.
22 Q. Do you know if it was more than one?
23 A. I do not know.
24 Q. Do you know how many times the motion
25 pictures were exhibited publicly?

1 A. My understanding was it was in
2 Fort Lauderdale.
3 Q. Do you know the name of the theater at
4 which it was playing?
5 A. No. No.
6 Q. Do you know if any tickets were sold
7 to the public performance?
8 A. Tickets were sold?
9 No, I do not know.
10 Q. Do you know how many people actually
11 attended the public performance?
12 A. No, I don't.
13 Q. So referencing again that date of use,
14 the May 7, 2007, are there any documents that you are
15 aware of which would show whether the ROUTE 66 mark
16 was being used in commerce on a motion picture
17 series?
18 A. I am not aware of any other specific
19 documents that would show that. I don't have... I
20 don't believe I ever saw any other documents.
21 Q. Other than the two specimens attached
22 to the statement of use?
23 A. I don't recall seeing any other
24 documents like that.
25 Q. Okay. So the only documents that you

Page 59

Page 61

1 A. No.
2 Q. Do you know if it was more than once?
3 A. I don't know.
4 Q. Do you know for sure that it even
5 happened once?
6 A. It's from what I'm told.
7 Q. Do you know, for the specimen on
8 Page 49, whether that's a public space or a private
9 space?
10 A. I don't know the answer to that. And
11 I also don't know what you mean by "public" and
12 "private" space.
13 Q. Do you know who is on Page 50 in the
14 specimen? On Page 50, of the two people looking at
15 the "COMING SOON" poster?
16 A. I do not know.
17 Q. Do you know who those people are?
18 A. No.
19 Q. Do you know where it was coming soon?
20 A. My assumption was that it was at the
21 venue where the film was exhibited.
22 Q. And see how the poster also says
23 "NOW PLAYING"?
24 A. Yes.
25 Q. Do you know where it was playing?

1 are aware of which support the statement of use are
2 the two specimens that you attached to that
3 statement?
4 A. That's correct.
5 Q. And how about documents of any kind?
6 Maybe contracts or receipts, documents evidencing
7 payment for duplication services and the like.
8 Basically business records.
9 Are you aware of any types of
10 documents which would support that the applicant
11 produced a ROUTE 66 motion picture film series?
12 MR. HALLAM: Objection; calls for speculation.
13 THE WITNESS: I don't have any knowledge of
14 any documents.
15 BY MS. HOLLAND:
16 Q. Have you ever registered a motion
17 picture film series for any other applicant besides
18 Roxbury or Cloudstreet?
19 A. Completed to registration?
20 Q. Yes.
21 A. I may have, but I don't recall.
22 Q. Do you recall any applications for a
23 motion picture film series, whether or not they were
24 completed to registration, for other clients?
25 A. I probably have, but I'm not

Page 62	Page 64
<p>1 specifically sure.</p> <p>2 Q. Have you made any statements on the</p> <p>3 Internet or on any blogs or in any public place about</p> <p>4 how to obtain a motion picture series registration?</p> <p>5 A. I don't recall.</p> <p>6 Q. Do you operate a website?</p> <p>7 A. Yes.</p> <p>8 Q. What is the website called?</p> <p>9 A. Supnik.com.</p> <p>10 Q. And what generally is the purpose of</p> <p>11 that website?</p> <p>12 A. It's essentially a public relations</p> <p>13 website that has lots of information concerning a</p> <p>14 wide variety of subjects in the intellectual property</p> <p>15 area, Federal Court litigation, and international</p> <p>16 law. And just some general entertainment industry</p> <p>17 information and the likes.</p> <p>18 Q. Who creates the content for</p> <p>19 Supnik.com?</p> <p>20 A. Well, the links are created by people</p> <p>21 other than myself. And the specific material, I may</p> <p>22 create myself.</p> <p>23 Q. All right. Do you recall creating a</p> <p>24 document called "Motion Picture and television titles</p> <p>25 by Paul D. Supnik"?</p>	<p>1 A. I didn't see any.</p> <p>2 Q. Okay. There are 17 points on the</p> <p>3 first page. And then the second page is basically</p> <p>4 your contact information and, you know, what looks to</p> <p>5 me to be standard language about "don't rely on this</p> <p>6 advice," et cetera.</p> <p>7 So on the first page, in those 17</p> <p>8 points, did you see anything that you would like to</p> <p>9 correct?</p> <p>10 A. No.</p> <p>11 Q. All right. Do you know if the</p> <p>12 ROUTE 66 motion pictures had any merchandising?</p> <p>13 A. At any time? I'm not aware of any.</p> <p>14 Q. And in point 14 you reference "the</p> <p>15 so-called franchise motion picture."</p> <p>16 What do you mean by a franchise motion</p> <p>17 picture?</p> <p>18 A. "Superman." A film that uses a title</p> <p>19 for sequels.</p> <p>20 Q. All right. Would you consider the</p> <p>21 ROUTE 66 motion picture as a franchise motion picture</p> <p>22 series?</p> <p>23 A. I consider that within that genre of</p> <p>24 type of properties, because it was such an iconic</p> <p>25 series for the time that I was growing up.</p>
Page 63	Page 65
<p>1 A. That does sound familiar, yes.</p> <p>2 Q. Copyright 1999? Does that ring a</p> <p>3 bell?</p> <p>4 A. The 1999 doesn't, but I do recall that</p> <p>5 does sound familiar.</p> <p>6 MS. HOLLAND: Okay. I'm going to mark as</p> <p>7 Exhibit 3 a printout from Supnik.com called "Motion</p> <p>8 picture and television titles by Paul D. Supnik."</p> <p>9 (THE DOCUMENT REFERRED TO WAS</p> <p>10 MARKED AS EXHIBIT 3 AND IS</p> <p>11 BOUND UNDER SEPARATE COVER)</p> <p>12 MS. HOLLAND: I'll give you a moment to read</p> <p>13 that document, Mr. Supnik. Let me know when you're</p> <p>14 finished.</p> <p>15 (WITNESS REVIEWS DOCUMENT)</p> <p>16 THE WITNESS: Okay.</p> <p>17 BY MS. HOLLAND:</p> <p>18 Q. Okay. Are there any statements in</p> <p>19 this document that you would like to correct or that</p> <p>20 you now disagree with?</p> <p>21 A. I didn't see any.</p> <p>22 MR. HALLAM: Objection; compound. Vague and</p> <p>23 ambiguous.</p> <p>24 BY MS. HOLLAND:</p> <p>25 Q. You didn't see any?</p>	<p>1 Q. You also state in this document,</p> <p>2 Exhibit 3, bullet point 14, "Registration of motion</p> <p>3 picture titles are rarely made..."</p> <p>4 What do you mean by that?</p> <p>5 A. Well, usually you have one motion</p> <p>6 picture, and a lot of money is spent on a motion</p> <p>7 picture. It's exhibited, and it goes off the screen,</p> <p>8 and it never appears again in any other form.</p> <p>9 Unlike ROUTE 66, where you have had</p> <p>10 this constant impact of the mark, every week on</p> <p>11 television, where millions of people view the series.</p> <p>12 So a single motion picture, the</p> <p>13 trademark office will not allow registration of a</p> <p>14 single motion picture or title of a single motion</p> <p>15 picture as a mark.</p> <p>16 Q. So you mentioned "Superman."</p> <p>17 Are you aware of a television series</p> <p>18 called "Superman"?</p> <p>19 A. I don't recall, frankly.</p> <p>20 Q. All right.</p> <p>21 A. Oh, yeah, I mean, I saw it. I think</p> <p>22 that's where... I think it started with a... It</p> <p>23 didn't start.</p> <p>24 It started with the comic book series,</p> <p>25 then a television series in the '50s, I think. Yes.</p>

Page 66

Page 68

1 Q. Okay. But when you were referring to
2 the motion picture series "Superman" you weren't
3 referring to the television series?

4 A. That's correct.

5 Q. What were you referring to?

6 A. I was referring to a series of motion
7 pictures probably that's been out in the past 15
8 years.

9 Q. Okay. Featuring, for example,
10 Christopher Reeve?

11 A. Probably.

12 Q. Okay. And Gene Hackman in one or more
13 of them?

14 A. That I don't recall.

15 Q. All right. Do you know if the actors
16 in the motion picture series were different than the
17 actors in the television series for "Superman"?

18 A. I should know this. And I won't tell
19 you why.

20 But there was a change of actors.

21 Q. Was the motion picture series filmed
22 at a different time than the television series?

23 A. Well, presumably it was. Presumably
24 it was many years later.

25 Q. And the "Superman" motion pictures

1 Q. Even if what they were going to
2 exhibit was exactly the same episodes that are
3 exhibited on AMC.

4 A. As long as it was a series. If it's
5 more than one episode, yes.

6 And do I think it's crystal clear?

7 No. I don't think that the trademark office has...

8 That the identification of goods and services
9 completely makes sense as a coherent package, as to
10 what titles and where titles fit within Class 9 and
11 Class 41.

12 I have not been able to find any of
13 that information to really make things crystal clear.
14 No.

15 MS. HOLLAND: Let's refer back to Exhibit 2.

16 And, gentlemen, just so you know where
17 I'm going, I would like to finish my motion picture
18 questions before we break for lunch, and then break
19 for lunch -- I don't know -- in the next 20 minutes?

20 If that's all right with you. We can
21 take an hour break and come back after lunch.

22 MR. HALLAM: That's fine with me.

23 THE WITNESS: Yes.

24 (DISCUSSION HELD OFF THE RECORD)

25 ///

Page 67

Page 69

1 that you were referring to, were those exhibited in
2 wide release theatrically? Just to the best of your
3 recollection.

4 A. Probably. But when I gave you the
5 example of "Superman," that's the first thing that
6 came to my mind.

7 I don't have specific knowledge as to
8 exactly what trademarks are registers for Superman.
9 But that's an obvious, extreme example of what I
10 would call a franchise motion picture.

11 Q. Okay. Let me give you another
12 example. What current television series do you
13 watch? Just one of them.

14 A. "60 Minutes."

15 Q. Okay. Something fictional. Something
16 scripted.

17 A. "Mad Men."

18 Q. "Mad Men." Okay. So would "Mad Men,"
19 the television series on AMC, would that also be
20 something that, if they contacted you and said, "We
21 want to register this a motion picture series," do
22 you think it would be something that you would apply
23 for as a motion picture series?

24 A. If they were going to exhibit it in a
25 theater? Possibly.

1 BY MS. HOLLAND:

2 Q. Referencing your declaration. We're
3 going to start at Paragraph 17, which is on Page 7 of
4 Exhibit 2. And let's skip ahead to Paragraph 19,
5 actually. Paragraph 19, on Page 8, you say,

6 "First, I prepared for
7 Roxbury's filing on July 6, 2005,
8 an 'Intent to Use' application
9 which combined the Motion Picture
10 Registration in International
11 Class 9 with an Intent to Use
12 application for the DVD/Videocassette
13 Registration, also in Class 9, and
14 a Current Use application for the
15 Television Program Registration in
16 Class 41."

17 Do you see that?

18 A. Yes.

19 Q. All right. Why did you initially file
20 the motion picture application on an intent to use
21 basis?

22 A. I was not satisfied at the time that
23 the mark had been used in connection with everything
24 in the application.

25 Q. All right. And then you later

Page 70

1 modified the date of first use for the motion picture
2 series to May of 2007, right?
3 A. Yes.
4 Q. All right. So I'm trying to
5 understand then your earlier testimony about the
6 television series, once exhibited publicly, could
7 qualify as a motion picture series.
8 And I may be paraphrasing it too much
9 or too little or incorrectly, but that's what I'm
10 referring to.
11 If you believe that the television
12 series itself on film, once exhibited in a theater,
13 would qualify for registration as a motion picture
14 series, why did you prepare the file as an intent to
15 use in July of 2005 for the motion picture series
16 registration?
17 A. Well, first, my understanding was that
18 it really hadn't been exhibited in the theater at
19 that point in time. And probably I had some question
20 about that issue.
21 As I said, it's not crystal clear.
22 Q. In Paragraph 20, you reference that,
23 "I understood that Roxbury was
24 preparing a motion picture film series
25 featuring various combined episodes

Page 71

1 of the Route 66 Television Programs
2 for exhibitions in theaters and
3 other public venues."
4 Do you see that?
5 A. Yes.
6 Q. Okay. What was the basis of your
7 understanding?
8 A. The basis of the understanding was
9 probably a telephone conversation with Kirk Hallam.
10 Q. And then you go on that,
11 "...I understood from
12 Roxbury had been suggested by the
13 original creator and producer of
14 the Route 66 Television Programs
15 a few years earlier, and which
16 Roxbury intended to implement."
17 When you say you understood from
18 Roxbury, are you again referring to Mr. Hallam?
19 A. Yes.
20 Q. And then when you reference the
21 original creator and producer of the ROUTE 66
22 television programs, who are you referring to?
23 A. The... I don't remember the name of
24 the individual. But, again, this is what was
25 presented to me from Mr. Hallam.

Page 72

1 Q. Okay. Who drafted this declaration?
2 A. Mr. Hallam probably drafted it
3 initially.
4 Q. All right.
5 A. I'm making the assumption. I don't
6 have personal knowledge of that. But I received it
7 from him.
8 Q. Do you remember writing this
9 declaration yourself?
10 A. My recollection is that I probably
11 modified it in some way.
12 MS. HOLLAND: Okay. In the documents you
13 produced today, there were a couple e-mails
14 referencing the office action related to the motion
15 picture. I'll just find those.
16 I would like to mark these three
17 e-mails as Exhibits 4, 5 and 6.
18 (THE DOCUMENTS REFERRED TO WERE
19 MARKED AS EXHIBITS 4, 5 AND 6 AND
20 ARE BOUND UNDER SEPARATE COVER)
21 MS. HOLLAND: Okay. We've marked as Exhibit 4
22 an e-mail dated July 17, 2006. The first one is from
23 KM Hallam to Paul Supnik, and it's Bates numbered
24 000033 through 34.
25 Q. Do you see that document?

Page 73

1 A. Yes.
2 Q. It begins with an e-mail from you,
3 Mr. Supnik, dated July 17th, 2006.
4 Do you see that?
5 A. Yes.
6 Q. All right. Why were you contacting
7 Mr. Hallam by e-mail?
8 A. I wanted to get some clarification as
9 to how we might move forward with these applications.
10 Q. Okay. In paragraph Number 3 of your
11 e-mail you reference the third application for a
12 series of motion pictures featuring drama, action and
13 adventure.
14 Do you see that paragraph?
15 A. Yes.
16 Q. And then you also reference the office
17 action and the deadline to respond is November 19th,
18 2006.
19 A. Yes.
20 Q. What did you mean with the next
21 statement, "We will need to specify the media in
22 which the film is sold"?
23 A. That might have been a reference to
24 what the examiner said in the office action. But I
25 don't recall specifically.

Page 74

1 Q. Okay. And then the next sentence
2 says, "We could probably add something about
3 downloadable films as well."
4 Do you see that?
5 A. Yes.
6 Q. What did you mean by that?
7 A. Probably at this point in time, I was
8 probably thinking about how to define or refine the
9 identification of goods.
10 Q. So you were thinking about adding
11 something to the description relating to downloadable
12 films?
13 A. Possibly. But, you know, I wasn't
14 real clear in my mind.
15 Q. Did you have any communications with
16 Mr. Hallam about whether the films were available for
17 download?
18 A. I don't believe so.
19 Q. And then Mr. Hallam responded to your
20 e-mail.
21 A. I think this was -- yeah -- this was
22 an intent to use application. And so I was trying to
23 think of the various ways that, when the registration
24 is obtained, we might want to be more specific about
25 what's in there.

Page 75

1 Q. Okay. All right. Let's look at the
2 next e-mail, which we've marked as Exhibit 5. And
3 that is Bates numbered 000035 through 36. This
4 starts with an e-mail from you, to Mr. Hallam, and it
5 begins,
6 "Kirk,
7 "I spoke with the Examining
8 Attorney today. She said that
9 distribution is not an entertainment
10 service in Class 41." Et cetera.
11 Who was the examining attorney that
12 you're referencing?
13 A. Oh, the examining attorney would have
14 been Jill Alt.
15 Q. Okay. Are you referring to a
16 different conversation than the one we discussed
17 earlier about the motion picture series, in this
18 e-mail?
19 A. I don't know, frankly.
20 Q. Okay. All right. Let's look at what
21 we've marked as Exhibit 6, which is Bates number
22 000039 through 40. Another e-mail string between you
23 and Mr. Hallam.
24 A. I'm sorry. I didn't understand the
25 numbers that you're mentioning.

Page 76

1 Q. They are the Bates numbers on the
2 bottom right-hand corner.
3 A. 39.
4 Q. 39 through 40.
5 A. Yes.
6 Q. We've marked this as Exhibit 6. And I
7 was just describing it as another e-mail exchange
8 between you and Mr. Hallam.
9 This one begins with an e-mail from
10 you, to Mr. Hallam, dated November 13th, 2006. And,
11 on the second page of this e-mail exchange, you write
12 to Mr. Hallam and reference the office action related
13 to the motion picture series.
14 Do you see that?
15 A. Yes.
16 Q. So you told Mr. Hallam that you plan
17 to respond to that office action with a different
18 description of the goods, correct?
19 A. Yes.
20 Q. And what description were you
21 proposing?
22 A. I was proposing a description that
23 would specifically identify the particular media of
24 distribution.
25 Q. Okay. Is that referenced in your

Page 77

1 e-mail?
2 A. Um...
3 Q. Let me just ask another question.
4 What description were you proposing?
5 A. Well, it says here, in the media of
6 film, digital optical disc, electronic media and
7 digital download.
8 Q. Okay. So the full proposal you were
9 making was, quote,
10 "Motion picture film series
11 featuring drama, action, and adventure,
12 distributed in the media of film,
13 digital optical disc, electronic
14 media and digital download."
15 Right?
16 A. Yes.
17 Q. And Mr. Hallam responds that he likes
18 the language proposed by the examining attorney,
19 correct?
20 MR. HALLAM: Objection; misstates the
21 document.
22 I would prefer it if you could read
23 the actual statement from the document rather than
24 characterizing it.
25 THE WITNESS: Okay. I've read it.

Page 78

1 BY MS. HOLLAND:
2 Q. What was Mr. Hallam's response?
3 A. He essentially suggested that we use
4 the examiner's language.
5 Q. Okay. He said that,
6 "The language suggested by
7 the examiner for the 3rd application
8 in Class 9 sounds perfect..."
9 Right?
10 A. Yes.
11 Q. And he also said,
12 "... since the tv show was
13 in fact shot on film."
14 Right?
15 A. Yes.
16 Q. And then he asks another question,
17 "Is there some reason why
18 we would not want to just use the
19 examiner's language verbatim, instead
20 of modifying it the way you did?"
21 Right?
22 A. Yes.
23 Q. Did you respond to that question?
24 A. I don't recall.
25 Q. I'll give you a moment to read your

Page 79

1 e-mail.
2 A. Maybe I did respond in the next
3 e-mail. Let me take a look.
4 MS. HOLLAND: All right.
5 (WITNESS REVIEWS DOCUMENT)
6 THE WITNESS: I see that.
7 BY MS. HOLLAND:
8 Q. So what was your response to his
9 question: "Is there some reason why we would not
10 want to just use the examiner's language verbatim?"
11 A. I'm not sure I gave him a real
12 response, because I pointed out future forms of use
13 and distribution.
14 I'm not sure.
15 Q. Well, let's look again. And keeping
16 Exhibit 6 there as a reference, and going back to
17 Exhibit 2, which is your declaration, and
18 specifically Page 43 of Exhibit 2.
19 A. Yes.
20 Q. All right. So your e-mail exchange
21 with Mr. Hallam is on November 13th, November 14th,
22 and November 15th of 2006, right?
23 A. Yes.
24 Q. And then the examiner's amendment
25 references that the amendments were authorized by

Page 80

1 Paul D. Supnik on November 16th, 2006.
2 A. Yes.
3 Q. Does that refresh your recollection
4 about the date on which you spoke with Ms. Alt?
5 A. Well, it suggests that I spoke with
6 her on the 16th.
7 Q. Okay. And during that discussion with
8 Ms. Alt, now that you've had a chance to look at your
9 e-mails at or around that time, do you remember
10 whether you proposed the description of Class 9 goods
11 that you referenced in your November 13th e-mail to
12 Ms. Alt?
13 A. You mean with the extra limiting
14 language?
15 Q. Yes. Describing the extra mediums of
16 optical disc, electronic media, digital download.
17 A. I'm not sure if I specifically did
18 that or not. But I know that I was a little bit
19 concerned, because of that ambiguity as to "films,"
20 and so I did bring it up.
21 Q. Okay. Did you submit anything to
22 Ms. Alt in writing, suggesting a different
23 description of the class of goods?
24 A. Not to my recollection.
25 Q. And then shortly after that

Page 81

1 conversation with her, is it your understanding that
2 she issued the examiner's amendment?
3 A. Yes.
4 MS. HOLLAND: All right. It's 12:20. Let's
5 break for lunch.
6 THE WITNESS: Okay.
7 (AT THE HOUR OF 12:20 P.M. A LUNCH
8 RECESS WAS TAKEN. THE DEPOSITION RESUMED AT
9 1:26 P.M. WITH THE SAME PERSONS BEING PRESENT, WITH
10 THE ADDITION OF MS. SMITH APPEARING TELEPHONICALLY)

11 ///
12 ///
13 ///

Page 82

LOS ANGELES, CALIFORNIA; TUESDAY, APRIL 19, 2011
1:26 P.M.

MS. HOLLAND: Okay. Let's go back on the record.

EXAMINATION (RESUMED)

BY MS. HOLLAND:

Q. Mr. Supnik, do you have a financial interest in the outcome of any of the litigation surrounding the ROUTE 66 marks?

A. My only interest is that Mr. Hallam be able to pay my legal fees.

Q. Okay. How much does he owe you?

A. I don't know what the exact amount is.

Q. Is it more than \$10,000?

MR. HALLAM: Objection. Instruct the witness not to answer.

No one's ever allowed me to ask those questions in this litigation, and I tried.

MS. HOLLAND: What is the basis of the instruction?

MR. HALLAM: On the grounds of attorney/client

Page 83

work product. Also on the grounds that it's not reasonably calculated to lead to the discovery of admissible evidence. And there has been no proffer of any relevance whatsoever to the issues in this cancellation petition.

MS. HOLLAND: Okay. Well, "relevance" isn't a ground for an instruction, but I will proffer that my original question was:

Mr. Supnik, do you have a financial interest in this case or any of the litigation related to the ROUTE 66 marks?

And he answered: Only to the extent that I would like Mr. Hallam to be able to pay my legal fees.

Which, you know, it might have been flip. It might have been serious. You know, I understand that, certainly as a lawyer who has fees that sometimes aren't paid myself.

But where I'm going with this is: I need to know if the witness has an interest in winning this case other than...

Q. Are you going to get paid, regardless of the result of the case, Mr. Supnik?

A. If Mr. Hallam files for bankruptcy at some point in time, I probably would have a problem.

Page 84

Otherwise, I would expect that I will be paid for this case.

But I do not have a financial interest as that term is normally understood in the case.

Q. Okay. How do you define the term "financial interest"?

A. "Financial interest" is used as a contingency matter.

No, it's not.

Q. How long have your fees been outstanding?

A. I can't say. I don't know.

Q. More than a year?

A. I don't know the answer to that.

Q. Is Mr. Hallam or Roxbury also paying your fees for the Conkle cancellation petition?

MR. HALLAM: I'm going to object and instruct the witness not to answer, unless you are officially opening the discovery in the Conkle petition matter.

Otherwise, it has no relevancy to these proceedings, and I'll instruct the witness not to answer.

MS. HOLLAND: On relevance grounds?

MR. HALLAM: On relevance grounds. On the grounds that this is way outside the bounds of the

Page 85

issues in this litigation. And Mr. Conkle who is, I understand, the petitioner in that matter, is not here and is not represented by counsel here.

And I think that you're trying to circumvent the rules of the TTAB and the procedures of the TTAB by crossing over into an entirely separate matter.

MS. HOLLAND: So you're instructing the witness, on those grounds?

MR. HALLAM: Oh, yeah.

MS. HOLLAND: I just want to point out that Mr. Conkle is represented by counsel here. Both Mr. Supnik and you, Mr. Hallam, are counsel of record in his proceeding.

MR. HALLAM: We're not appearing here as counsel for Mr. Conkle. This is not the Conkle petition.

But, as I say, if you want to consult with your client, who is on the phone, and officially open the discovery period for the Conkle petition matter, I will consider whether we will allow you to do that, at this point.

MS. HOLLAND: I'm not negotiating. I'm just asking questions. And if you have an instruction, just state it for the record and we'll take it up, if

Page 86

Page 88

1 necessary.
2 **MR. HALLAM:** Well, your client is on the
3 phone. So if that's what you intend to do, is open
4 the door and officially open discovery in the Conkle
5 petition today, then please let me know. Otherwise,
6 I think you should get on to questions that relate to
7 this petition.
8 **MS. HOLLAND:** I'm just asking questions about
9 Mr. Supnik's financial interest in the outcome of the
10 cases relating to the ROUTE 66 mark, and I'm entitled
11 to explore that. It goes to his credibility and
12 bias.
13 **MR. HALLAM:** Yeah. And it has nothing to do
14 with Conkle.
15 And I think you and your co-counsel in
16 this case have attempted to convert this cancellation
17 petition into one that's interrelated with the Conkle
18 petition, and I don't think the TTAB has acknowledged
19 a right to do that.
20 And I think the TTAB's procedures and
21 orders are clear. And we're in the discovery period
22 not for the Conkle matter, but for the petition to
23 cancel the ROUTE 66 marks of Roxbury Entertainment.
24 And on that, we're open for questions.
25 ///

Page 87

1 **BY MS. HOLLAND:**
2 **Q.** So are you refusing to answer the
3 question, based on your counsel's instructions,
4 **Mr. Supnik?**
5 **A.** Yes.
6 **Q.** So you won't tell me whether Roxbury
7 is paying your legal fees for your representation of
8 **Mr. Conkle?**
9 **MR. HALLAM:** Same objections. Same
10 instruction.
11 **MS. HOLLAND:** On the grounds of
12 attorney/client privilege?
13 **MR. HALLAM:** All of the grounds that I stated
14 in the last five minutes.
15 But, as I say, if you want to confer
16 with your client and determine whether you intend to
17 open the discovery period in the Conkle petition
18 matter, then, you know, we can consult with our
19 client and see whether he authorizes us to go forward
20 with that discovery.
21 But as of right now, my understanding
22 is that discovery period has not opened yet.
23 **BY MS. HOLLAND:**
24 **Q.** Who came up with the idea to register
25 a motion picture series related to ROUTE 66?

1 **A.** Who came up with the specific
2 identification?
3 **Q.** No. Who proposed that an application
4 be filed for Class 9 with the description of goods
5 that included a reference to a motion picture film
6 series?
7 **A.** It was probably me that came up with
8 the overall identification.
9 **Q.** Did you come up with the idea to
10 register ROUTE 66 for a motion picture film series?
11 **A.** I'm not sure if I came up with an idea
12 for it. I probably had some input as to the
13 objectives, and then I came up with a proposed
14 identification.
15 **Q.** What was your process? How did you
16 determine which classes of goods in which to register
17 or to apply for registration of ROUTE 66?
18 **A.** Well, usually in entertainment
19 properties, I think most frequently in Classes 9 and
20 41.
21 **Q.** And what questions did you ask of
22 **Mr. Hallam** in making the determinations of the
23 classes of goods for the applications?
24 **A.** I'm not sure that I recall any
25 specific questions. I probably asked him something

Page 89

1 in the nature of what he's done with ROUTE 66 and
2 what he plans to do.
3 **Q.** Going back to Exhibit 2. And
4 specifically, let's start at Paragraph 5, on Page 3
5 of Exhibit 2.
6 To your knowledge, was Roxbury or
7 Cloudstreet -- or **Mr. Hallam**, for that matter -- were
8 any of those entities using ROUTE 66 on DVDs as of
9 February 28, 1995?
10 **A.** I don't believe so.
11 **Q.** When was ROUTE 66 first used on DVDs
12 by Roxbury or Cloudstreet, to your knowledge?
13 **A.** Well, I don't have a specific
14 recollection, but this would suggest -- this
15 declaration would suggest -- that it might have been
16 2005.
17 **Q.** The declaration prepared by
18 **Mr. Hallam**?
19 **A.** Yes.
20 **Q.** And do you know where that 2005 date
21 or what the basis of the 2005 date is?
22 **A.** I do not recall.
23 **Q.** Did **Mr. Hallam** provide you with any
24 sales receipts demonstrating that there have been DVD
25 sales in 2005?

23 (Pages 86 to 89)

Page 90

1 A. I don't recall.
2 Q. Did you ask him for any sort of
3 records that would show sales of DVDs by Roxbury or
4 Cloudstreet in 2005?
5 A. I don't believe I did.
6 Q. What type of inquiry did you make
7 regarding that date? The 2005 date.
8 A. It was probably a verbal inquiry.
9 Q. And what did you ask?
10 A. Well, I don't have a specific
11 recollection as to what was asked.
12 Q. What is your general recollection?
13 A. I probably asked for... I probably
14 asked him for dates. I don't know. I might have
15 done it by e-mail. I might have done it by
16 telephone.
17 Q. If you did it by e-mail, would you
18 have saved your e-mail?
19 A. Probably.
20 Q. And where would the e-mail be today?
21 A. I would think that it would be in the
22 documents that were brought in.
23 Q. Okay. Let's focus on those e-mails
24 for a minute.
25 Did you do an e-mail search before

Page 91

1 your deposition today?
2 A. No, I did not.
3 Q. Did you undertake any kind of
4 e-discovery or electronic records search, in
5 responding to the subpoena and appearing for
6 deposition today?
7 A. I don't believe so. No.
8 MS. HOLLAND: Mr. Hallam, the issue with the
9 document production is that this is a case in which
10 we are alleging fraud and intent is at issue.
11 So complete files and complete records
12 are essential for me to be able to conduct a full
13 examination and cross-examination of what took place
14 with these registrations.
15 So the selective production of e-mails
16 without the other documents from the files really
17 makes it impossible for me to undertake the
18 examination I'm entitle to undertake.
19 MR. HALLAM: Well, my answer to that is
20 twofold.
21 One, we produced -- though I don't
22 think we were obligated to -- we produced all of the
23 records of communications between myself and
24 Mr. Supnik, in any form, and any attachments to
25 those. And we produced numerous documents in the

Page 92

1 District Court proceedings. That's number one.
2 Number two, your co-counsel,
3 Mr. Mandell, stipulated with me, a stipulation which
4 your firm then submitted in the form of a pleading to
5 the TTAB, an agreement that there was to be no
6 further discovery beyond what had been taken in the
7 District Court proceedings in this cancellation
8 petition proceeding.
9 And we are here, even though it's not
10 consistent with that stipulation, we're here to give
11 you more than what I think you're entitled to.
12 Certainly more than what your
13 co-counsel had stipulated would be allowed in this
14 proceeding.
15 MS. HOLLAND: We never stipulated to that.
16 And discovery is open in this case.
17 This is the first deposition you've actually allowed.
18 We probably will have to take it separately to the
19 TTAB and move to compel production.
20 MR. HALLAM: Perhaps.
21 MS. HOLLAND: And, of course, we'll reserve
22 rights on that, because there are costs associated
23 with the tactics that you're adopting.
24 MR. HALLAM: There are costs associated with
25 breaching one's word, filed in a stipulation with the

Page 93

1 TTAB by your law firm, Ms. Holland.
2 And your law firm may not believe that
3 its word as set forth in a stipulation of counsel
4 that's submitted to the TTAB has any meaning, but I
5 think the TTAB may feel differently, and I certainly
6 do.
7 And I have heard nothing from you,
8 Mr. Mandell, or anyone else in your firm to deny the
9 statement made in the pleadings submitted to the TTAB
10 clearly asserting that there is an agreement between
11 the parties, through their counsel, that there will
12 be no further discovery in this TTAB proceeding, and
13 that we're limited to the discovery taken in the
14 District Court proceeding.
15 I understand you've changed your minds
16 and your position, perhaps as you sat down and
17 figured out that it would somehow behoove you to
18 re-take all the depositions that we took in the
19 District Court, or that you made a tactical error
20 when you made a calculated decision not to take
21 Mr. Supnik's deposition.
22 But that's your decision. And I think
23 you have to live with the agreements that your
24 co-counsel, Mr. Mandell, made in this case and that
25 were filed with the TTAB. And you cannot deny that.

Page 94

1 It is a fact.

2 **MS. HOLLAND:** We filed a stipulation. I'm not
3 denying it.

4 It doesn't say what you're contending
5 it says.

6 And we're here today. Mr. Supnik is
7 subpoenaed. You didn't move for a protective order.
8 You didn't do anything that would have prevented the
9 deposition. You didn't even give me written
10 objections. And you didn't produce the documents
11 that he has in his possession. And I'm entitled to
12 those.

13 And so I'm giving you the chance.
14 What I'm giving you the chance to do is agree to give
15 me those documents, we'll agree on a date, I'll go
16 over them.

17 If I need to continue questioning
18 Mr. Supnik, we'll pick a date that's convenient
19 within the current schedule, and we'll avoid a
20 motion. Otherwise, we're going to have to bring a
21 motion on that.

22 **MR. HALLAM:** You may have to bring your
23 motion. And I'll be bringing one, too, to try to
24 enforce the stipulation that counsel reached.

25 And I asserted in numerous e-mails to

Page 96

1 that you're submitting a witness and now producing
2 what you would like to and saying that: That's all I
3 have to do.

4 That's not the position that we've
5 ever accepted. It's not something that we're going
6 to allow without a motion. And it's unfortunate,
7 because this conduct continues to escalate the costs
8 of this case.

9 **MR. HALLAM:** And if I didn't agree, then
10 whichever one of the multitude of lawyers from your
11 law firm that signed that pleading saying, quote,
12 "Counsel have agreed there shall be no further
13 discovery in this matter, and the discovery shall be
14 limited to that taken in the District Court
15 proceedings," that person's lying then, obviously, in
16 the form of a pleading that they submitted to the
17 TTAB.

18 **MS. HOLLAND:** I guess we'll just brief the
19 issue.

20 I think the record is pretty clear
21 that you have only selectively turned over documents
22 in response to a subpoena.

23 **MR. HALLAM:** And if there is anybody that's
24 vexatious litigators, it is you and your law firm,
25 Ms. Holland.

Page 95

1 you and Mr. Mandell and Ms. Smith that there was a
2 stipulation in place, that we do not believe you have
3 the right to take any depositions in this proceeding,
4 because you reached a stipulation which you filed
5 with the TTAB in the form of a pleading.

6 And we are going way above and beyond
7 what we are obligated to do in making Mr. Supnik
8 available today and producing all of the documents
9 that are responsive to your subpoena that were
10 previously withheld on the grounds of privilege in
11 the District Court case.

12 And I think that you should just
13 proceed with your questions, because you're not going
14 to get anywhere sitting there telling me that you
15 didn't reach a stipulation, that it wasn't filed with
16 the TTAB, and that you don't have to live up to the
17 agreements that you made with counsel.

18 **MS. HOLLAND:** I didn't say any of those
19 things.

20 And, actually, I just want to point
21 out that the stipulation that you are referencing,
22 you never signed. You never signed it. You never
23 responded to us. You never executed a stipulation.

24 So it's curious that you're now
25 relying on something that you never agreed to, and

Page 97

1 After reaching that agreement, you're
2 now trying to re-take all the depositions or take the
3 depositions that you made tactical decisions not to
4 take in the District Court proceedings after agreeing
5 it would be limited to what we did take in the
6 District Court proceedings.

7 And if that's not vexatious
8 litigation, I don't know what it is.

9 **MS. HOLLAND:** I don't think you do know what
10 vexatious litigation is. Because you continue to
11 engage in it, with total disregard of efficiency,
12 cost savings, or even common sense with respect to
13 what privileges and what a subpoena means and, you
14 know, confirming dates and all of that.

15 So, maybe you're right, you don't know
16 what it means.

17 **MR. HALLAM:** And I guess I don't know what it
18 means when you and your law firm submit something in
19 a pleading to the TTAB saying there is an agreement
20 of counsel that no further discovery shall be taken
21 in this matter and that we shall be limited to the
22 discovery taken in the District Court proceedings. I
23 guess I don't know what that means either.

24 And I guess I don't know what it means
25 to abide by a stipulation and the word between

Page 98

1 counsel. I guess I don't. Maybe it's the new law.
2 The new way that law is practiced.
3 **BY MS. HOLLAND:**
4 **Q.** Mr. Supnik, do you know who David
5 Garland is?
6 **A.** No, I don't.
7 **Q.** So you don't know what his address is?
8 **A.** No, I don't know who he is.
9 **Q.** All right. Let's go back to your
10 declaration. Paragraph 5. And, actually, I'm now
11 referring to Paragraph 7.
12 You refer to Section 903.09 of the
13 Trademark Manual of Examining Procedure.
14 Do you see that?
15 **A.** Yes.
16 **Q.** What version of the Trademark Manual
17 of Examining Procedure were you referring to? What
18 year?
19 **A.** I have no idea what year.
20 **Q.** Are you aware that currently there is
21 no Section 903.09?
22 **A.** I think that I did notice that that
23 had been eliminated. Or some aspect of that had been
24 eliminated in the most-recent version.
25 **Q.** Now, what documents exist, if any,

Page 99

1 supporting the statement you make in your declaration
2 that: As of July 6, 2005, the Registrant was using
3 the ROUTE 66 mark in commerce or in connection with
4 an ongoing television program?
5 **A.** I don't know if there are any specific
6 documents in my mind.
7 **Q.** Well, what is your understanding when
8 you say that: The Registrant was using ROUTE 66 with
9 an ongoing television program? What did you mean by
10 that?
11 **MR. HALLAM:** I'm sorry. Can I ask where
12 you're referring specifically.
13 **MS. HOLLAND:** Sure. It's in...
14 I'm sorry. I'm reading from my
15 outline, and I don't have it marked in a section in
16 the declaration. I'll find it in a moment.
17 But right now, I'll refer you to
18 Page 29 of 55, and I'll switch to something else, so
19 I can find the reference.
20 This is, again, referring to
21 Exhibit 2, Page 29, the trademark application for
22 serial number 78664154.
23 And on the second page of that
24 application, under the description of class of goods
25 in International Class 41,

Page 100

1 "Entertainment services,
2 namely, title of a television
3 series; television production
4 services; television distribution
5 services."
6 Let's focus on that language for a
7 moment.
8 **Q.** What was the basis of the statement
9 "television production services"? That ROUTE 66 was
10 currently being used in association with television
11 production services?
12 **A.** My understanding was that Mr. Hallam
13 was involved in trying to develop various types of
14 entertainment properties using ROUTE 66.
15 **Q.** Including television?
16 **A.** I don't have a specific recollection
17 of television. But my thought was that there were
18 some sort of production services.
19 **Q.** So what types of production services
20 was Roxbury or Cloudstreet engaged in with respect to
21 the ROUTE 66 mark --
22 **A.** Development.
23 **Q.** -- in, I guess, 2005, when this
24 application was filed?
25 **A.** My thought was that it was development

Page 101

1 services.
2 **Q.** Development of another television
3 production?
4 **A.** Well, when you create a property, you
5 don't necessarily develop it for a...
6 You might be developing it for a
7 specific media. But usually you have in your mind
8 development in a variety of different types of media.
9 So whether it was in the idea of a
10 motion picture or made-for-television type of a
11 motion picture or something else, I kind of lumped
12 that all together in production services.
13 **Q.** So television production services
14 includes motion picture production services, in your
15 mind?
16 **A.** If it's also potentially geared for
17 television as well, yes.
18 **Q.** Did Mr. Hallam or anybody at Roxbury
19 or Cloudstreet tell you that they were producing a
20 television series?
21 **A.** I don't recall.
22 **Q.** Did they provide you any specimens or
23 examples of use in connection with television
24 production services?
25 **A.** I don't know that they did.

Page 102	Page 104
<p>1 Q. Do you know if they ever produced a 2 television series using the ROUTE 66 mark? 3 A. Well, I know that they were continuing 4 to work with the series that they already had. But 5 I'm not sure exactly the specific manner in what they 6 were doing. 7 Q. What was your understanding of exactly 8 what Roxbury or Cloudstreet was doing in connection 9 with the existing series? 10 A. It was limited, but my understanding 11 is that they were doing whatever they could to 12 exploit that series. 13 So if it meant doing things to improve 14 the quality of the existing series, doing something 15 on the postproduction end, or putting it in some sort 16 of a different format, or trying to work with other 17 people that would do something in that regard, I 18 considered that under the broad umbrella of 19 production services. 20 And that would probably include 21 television production services, as well as other 22 forms of production services. 23 Q. Okay. What does the phrase 24 "television distribution services," which you used in 25 the description there, what does that mean to you?</p>	<p>1 Q. What is your understanding as to the 2 identity of that predecessor-in-interest company? 3 A. My vague recollection was it was 4 either the producer or Sony had -- one of the two, or 5 both -- had rights. 6 Q. And what is the basis of your 7 understanding in that respect? 8 A. Probably telephone conversations with 9 Kirk Hallam. 10 Q. Did you ever see any of -- to the 11 extent I'm just assuming they exist -- the documents 12 that would convey rights from Columbia TriStar to 13 Roxbury or Cloudstreet? 14 A. I have not seen them. 15 Q. Do you know what rights Roxbury holds 16 in the ROUTE 66 property? 17 A. My guess is that they own -- 18 MR. HALLAM: I would just counsel you not to 19 speculate or guess. 20 THE WITNESS: I should know that. 21 MR. HALLAM: If you know, then please answer. 22 But, please, don't speculate. 23 BY MS. HOLLAND: 24 Q. Do you know? 25 A. I don't know.</p>
Page 103	Page 105
<p>1 A. That means, essentially, licensing of 2 the... Licensing. It's a significant part of it. 3 Q. Okay. So, in your mind, licensing is 4 a significant part of distribution services? 5 A. Licensing is a significant part. And 6 delivery of product to the licensees. 7 Q. Do you know whether Roxbury ever saw 8 the television distribution of ROUTE 66? The 9 original series? 10 MR. HALLAM: Objection; vague and ambiguous, 11 as to time frame. 12 MS. HOLLAND: At any time. 13 THE WITNESS: My thought, and I'm not sure if 14 it's accurate or not, was that they had some 15 involvement with distribution. Certainly not in the 16 '60s, but in the time frame during the time of the 17 application. That was my general impression. 18 Whether they did or not, I don't know. 19 BY MS. HOLLAND: 20 Q. You reference in your declaration, at 21 various points, that Roxbury was the 22 successor-in-interest to some other company. Or that 23 it had a predecessor-in-interest with respect to the 24 rights of the ROUTE 66 television series. 25 A. Yes.</p>	<p>1 Q. Did you seek permission from Columbia 2 TriStar Television for the applications for 3 registration of any of the ROUTE 66 trademarks? 4 MR. HALLAM: Objection. Assumes a fact 5 contrary to the evidence, that there was any need to 6 seek permission from Sony or Columbia TriStar. 7 MS. HOLLAND: You can answer. It's just "Yes" 8 or "No." 9 Q. Did you seek permission from Columbia 10 TriStar to apply for the registrations? 11 A. No. 12 Q. Did you have any discussions with 13 Mr. Hallam or anyone at Roxbury or Cloudstreet about 14 Roxbury's standing to apply for those registrations? 15 A. Yes. 16 Q. What were those discussions? 17 A. I have a vague recollection of asking 18 Mr. Hallam the basis on which he acquired the rights. 19 Q. And what did he tell you? 20 A. My understanding was that there were 21 agreements that transferred the rights to -- I'm not 22 sure who -- if it was to Cloudstreet or exactly who. 23 But there were some rights that were transferred. 24 And I also heard, I guess is it 25 Herbert Leonard that was referenced?</p>

Page 106

1 But I don't recall specifically
2 exactly how the rights were transferred.
3 Q. Okay. So you asked him: Do you have
4 the right to apply, and he said yes, basically, and
5 gave you an explanation?
6 A. Basically my understanding was that
7 Cloudstreet, at that point in time, owned the rights
8 to the ROUTE 66 series.
9 Q. Okay. And you took Mr. Hallam's word
10 for it?
11 A. Yes.
12 Q. In Paragraph 11 of your declaration
13 and also the trademark application, you referenced a
14 date of first use for the television program as at
15 least as early as September 30th, 1960.
16 A. Yes.
17 Q. Okay. What is the basis of your
18 understanding that that was the date of first use?
19 A. That was, I believe, the date that was
20 communicated to me as the date the program aired on
21 television.
22 Q. And who communicated that to you?
23 A. It would have been Mr. Hallam.
24 Q. Okay. Do you know if the television
25 program was continuously aired on television from

Page 107

1 1960 to 2005?
2 A. I don't know what you mean
3 "continuously."
4 Q. Well, I don't mean was it on every
5 minute of every day. But, I mean, was it generally
6 being exhibited on a periodic basis on television,
7 network, cable, whatever -- broadcast television --
8 throughout the period 1960 through 2005?
9 A. Well, I don't have any knowledge that
10 it was on, other than on network television,
11 personally, other than during that initial broadcast
12 run.
13 My understanding is that it was
14 licensed internationally. And I thought, from
15 conversations with Mr. Hallam, that it was broadcast
16 in some manner or way on syndication. But I don't
17 have specific knowledge.
18 Q. Okay. If there were gaps of time when
19 ROUTE 66 the television series was not being
20 broadcast in the United States, but it was being
21 broadcast outside the United States, would that
22 satisfy as continuous use of the mark?
23 A. For what purpose?
24 Q. For purposes of the representations
25 you made in the trademark applications.

Page 108

1 A. First, I'm not sure that was the
2 representation that was made in the trademark
3 application.
4 However, my sense is that
5 international licensing might be sufficient to
6 establish use of the mark as the title of a
7 television series.
8 The title of a television series in
9 Class 41 is one of those creatures of trademark
10 practice that is very vague and very fuzzy.
11 I have done some research on that back
12 in the time of this application. And my recollection
13 is that...
14 I don't remember if this was at the
15 time of the Lanham Act, where there was testimony or
16 discussion by congress.
17 And the idea was that congress was
18 supposed to provide protection for trademarks
19 relating to television features, aspects of
20 television shows. And there wasn't much more that I
21 was able to find.
22 So as to whether or not use is
23 established by continuously broadcasting the show on
24 television, whether the use is established by
25 licensing between, which is commerce between the

Page 109

1 United States and another country, it's all very
2 fuzzy. So I can't tell you. I can't tell you
3 whether that's satisfactory or not.
4 But I don't know that that continuous
5 use for a period of time prior to the application is
6 something that's really meaningful.
7 Q. So, in your mind, Roxbury's date of
8 first use related back to Columbia TriStar's date of
9 first use?
10 A. I think that's what... I thought that
11 that was a reasonable interpretation.
12 Q. Did you verify the air dates of the
13 series?
14 A. No.
15 Q. Did Mr. Hallam provide you with any
16 documents related to the original air dates of the
17 television series?
18 A. I remember I had a listing of... I
19 don't know if it was air dates. I don't remember
20 what that was.
21 I think it's part of one of the
22 exhibits here. But I don't remember if that was tied
23 in to it or not.
24 Q. Okay. Are you referring to the
25 exhibit that begins on Page 21 of Exhibit 2?

Page 110	Page 112
<p>1 A. Yes.</p> <p>2 Q. And goes through Page 27?</p> <p>3 A. Yes.</p> <p>4 Q. That exhibit, beginning on Page 22,</p> <p>5 who prepared it, if you know?</p> <p>6 A. I don't know.</p> <p>7 Q. Who provided it to you?</p> <p>8 A. It would have been provided by</p> <p>9 Mr. Hallam's office.</p> <p>10 Q. Do you see, the fourth column says</p> <p>11 "PUB DATE"?</p> <p>12 A. Yes.</p> <p>13 Q. Do you know what that represents?</p> <p>14 A. That probably was an exhibition date.</p> <p>15 But -- well -- frankly, I don't know. I don't know.</p> <p>16 Q. Under the fifth column, Registration</p> <p>17 Number, do you know what those are?</p> <p>18 A. Those look like copyright registration</p> <p>19 numbers.</p> <p>20 Q. Okay. And the next column is</p> <p>21 "REG. DATE." Do you know what that refers to?</p> <p>22 MR. HALLAM: Objection; no foundation.</p> <p>23 Calling for speculation.</p> <p>24 THE WITNESS: I don't know.</p> <p>25 ///</p>	<p>1 Leonard Enterprises, of rights associated with</p> <p>2 ROUTE 66?</p> <p>3 A. I think I was told at one time the</p> <p>4 manner in which Roxbury acquired the rights. But I</p> <p>5 couldn't remember exactly how that occurred.</p> <p>6 Q. This exhibit also doesn't reference</p> <p>7 Columbia TriStar at all, does it?</p> <p>8 A. No.</p> <p>9 Q. So you registered marks for Roxbury</p> <p>10 without any documents demonstrating that Roxbury</p> <p>11 owned the rights to the television series?</p> <p>12 A. I based it on my communication with</p> <p>13 Mr. Hallam.</p> <p>14 Q. So you were relying entirely on</p> <p>15 Mr. Hallam's representations?</p> <p>16 A. Yes.</p> <p>17 Q. Did you do any independent research or</p> <p>18 inquiry to determine whether the dates on the</p> <p>19 exhibit, beginning at Page 22, were the correct air</p> <p>20 dates of the ROUTE 66 episodes listed?</p> <p>21 MR. HALLAM: I'm going to object. It's</p> <p>22 contrary to the testimony of the witness. He didn't</p> <p>23 recall specifically seeing that document.</p> <p>24 BY MS. HOLLAND:</p> <p>25 Q. Did you do any independent inquiry to</p>
Page 111	Page 113
<p>1 BY MS. HOLLAND:</p> <p>2 Q. And under the next column, "CLAIMANT,"</p> <p>3 do you know what that refers to?</p> <p>4 MR. HALLAM: No foundation. Calls for</p> <p>5 speculation.</p> <p>6 THE WITNESS: I don't know.</p> <p>7 BY MS. HOLLAND:</p> <p>8 Q. And, the last column, which says</p> <p>9 "AUTHOR," do you know what author refers to?</p> <p>10 MR. HALLAM: Same objections.</p> <p>11 THE WITNESS: I don't know.</p> <p>12 BY MS. HOLLAND:</p> <p>13 Q. Roxbury Entertainment is not listed as</p> <p>14 a claimant or author for any episode on this exhibit,</p> <p>15 is it?</p> <p>16 A. I don't see it. No.</p> <p>17 Q. When you received this, did you ask</p> <p>18 Mr. Hallam if there were any documents showing an</p> <p>19 assignment or transfer of rights from Lancer</p> <p>20 Productions to Roxbury Entertainment?</p> <p>21 A. I remember having some discussion, but</p> <p>22 I don't remember specifically if it was regarding</p> <p>23 acquisition from Sony or from Herbert Leonard.</p> <p>24 Q. Did you ask Mr. Hallam or anybody at</p> <p>25 Roxbury if they had an assignment, from Herbert</p>	<p>1 verify the first air dates of any of the ROUTE 66</p> <p>2 episodes?</p> <p>3 A. No.</p> <p>4 Q. Is Exhibit 2 a document from your</p> <p>5 files?</p> <p>6 A. I'm sorry?</p> <p>7 Q. I'm sorry. I called it Exhibit 2.</p> <p>8 Is the chart that begins on Page 21 of</p> <p>9 what we've marked as Exhibit 2, which is your</p> <p>10 declaration, is that chart something from your files?</p> <p>11 A. It was probably... I don't know. I</p> <p>12 mean, in other words, I might have received a copy of</p> <p>13 it. But it was provided to me in this declaration</p> <p>14 from Mr. Hallam.</p> <p>15 Q. Okay. It's referred to in</p> <p>16 Paragraph 11 of your declaration. And I'll just let</p> <p>17 you read that paragraph.</p> <p>18 What I'm trying to determine is...</p> <p>19 Well, I'll just have a series of follow-up questions</p> <p>20 here, but...</p> <p>21 On Pages 4 and 5 of your declaration,</p> <p>22 in Paragraph 11, you reference the chart we've been</p> <p>23 discussing.</p> <p>24 A. Okay.</p> <p>25 Q. And the sentence in your declaration</p>

Page 114

1 is,
2 "Confirmation of this date" --
3 And I believe this date is referring
4 to the 1960 date.
5 -- "was provided to me by
6 Roxbury Entertainment in the form
7 of an historical list showing the
8 dates of first airing for each
9 episode of the original Route 66
10 Television Program (a true and correct
11 copy of which is attached hereto as
12 Exhibit 2)."
13 Right? And that's what we've been
14 talking about, that spreadsheet?
15 A. Yes.
16 Q. Okay. So when did you receive the
17 chart with the air dates on it?
18 A. I don't have a specific recollection.
19 Q. Was it before you signed your
20 declaration? Or was it around the same time that you
21 signed your declaration?
22 A. I do not recall.
23 Q. Do you know if you received the chart
24 at or around the time you filed the service mark
25 application in 2005?

Page 115

1 A. I don't recall.
2 Q. Is it possible that you only received
3 the chart a few years after you filed that
4 application?
5 A. Yes.
6 (SPEAKING SIMULTANEOUSLY)
7 MR. HALLAM: Objection. It calls, by its
8 explicit terms, for pure speculation.
9 MS. HOLLAND: You were about to answer.
10 Q. Is it possible that you received the
11 chart several years after you filed the application?
12 MR. HALLAM: I would counsel you not to
13 speculate. If you remember, fine. If you don't,
14 don't speculate, please.
15 THE WITNESS: I don't recall.
16 MS. HOLLAND: Okay.
17 Q. So as you sit here today, you don't
18 recall having this chart --
19 A. I don't recall.
20 Q. -- when you filed the 2005
21 application?
22 A. I don't recall if I had it or didn't
23 have it. Nor did I think it was pertinent.
24 Q. When did Roxbury Entertainment first
25 use the ROUTE 66 mark on anything?

Page 116

1 A. It's vague as to what you mean by
2 "use." I don't know the answer to that. My vague
3 recollection is hearing dates in 2005. But I don't
4 know the answer.
5 Q. Did you investigate whether the
6 ROUTE 66 mark had been abandoned prior to 2005
7 because of, for example, non-use?
8 A. In my mind, the mark was not
9 abandoned. Because even whether it was used or it
10 wasn't used, there is a residual goodwill for a
11 mark -- for an iconic mark like that -- that just
12 lives on.
13 Q. Do you believe that any periods of
14 non-use before the date of filing the applications
15 for registration were immaterial to the decision by
16 the patent and trademark office to issue the
17 registrations?
18 A. If there were -- and I don't know if
19 there were any -- if there were, I think it's
20 immaterial.
21 You can't take a major property like
22 that and say: Well, if it hasn't been used for a
23 period of time, therefore there are no rights in the
24 mark.
25 Q. When you signed your declaration which

Page 117

1 we've marked as Exhibit 2, October of 2009, did you
2 at that time make any inquiries about the chain of
3 title to the ROUTE 66 properties?
4 A. I might have asked about, you know,
5 what was the transaction.
6 I don't recall specifically what the
7 response was, other than the fact that I think I was
8 probably told, you know: We've got it through "this"
9 reason or "this" reason. But I don't recall the
10 specifics.
11 Q. And again, for that chain of title and
12 acquisition of rights, the information you were
13 relying on is what Mr. Hallam told you?
14 A. Yes.
15 Q. You referenced domestic and
16 international licenses for distribution in your
17 declaration by Roxbury's predecessor, Sony.
18 What domestic or international
19 licenses were you referring to?
20 A. And this, again, goes based on my
21 verbal discussions.
22 My understanding is that there was
23 some certain international licensing that had gone on
24 for the ROUTE 66 series. And based on those
25 conversations, my understanding was there was some

Page 118

1 international licensing that had gone on.
2 And so my thinking is: Well, that's
3 fine. That's use, because it's use of a mark between
4 the United States and another country.
5 Q. So, again, your information about
6 domestic and international licenses for distribution
7 was from Mr. Hallam?
8 A. Yes, it was.
9 Q. And not based on any review of
10 documents?
11 A. That's correct.
12 Q. You also reference in your declaration
13 that VHS copies of ROUTE 66 were being sold in 2005.
14 And I'm referring to Paragraph 15.
15 At Lines 6 and 7, you reference a
16 "sell-off of VHS copies of the Route 66 television
17 program by Sony and its licensees..."
18 Do you see that? Lines 6 and 7 of
19 Paragraph 15?
20 A. Yes, I do.
21 Q. What is the basis of that statement
22 that a sell-off was taking place?
23 A. That was through Mr. Hallam.
24 Q. Did you do any independent
25 verification of whether VHS copies were being sold

Page 119

1 off?
2 A. No.
3 Q. Then, at Lines 7 and 8 of that same
4 paragraph, 15, you mention "... Roxbury's use of the
5 Mark in connection with the development of a remake
6 of the original Series..."
7 Do you see that?
8 A. Yes.
9 Q. What were you referring to with
10 respect to a remake of the original series?
11 A. I thought they were going to do
12 something with creating a new series, as well as a
13 motion picture. But I didn't have any specifics.
14 Q. Was that based on discussions with
15 Mr. Hallam?
16 A. Yes.
17 Q. Was it based on anything other than
18 discussions with Mr. Hallam?
19 A. No.
20 Q. How was ROUTE 66 being used in
21 commerce in connection with a television program in
22 2005?
23 A. My thinking was that there was some
24 licensing or syndication that was going on.
25 Q. Was that the licensing or syndication

Page 120

1 by Sony?
2 A. I don't know. I don't know the answer
3 to that.
4 Q. All right. And your understanding was
5 based on discussions with Mr. Hallam, correct?
6 A. Yes.
7 Q. And only on those discussions?
8 A. Yes.
9 (WHEREUPON MS. PANTON EXCUSED
10 HERSELF TELEPHONICALLY FROM THE
11 DEPOSITION PROCEEDINGS)
12 BY MS. HOLLAND:
13 Q. Mr. Supnik, do you know whether a new
14 feature film called ROUTE 66, using new footage, you
15 know, current actors, do you know whether a new film
16 has been shot?
17 A. I have no knowledge that a new film
18 has been shot.
19 Q. Okay. And I just want to clarify.
20 You said you received some DVDs from Mr. Hallam?
21 A. Yes.
22 Q. And that they contained episodes of
23 the television series ROUTE 66?
24 A. Yes.
25 Q. Did you receive the DVDs that were the

Page 121

1 motion picture versions of the ROUTE 66 episodes?
2 MR. HALLAM: Objection; no foundation. Calls
3 for speculation.
4 THE WITNESS: Yeah. I don't know what you
5 mean by "the motion picture versions."
6 MS. HOLLAND: Okay. I don't think there were
7 motion picture versions, but...
8 MR. HALLAM: Move to strike the commentary.
9 That's not a question.
10 MS. HOLLAND: I think that's why there is
11 confusion. Because there wasn't actually a motion
12 picture.
13 MR. HALLAM: I move to strike. I think your
14 vexatious litigation and your opinions should be kept
15 to yourself.
16 BY MS. HOLLAND:
17 Q. But let's assume, for purposes of
18 argument, that there was a motion picture, and that
19 it was exhibited at that Fort Lauderdale film
20 festival on DVD.
21 Did you receive a copy of the DVD that
22 was exhibited at the Fort Lauderdale film festival?
23 A. I do not recall whether... I don't
24 have personal knowledge as to whether the DVDs that I
25 received were the identical DVDs that were exhibited

Page 122

1 at the Fort Lauderdale film festival.
2 Q. Okay. How many motion pictures are
3 required to constitute a series, for purposes of
4 trademark registration?
5 A. Well, I think generally, when you talk
6 in terms of series and talk in terms of creative
7 works, in my mind, two constitute a series.
8 Q. Are you aware that the ROUTE 66
9 television series episodes each had their own titles?
10 A. Yes.
11 Q. And that no two were titled the same?
12 A. I would assume that that's correct.
13 And that's all the more reason why ROUTE 66 is
14 clearly a trademark.
15 Q. With respect to the television series?
16 A. Well, with respect to the television
17 series and any ancillary uses.
18 Q. So how many ROUTE 66 motion pictures
19 are there, as of 2011, that you are aware of?
20 A. I don't know the specific number. I
21 think I saw in here, the list had something like 116
22 episodes. But I don't know what you're referring to.
23 Q. So every episode of the series would
24 be a separate motion picture?
25 A. Yes.

Page 123

1 Q. Even though each episode has a
2 different title?
3 A. Oh, absolutely.
4 Ask me that question again. I didn't
5 understand that.
6 Q. Okay. I asked you and it started
7 with: How many ROUTE 66 motion pictures are there as
8 of 2011. And then you referred to the list of
9 episodes, and said there were over a hundred.
10 Something like that.
11 A. That's correct.
12 Q. And then I think I said -- I can have
13 it read back -- but I think I said: So every episode
14 in the series is a motion picture?
15 A. That's correct. For example, in the
16 copyright office, the terminology they used to use is
17 if you have a television show, I think they refer to
18 that as a motion picture, under the old copyright
19 scheme.
20 Q. Okay. And then I said: Well, every
21 episode has a different title. So how could the
22 episodes constitute a motion picture series?
23 A. But they all go under the same
24 trademark: ROUTE 66.
25 So it's used as a title for a series.

Page 124

1 Q. Of both television shows and, in your
2 mind, motion pictures?
3 A. Yes.
4 MR. HALLAM: Those pictures do move.
5 BY MS. HOLLAND:
6 Q. So there is no distinction between a
7 television show and a motion picture, in your mind?
8 A. I think, depending upon the context,
9 there can be an overlap in the meanings. And,
10 obviously, it's not perfectly clear.
11 If you were going to show, every week,
12 the identical episode, that might not be a series.
13 MR. HALLAM: It might not be watchable either.
14 MS. HOLLAND: Okay. Let's mark as Exhibit 7
15 Plaintiff Roxbury Entertainment's Privilege Log.
16 (THE DOCUMENT REFERRED TO WAS
17 MARKED AS EXHIBIT 7 AND IS
18 BOUND UNDER SEPARATE COVER)
19 BY MS. HOLLAND:
20 Q. Have you seen this document before,
21 Mr. Supnik?
22 A. No, I have not.
23 Q. So you didn't help prepare this
24 document?
25 A. No.

Page 125

1 Q. You see, though, that you're the
2 author of various communications listed in this
3 chart?
4 A. Yes.
5 Q. And you're also the recipient of
6 various communications listed?
7 A. Yes.
8 Q. And they appear to be organized in
9 chronological order by date, starting with the
10 earliest first?
11 MR. HALLAM: Objection. I think the document
12 needs to speak for itself. Plus, it's contrary to
13 what I see.
14 Also, no foundation. The witness
15 already testified he's never seen this before and he
16 didn't help prepare it.
17 MS. HOLLAND: I see what you're saying about
18 the date.
19 After the first page, it looks like
20 the dates are chronological, with the oldest first.
21 But the first page does have some shuffling of
22 documents.
23 Q. So the documents that your counsel
24 gave me today include communications between you and
25 Kirk Hallam, correct?

Page 126

1 A. Yes.
2 Q. In fact, they're mostly communications
3 between you and Mr. Hallam?
4 A. Yes.
5 Q. E-mail communications, right?
6 A. Yes.
7 Q. And, for the record, those were
8 numbered 000001 through 66.
9 And the numbers on the documents that
10 were provided today don't appear to correspond to the
11 document numbers referenced in this Exhibit 7, do
12 they?
13 MR. HALLAM: Objection; no foundation. Calls
14 for speculation.
15 The witness already testified he's
16 never seen this before. What are we accomplishing
17 here?
18 BY MS. HOLLAND:
19 Q. Do they?
20 A. I don't understand what you're saying.
21 Are you saying that these numbers --
22 the Bates numbers, the control numbers -- do not
23 match the numbers in the document?
24 Well, I don't see "P" in front of
25 these numbers.

Page 127

1 Q. And these numbers all appear to be in
2 the thousand-plus range, right, on Exhibit 7?
3 MR. HALLAM: The document speaks for itself,
4 Counsel. Why are you asking him to go through a
5 12-page document and compare numbers? You can do
6 that for yourself. You don't need him to do that.
7 That's not what he's here to testify
8 about. It's nothing he's ever seen before and never
9 helped prepare.
10 BY MS. HOLLAND:
11 Q. The documents under the column
12 "DOCUMENT #," P001007 is the first one there.
13 Do you see that?
14 A. Yes.
15 Q. That does not correspond to the Bates
16 numbering on the documents that your office provided
17 to me today, does it?
18 MR. HALLAM: No foundation. Calls for
19 speculation.
20 Counsel, let me just cut through it.
21 No. These numbers from our document privilege list
22 and the District Court proceeding do not correspond
23 with the numbers in the documents that we produced
24 today. We've just done it over at Number 1 and
25 finished up with Number 66, apparently.

Page 128

1 MS. HOLLAND: So...
2 MR. HALLAM: And if you want to list -- on the
3 assumption that you'll do the same for me when the
4 time comes up -- the documents that we did not
5 produce, because they are not responsive and they're
6 privileged, because they don't relate to this
7 cancellation proceeding, I'll be happy to give you
8 that list.
9 MS. HOLLAND: Okay. I need something that
10 shows me what you've produced and what you're still
11 withholding, that corresponds to the document numbers
12 on Exhibit 7 and to the new numbers on the documents
13 you just provided today, so I can tell if there are
14 any other e-mails within the relevant time period.
15 Especially with the description like
16 the first one, "Redacted emails re trademark
17 application," whether, you know, those are things
18 that I should have been provided.
19 MR. HALLAM: I will let you know and give you
20 a list of any documents that are on this privilege
21 list, which you marked as Exhibit 7, that we have not
22 produced.
23 MS. HOLLAND: Okay.
24 MR. HALLAM: And I just want to repeat again,
25 for the record, that our production of clearly

Page 129

1 privileged documents is not intended as a waiver and
2 should not be construed as a waiver of the
3 attorney/client privilege in general.
4 We produced and waived the privilege
5 only with respect to documents that pertain to the
6 trademark applications at issue in this cancellation
7 proceeding.
8 We're not waiving the privilege with
9 respect to any other communications with Mr. Supnik
10 that do not pertain to the trademark applications at
11 issue in this litigation.
12 MS. HOLLAND: Well, again, by putting
13 Mr. Supnik's intent at issue in this case and putting
14 him on the witness list, we think you've waived the
15 privilege as to communications with him about
16 certainly the registrations at issue. And maybe
17 we're in agreement on that.
18 MR. HALLAM: You know, yeah, we are. I'm not
19 disputing that.
20 And I haven't withheld any documents
21 that have anything to do with the registrations of
22 the applications.
23 But Mr. Supnik has represented Roxbury
24 and advised us on numerous unrelated matters, that
25 is, unrelated to the trademark applications at issue

Page 130

1 in this cancellation proceeding. Including
2 litigation and prospective litigation.
3 **BY MS. HOLLAND:**
4 **Q.** Did you register the mark "Gone in 60
5 Seconds" on, for among other things, pre-recorded
6 videotapes, DVDs, et cetera, Mr. Supnik?
7 **A.** I'm hesitant to get into a discussion
8 about that, because there is probably attorney/client
9 privilege that I'm concerned about with respect to
10 other clients.
11 **So...**
12 **Q.** Well, were you attorney of record with
13 respect to "Gone in 60 Seconds"?
14 **A.** Yes.
15 **MS. HOLLAND:** All right. I would like to mark
16 as Exhibit 8 another declaration of Paul D. Supnik.
17 (THE DOCUMENT REFERRED TO WAS
18 MARKED AS EXHIBIT 8 AND IS
19 BOUND UNDER SEPARATE COVER)
20 **BY MS. HOLLAND:**
21 **Q.** Did you sign this declaration,
22 Mr. Supnik?
23 **A.** Yes, I did.
24 **Q.** Even though this copy isn't signed, at
25 some point you did sign it?

Page 131

1 **A.** I believe so.
2 **Q.** Okay. In Paragraph 2 of this
3 declaration, you state that you,
4 "... communicated with the
5 attorney at the TTAB who is handling
6 the Petition to Cancel, filed by
7 Penthouse Digital Media Productions,
8 Inc. on September 12, 2008."
9 What was the subject of that
10 communication?
11 **A.** Frankly, I don't remember.
12 **Q.** Well, in Paragraph 4, you state that
13 you have 20-plus years dealing with the TTAB.
14 **Correct?**
15 **A.** Yes.
16 **Q.** Was that true?
17 **A.** It probably is.
18 **Q.** And what was this declaration filed in
19 support of, if you remember?
20 **MR. HALLAM:** If you remember. If you don't...
21 **THE WITNESS:** Yeah. I think the idea was to
22 probably suspend the TTAB proceeding for the District
23 Court proceeding.
24 **MR. HALLAM:** And just for the record, in fact,
25 the document states itself, at the bottom, that it's

Page 132

1 the declaration of Paul D. Supnik in support of
2 Plaintiff's Opposition to Defendants' Motion to Stay.
3 **BY MS. HOLLAND:**
4 **Q.** So you state that if the motion to
5 suspend those proceeding is not granted --
6 **MR. HALLAM:** Where are you reading from,
7 Counsel?
8 **MS. HOLLAND:** It's Line 23 of Paragraph 4.
9 **Q.** Are you referring to Roxbury's motion
10 to suspend the cancellation proceeding that we're
11 discussing today?
12 **A.** I think so. I'm a little bit confused
13 because it seems to me there was another proceeding.
14 **But I guess this is the only one that**
15 **was... I'm somewhat confident that that's what we're**
16 **talking about.**
17 **MS. HOLLAND:** Okay. Well, let me mark as
18 Exhibit 9 Registrant Cloudstreet Inc.'s initial
19 disclosures.
20 (THE DOCUMENT REFERRED TO WAS
21 MARKED AS EXHIBIT 9 AND IS
22 BOUND UNDER SEPARATE COVER)
23 **MS. HOLLAND:** I'm just going to refer you to
24 Page 2 of that.
25 **MR. HALLAM:** I'm sorry. I didn't get a copy.

Page 133

1 **BY MS. HOLLAND:**
2 **Q.** Section "I. DISCLOSURES," Paragraph A.
3 "Persons Likely to Have Discoverable Information That
4 Registrant May Use to Support Its Claims."
5 And identified in that paragraph is
6 Paul Supnik, Esquire. So you've been identified.
7 Do you understand that?
8 **A.** Yes.
9 **Q.** And the general subject areas of
10 knowledge include preparation and submission of the
11 applications for registration.
12 **Correct?**
13 **A.** Yes.
14 **Q.** Representations to the PTO in
15 connection with the applications, correct?
16 **A.** Yes.
17 **Q.** Okay. The rules and guidelines in
18 connection with the Patent & Trademark Office and the
19 TTAB, including the Trademark Manual of Examining
20 Procedure.
21 Do you see that?
22 **A.** Yes.
23 **Q.** And then finally, the subjects set
24 forth in Mr. Supnik's declarations filed in the
25 District Court proceeding in support of Registrant's

Page 134

1 **Opposition to Petitioner's Motion to Stay filed on**
2 **November 10, 2008, and Registrant's Motion for**
3 **Summary Judgment filed in October of 2009.**
4 **Do you see that?**
5 **A. Yes.**
6 **Q. Are you planning to offer testimony on**
7 **any of those subject areas in the cancellation**
8 **proceeding?**
9 **MR. HALLAM:** I'm going to object and instruct
10 the witness not to answer, to the extent that your
11 answer would disclose any communications with me
12 regarding your prospective testimony in this case.
13 Other than that, if you have anything
14 to offer other than what we may have discussed, you
15 may answer.
16 **THE WITNESS:** Just in general, these appear to
17 be the general subject areas that I would imagine
18 would probably be discussed in the testimony.
19 **BY MS. HOLLAND:**
20 **Q. And since we've got it in front of us,**
21 **Exhibit 8, which is your November 10th, 2008**
22 **declaration...**
23 **A. Yes.**
24 **MR. HALLAM:** I think I can help short-circuit.
25 There doesn't seem to be anything in Exhibit 8 that's

Page 135

1 relevant to this cancellation proceeding.
2 I think we were just, in an abundance
3 of caution, being all inclusive of anything that he's
4 ever said before that he might testify to.
5 But reading through it, other than the
6 fact that it says in Paragraphs 1 and 2 that he
7 specializes in intellectual property and appears
8 before the TTAB, and he filed on behalf of Roxbury
9 Entertainment the applications for registration of
10 ROUTE 66, I don't think the rest of it really has
11 anything to do with our cancellation proceeding.
12 **MS. HOLLAND:** Thanks. That's all. I just
13 wanted to make sure I wasn't missing anything there.
14 **MR. HALLAM:** But he was sure right on the
15 timing.
16 **MS. HOLLAND:** I think you underestimated the
17 timing. Even if you doubled the timing, it would
18 still be...
19 Oh, I suppose we're still somewhere in
20 the window that you asked me.
21 We'll mark as Exhibit 10 a
22 Supplemental Declaration of Paul Supnik in Support of
23 Plaintiff's Reply to Motion for Summary Judgment, or
24 in the alternative, Summary Adjudication.
25 ///

Page 136

1 (THE DOCUMENT REFERRED TO WAS
2 MARKED AS EXHIBIT 10 AND IS
3 BOUND UNDER SEPARATE COVER)
4 **MS. HOLLAND:** Okay. Paragraph 3 of that
5 declaration, which was filed on... Let's just look
6 at the filing date for a minute.
7 The filing date at the top of the
8 document shows it was filed with the District Court
9 on December 2nd.
10 **THE WITNESS:** November 2nd.
11 **MS. HOLLAND:** I'm sorry. November 2nd --
12 you're right -- 2009.
13 But then your signature block says it
14 was executed in Madrid Spain, on the 3rd of November.
15 **THE WITNESS:** That was probably at
16 1:00 o'clock in the morning.
17 **BY MS. HOLLAND:**
18 **Q. So that's due to the time difference?**
19 **A. I think so.**
20 **Q. All right. So in Paragraph 3,**
21 **Line 16, you state,**
22 **"I believed then as I believe**
23 **now that all of the statements made**
24 **to the PTO in relation to the filing**
25 **and processing of Roxbury's applications**

Page 137

1 **for its Marks in Route 66 were made**
2 **truthfully and accurately to the**
3 **best of my knowledge and based on my**
4 **understanding of applicable PTO guidelines**
5 **and procedures, as well as applicable**
6 **law."**
7 **Do you still believe that all of those**
8 **statements were truthfully and accurately made?**
9 **A. Yes.**
10 **Q. Do you still believe that you fully**
11 **complied with the TMEP guidelines pertaining to the**
12 **date of first use in those applications?**
13 **A. As far as I understand it, yes.**
14 **Q. And do you believe that you undertook**
15 **the requisite diligence in determining that Roxbury**
16 **or Cloudstreet had the right to apply for those**
17 **registrations?**
18 **A. Based on my acquaintanceship with**
19 **Mr. Hallam over a long period of time, yes.**
20 **Q. And in Paragraph 6 of this**
21 **declaration, at Line 14, you state,**
22 **"If I had been subpoenaed,**
23 **I would have provided my testimony**
24 **and any requested documents other**
25 **than any which would have disclosed**

Page 138

1 my privileged communications with
2 my clients, Roxbury Entertainment
3 or its President and counsel, Kirk
4 Hallam."
5 Do you see that?
6 A. Yes.
7 Q. Okay. Is that still your position?
8 MR. HALLAM: That he would have, had he been
9 subpoenaed?
10 BY MS. HOLLAND:
11 Q. Do you still agree with that
12 statement?
13 A. Privilege. Oh, privileged
14 communications.
15 I don't see anything about work
16 product here. So probably work product would have
17 had to be excluded as well.
18 Q. Okay. So now you have been
19 subpoenaed.
20 A. Yes.
21 Q. Have you provided everything except
22 privileged and work product communications to us?
23 MR. HALLAM: I think we've covered that
24 subject. And I will instruct the witness not to
25 answer, based on attorney/client privileged

Page 139

1 communications with me.
2 And I think it's very evident that
3 this exhibit that you're asking him about references
4 a subpoena in the District Court proceeding some two
5 years ago, and not a subpoena at this stage, after
6 there was a stipulation of counsel reached and filed
7 by the law firm of Katten Muchin referencing that
8 agreement that we had concluded our discovery on this
9 matter.
10 MS. HOLLAND: So you're instructing him not to
11 answer that question?
12 MR. HALLAM: I am. Because any answer would
13 reflect communications he's had with me.
14 BY MS. HOLLAND:
15 Q. In Paragraph 7, you state as of
16 December 2009 I have never been retained as an expert
17 to testify in this litigation.
18 Do you see that?
19 A. Yes.
20 Q. Have you, as of today's date, been
21 retained to testify as an expert in this cancellation
22 proceeding?
23 A. No.
24 Q. Do you expect to be retained as an
25 expert to testify in this cancellation proceeding?

Page 140

1 A. As a retained expert? No.
2 Q. As an unretained expert, do you expect
3 to be asked to testify?
4 A. That's possible.
5 Q. What would your area of expert
6 testimony be?
7 MR. HALLAM: Objection; calls for speculation.
8 No foundation. Also, attorney/client privilege;
9 calling for the communications with me as to what
10 subjects he might be asked to testify about.
11 MS. HOLLAND: So you're instructing him, and
12 you're following the instruction?
13 MR. HALLAM: Yes.
14 THE WITNESS: Yes.
15 BY MS. HOLLAND:
16 Q. What is the difference in your mind
17 between being a retained expert and being an
18 unretained expert?
19 A. I guess a retained expert is somebody
20 that's been retained especially for the purposes of a
21 litigation and, in which case, all documents
22 generated and created in that context are available
23 for discovery.
24 Whereas I'm not sure that I have
25 anything specific for an unretained expert.

Page 141

1 Q. Okay. We've covered a few
2 conversations with the examining attorney. One
3 specific to the motion picture registration?
4 A. Yes.
5 Q. Another, you referenced in Exhibit 8,
6 which was the declaration, but you couldn't recall
7 what it was about. It was in September of 2008.
8 A. Yes.
9 Q. You still don't remember what that was
10 about?
11 A. No.
12 Q. Okay. Do you recall any other
13 communications with the examining attorney with
14 respect to any of the three registrations that you
15 prepared for ROUTE 66 marks?
16 A. There was something in one of those
17 e-mails that we went over that suggested that there
18 was a communication. Because, I think in that
19 e-mail, it said "I spoke to the examining attorney
20 today."
21 Q. Okay. And you're referring to the
22 e-mail... Let me make sure we covered all the
23 communications.
24 A. That's Exhibit 5, at the bottom.
25 Q. Right.

Page 142	Page 144
<p>1 A. And that has a date of August 15, 2 2006. 3 MS. HOLLAND: Let me see if I can find that 4 one. 5 (PAUSE IN THE PROCEEDINGS) 6 MS. HOLLAND: I'm going to mark the whole set 7 of documents you gave me this morning as the next 8 exhibit. But I need to go make a quick copy of a few 9 pages, to make them complete. 10 So can we go off the record for a few 11 minutes, so I can do that? 12 MR. HALLAM: Yes. 13 (WHEREUPON A RECESS WAS HELD 14 FROM 3:04 P.M. TO 3:10 P.M.) 15 MS. HOLLAND: So this is going to be 16 Exhibit 11. 17 (THE DOCUMENT REFERRED TO WAS 18 MARKED AS EXHIBIT 11 AND IS 19 BOUND UNDER SEPARATE COVER) 20 MS. HOLLAND: Back on the record, please. 21 So we've marked as Exhibit 11 a 22 complete set of the documents that were provided 23 today by Mr. Hallam on your behalf, Mr. Supnik. 24 I would like you to take a look at 25 this first page, which is Bates stamp 000001. And on</p>	<p>1 but... 2 MR. HALLAM: I understand, Kristin. And as I 3 said to you when we took a break just a minute ago, 4 it's my belief and I am aware there is one of four or 5 one of five and you don't see the rest. 6 It's because we previously produced 7 them in the District Court litigation. And we were 8 producing -- although we were not obligated to -- we 9 were producing the privileged documents that we had 10 not produced in the District Court proceeding without 11 a duplication of all the rest of the documents. 12 But, as I said to you off the record, 13 I will determine for you, if that is in fact the 14 case, in a situation where it says 1 of more than one 15 and you only see one here. 16 MS. HOLLAND: Well, just since it happens to 17 be the first in the stack, I'm referring back to 18 Exhibit 7, which is the privilege log. 19 I don't see any log entry for a 20 document. I might be missing it, but I don't see a 21 log entry for a document from July 6, 2005. 22 And this document now, Bates stamped 23 1, the first page of Exhibit 11, is an e-mail from 24 Mr. Supnik to you from Wednesday, July 6, 2005. 25 THE WITNESS: That's the first one on here,</p>
Page 143	Page 145
<p>1 the top right-hand corner, it says "Page 1 of 5." 2 Q. Do you see that? 3 A. Yes. 4 Q. Do you know where the remaining four 5 pages are of that e-mail? 6 A. Probably it would still be on a 7 computer that I was using at that point in time. Or 8 I'm not sure, frankly. I generally don't print out 9 those types of e-mails. 10 Q. So who assembled these documents for 11 production? The documents we're looking at now, 12 Exhibit 11. 13 MR. HALLAM: I've already addressed that. And 14 I'm going to instruct the witness not to answer. 15 MS. HOLLAND: On the grounds of 16 attorney/client privilege? 17 MR. HALLAM: Um-hmm. And on the grounds that 18 it's asked and answered, and that it's been covered 19 ad nauseam throughout this deposition. 20 MS. HOLLAND: Well, I'll just note that I 21 don't have a complete record of even the e-mails that 22 you've agreed to produce. 23 Apparently, because I don't have, for 24 example, the remaining four pages of the first 25 e-mail. And I'll go through the rest of the stack,</p>	<p>1 isn't it? 2 MS. HOLLAND: Is it? Oh, you know what? I 3 apologize. See, it's right in front of my face. 4 Okay. 5 So you're saying, Mr. Hallam, that if 6 I look at P00107 in the District Court production 7 I'll be able to find possibly the other four pages of 8 this e-mail? 9 MR. HALLAM: Where did you get that number 10 from? 11 THE WITNESS: Here. Look. 12 MR. HALLAM: Oh, most likely, yes. Unless 13 there is some other document that's an e-mail dated 14 July 5th. But, most likely, on July 6th those are 15 one in the same. Yes. 16 MS. HOLLAND: Has this e-mail been redacted? 17 THE WITNESS: No. No. 18 MS. HOLLAND: No, it has not. Okay. 19 They do seem to be, now that you've 20 shown me, Mr. Supnik, they seem to be corresponding 21 with the dates on your privilege log, Number 7, with 22 some exceptions. It might be type-os, but... 23 Do you know if you applied a date 24 cutoff, Mr. Hallam, to when you produced things? It 25 looks like the production from today ends in May of</p>

Page 146

1 '07.
2 **MR. HALLAM:** I produced everything that had
3 not previously been produced in the District Court
4 litigation. That is, it was withheld on the grounds
5 of privilege, that had anything to do with the
6 trademark applications or their prosecution.
7 So, no, I didn't use a time cutoff,
8 but...
9 **BY MS. HOLLAND:**
10 **Q.** You mentioned earlier, Mr. Supnik,
11 that you have a long history with Mr. Hallam?
12 **A.** Yes.
13 **Q.** When did you first meet Mr. Hallam?
14 **A.** I believe when he was either a friend
15 or a clerk of -- probably a friend of -- an attorney
16 that I shared office space with many years ago.
17 How many years ago?
18 **MR. HALLAM:** A hundred.
19 **THE WITNESS:** Maybe 20.
20 I'm not sure that he had even gone to
21 law school yet. He might have gone.... Frankly, I
22 don't remember. I don't remember.
23 **MS. HOLLAND:** Okay.
24 **Q.** So more than 20 years?
25 **A.** Probably.

Page 147

1 **(DISCUSSION HELD OFF THE RECORD)**
2 **BY MS. HOLLAND:**
3 **Q.** When did you first start working for
4 Roxbury Entertainment or Cloudstreet?
5 **A.** My guess is it's somewhere in the
6 neighborhood of five or six years ago.
7 **Q.** Okay. Let's look at Bates number
8 000011 in Exhibit 11. There are some e-mails here
9 referencing a specimen of goods. One of which
10 contains the word "DEMO."
11 Do you see that?
12 **A.** Yes.
13 **Q.** And then, your e-mail at the top of
14 the chain to Mr. Hallam, in the middle of the e-mail,
15 you say,
16 "The other reason that this
17 may not be a good specimen is that
18 it says 'DEMO' suggesting that this
19 is not being sold."
20 Do you see that?
21 **A.** Yes.
22 **Q.** What were you referring to?
23 **A.** Frankly, I don't recall. I did see
24 this and I don't -- frankly -- I don't remember.
25 **Q.** Okay.

Page 148

1 **A.** I don't know what I was provided with.
2 **Q.** Let's look at an earlier chain. I'll
3 refer you now to Pages 14 and 15 of Exhibit 11.
4 **A.** Yes.
5 **Q.** It looks like these are e-mails
6 related to the "DEMO" issue.
7 Do you see those?
8 **A.** Yes.
9 **Q.** Mr. Hallam writes to you,
10 "Paul, I do understand the
11 problem with the word 'demo' and I
12 can delete that and send it back to
13 you."
14 Does that refresh your recollection
15 when you read that?
16 **A.** It does not.
17 **Q.** Do you have a copy of the specimen
18 with the word "demo" on it that's referred to in this
19 e-mail?
20 **A.** I don't know if the specimen was an
21 actual DVD or something else. I don't recall seeing
22 anything like that.
23 **Q.** Do you have any understanding of what
24 Mr. Hallam means, in his e-mail at the top of
25 Page 14, where he says,

Page 149

1 "But I don't understand your
2 point that for the service mark, the
3 sample has to have been in use at
4 least by the time of filing."
5 **A.** Yeah. And what was the question?
6 **Q.** Do you know what he was referring to
7 there?
8 **A.** No. Because I'm not sure where the
9 word "demo" appeared. If it was on packaging. If it
10 was stamped on a DVD. I don't understand. Or if it
11 was on a... What it was.
12 **Q.** Well, the next sentence, Mr. Hallam
13 says,
14 "This is not only a specimen
15 of the mark in use at this very
16 moment, but it is also a sample of
17 the mark as used on each of the
18 episodes of the series from September
19 30, 1960 to today. As I mentioned,
20 the artwork/logo on the dvd is
21 lifted directly and exactly from
22 the first frames of each episode.
23 This is the mark taken directly
24 from the masters of the series. I
25 will delete the 'demo' and send it

Page 150

1 back to you, but I think with that
2 deleted I am giving you exactly
3 what you are asking for: a specimen
4 of the mark as used since 1960 through
5 today."
6 So in reading that now, you don't know
7 what he's talking about?
8 A. I really don't know.
9 Q. Do you know whether Roxbury had in use
10 the specimen that Mr. Hallam is suggesting he create
11 in this e-mail as of July of 2005?
12 A. It depends upon what you mean by
13 "in use."
14 Q. Well, he is referencing here the
15 artwork/logo on the DVD, right?
16 A. Yes.
17 Q. And apparently it has the word "demo"
18 on it. Because you're debating whether "demo" has to
19 be on or off.
20 So do you know whether that DVD was
21 being sold to anybody in commerce as of July 1st,
22 2005?
23 MR. HALLAM: Does he recall now, as he sits
24 here now?
25 THE WITNESS: I don't recall. I don't know.

Page 151

1 I don't have a specific recollection of what occurred
2 right here.
3 MS. HOLLAND: Okay. Well, we have to reserve
4 the right to continue questioning on this issue once
5 we get your complete file and get a copy of whatever
6 the specimen was with the word "demo" on it and then
7 what it was without the word "demo" on it.
8 MR. HALLAM: And we reserve the right to
9 enforce the stipulation of counsel that was reached
10 and submitted to the TTAB by petition to counsel.
11 MS. HOLLAND: All right. We understand your
12 position but, you know, I guess we agree to disagree
13 on that.
14 Q. Again, let's look at Page 16 of
15 Exhibit 11. It's another e-mail from Mr. Hallam.
16 And this one is from July 5th of 2005, a few days
17 after the prior e-mail exchange.
18 This e-mail references a photo of the
19 ROUTE 66 mark, but there is no attachment.
20 Was there an attachment to this
21 e-mail?
22 A. I don't have a specific recollection
23 of this e-mail.
24 Q. And then, this is Mr. Hallam writing
25 in the next paragraph,

Page 152

1 "By the way, I recall that
2 when I tried, unsuccessfully, to
3 register Gone in 60 Seconds, and I
4 sent the PTO a photo of the logo
5 on a box with the toy car in it,
6 the PTO thought I was trying to
7 register the car design as well as
8 the words 'Gone in 60 Seconds',
9 even though I specifically described
10 in the application that the mark
11 was only the words and not any other
12 artwork or designs."
13 Did you work with Mr. Hallam on the
14 "Gone in 60 Seconds" registration?
15 A. Yes. Well, when I say "Yes," I'm not
16 sure which particular registration, but I did work
17 with Mr. Hallam.
18 Q. On one or more registrations for "Gone
19 in 60 Seconds"?
20 A. Yes.
21 Q. And he asks you the question:
22 "How do you avoid the PTO
23 here thinking that we are trying to
24 trademark the corvette in the picture
25 with the words 'Route 66' and not

Page 153

1 just the words?"
2 Did you answer that question?
3 A. I may have.
4 Q. What was your answer?
5 A. Well, if I answered, the way I would
6 have answered is that I think he was probably
7 confusing what's called a specimen with a drawing.
8 The drawing being the configuration of
9 the mark which is actually being registered as
10 opposed to the specimen, which is a proof of the
11 manner in which the mark is being used.
12 Q. For the ROUTE 66 marks, were you
13 registering word marks?
14 A. My recollection is yes.
15 Q. And the word marks only?
16 A. Yes.
17 Q. Let's look at Page 17. This one
18 contains your response to the e-mail we just read.
19 MR. HALLAM: By the way, I believe, looking at
20 Exhibit 16, that the picture that's being referred
21 to, although the photo of the ROUTE 66 mark, is the
22 photo that's a part of the exhibits to his
23 declaration, which is Exhibit Number 2 in this
24 deposition.
25 MS. HOLLAND: Okay.

Page 154

Page 156

1 **MR. HALLAM:** That you have.
2 **MS. HOLLAND:** Our position is we're still
3 entitled to the records as they're kept. The
4 business records. And we're not required to piece
5 things together from different productions and
6 different cases and assume that certain other
7 documents with different numbers are the missing
8 pages of these e-mails.
9 **MR. HALLAM:** And our position is that
10 Mr. Mandell very explicitly stipulated there will be
11 no further discovery, and that we be limited to the
12 discovery taken in the District Court proceeding, and
13 that he submitted that in a pleading to the TTAB.
14 That is, he made the statement that
15 there is and was an agreement among counsel to that
16 effect and the parties.
17 So I don't think we need to be
18 producing anything to you or taking any depositions.
19 But nonetheless, we are giving you the
20 unrequired discovery that is taking forth here today.
21 **MS. HOLLAND:** The order is pretty clear that
22 discovery is open. And we subpoenaed Mr. Supnik for
23 the deposition. You didn't object to the subpoena.
24 You didn't seek a protective order.
25 **MR. HALLAM:** Oh, I objected quite vehemently

1 resolved by the TTAB.
2 And it was in that vein that
3 Mr. Mandell and I reached an agreement there would be
4 no further discovery in the TTAB proceedings. An
5 agreement that obviously he doesn't feel that he has
6 to live up to.
7 **MS. HOLLAND:** Again, we continue to disagree
8 about the scope of the stipulation and all of those
9 things. But the proper procedure would have been to
10 seek a protective order, and you did not do that.
11 **MR. HALLAM:** Well, you think it would have
12 been the fault of the TTAB?
13 **MS. HOLLAND:** I don't know. It probably would
14 be the District Court from where the subpoena is
15 issued. But if you researched it and you know you
16 should have filed it...
17 **MR. HALLAM:** But somehow you're willing to
18 stipulate that we can get the TTAB to resolve our
19 discovery disputes and hear a motion for a protective
20 order or motions to quash subpoenas. And I'm all for
21 it. But I don't see it.
22 **MS. HOLLAND:** In any event, whatever the right
23 forum is...
24 **MR. HALLAM:** Maybe we can. Maybe we should
25 try that and see if the examining attorney will step

Page 155

Page 157

1 to any discovery in this proceeding, but nonetheless
2 allowed you to take this deposition today and produce
3 documents that previously were held on the grounds of
4 privilege. But I objected loudly and clearly on the
5 basis of the stipulation of counsel that your firm
6 submitted to the TTAB.
7 **MS. HOLLAND:** But the proper procedure --
8 **MR. HALLAM:** And I objected at the outset of
9 this litigation.
10 **MS. HOLLAND:** But the proper procedure was to
11 seek a protective order, and that wasn't done, so
12 this deposition is proceeding as noticed on the
13 documents as requested and in the spirit of
14 efficiency.
15 **MR. HALLAM:** From whom was I supposed to seek
16 a protective order?
17 **MS. HOLLAND:** The TTAB.
18 **MR. HALLAM:** No. They don't issue protective
19 orders.
20 **MS. HOLLAND:** Then the District Court in which
21 the subpoena was issued.
22 **MR. HALLAM:** Very well.
23 I think the District Court made it
24 clear it was deferring this case to the TTAB and is
25 not interested in our disputes until this thing is

1 in and be our discovery magistrate.
2 **MS. HOLLAND:** Wherever the right forum is, the
3 proper procedure with the third party subpoena is
4 seeking a protective order, if you disagree with the
5 scope, and you didn't do that.
6 And we're here today, and we don't
7 have all the documents here. So we'll probably have
8 to bring a motion to compel if we can't come to some
9 agreement and a continue date to finish this up.
10 **MR. HALLAM:** There is a suggestion. I'm going
11 to bring a motion for a protective order with the
12 TTAB. But at your suggestion, I'm going to do just
13 that.
14 **MS. HOLLAND:** Well, the procedure requires
15 that you do it before the deposition, and we've
16 already begun the deposition, so...
17 **MR. HALLAM:** And when I say I'm going to bring
18 a motion for a protective order, you and your
19 colleagues accused me of being a vexatious litigator,
20 even though I'm simply trying to enforce an agreement
21 that Mr. Mandell made and submitted in writing in a
22 pleading to the TTAB.
23 So when I take a more conciliatory
24 approach and allow you to take limited discovery even
25 though it's in breach of the agreement that counsel

Page 158

1 made that was submitted in writing to TTAB, now I'm
2 suddenly a vexatious litigator. So you've obviously
3 created a complete Catch 22 and turned it on its
4 head.
5 Mr. Mandell agreed there would be no
6 further discovery. There is nothing ambiguous about
7 what he and your colleagues submitted to the TTAB in
8 a pleading.
9 And the only thing that is contrary to
10 that is your continued efforts to take or re-take
11 depositions and re-litigate issues that are already
12 litigated before the District Court.
13 MS. HOLLAND: We disagree, but I'll just move
14 on.
15 Q. So moving on to Page 19, this e-mail
16 references an office action which apparently involved
17 other pending applications. This was from January of
18 2006.
19 Do you know what Mr. Hallam is
20 referring to there?
21 A. No, I don't. Well, wait. Referring
22 to where?
23 Q. I'm sorry. At the top of Page 19,
24 Mr. Hallam writes you,
25 "Paul.

Page 159

1 "I'm in Bulgaria for the
2 next month on Rin Tin Tin so we
3 will have to communicate via email."
4 Do you see that?
5 A. Yes.
6 Q. "What are these other prior
7 pending applications? How come we
8 did not pick these up in our search?
9 Pending applications don't come up?
10 What do you think is the proper
11 course of action in relation to these
12 pending applications? How much a
13 problem?"
14 What is Mr. Hallam referring to there?
15 A. Frankly, I don't know. There might
16 have been some applications in response to an office
17 action. Except that the examiner cited. But,
18 frankly, I don't recall.
19 Q. Okay. And I'll just represent that,
20 going through the privilege log which we marked as
21 Exhibit 7, I think there were some documents missing
22 from October of 2005 that might -- I don't know --
23 they might relate to this issue?
24 A. Well, there is a reference here to
25 office action 1.26.06. So I take it you must have

Page 160

1 the file history there.
2 Q. I don't have the whole thing right
3 here, but I could probably go back and find it.
4 MR. HALLAM: And I'll represent that the
5 attached office action was produced in the District
6 Court proceeding. And I merely supplemented it with
7 the attorney/client privileged communication between
8 myself and Mr. Supnik, which was withheld on the
9 grounds of privilege in the District Court.
10 BY MS. HOLLAND:
11 Q. It's a different office action, in any
12 event, than the one we discussed earlier about the
13 motion picture series issue, correct?
14 A. There is a reference to it below on
15 document number 000020.
16 Q. Okay. Thank you.
17 So what was the result of that office
18 action?
19 A. Well, if you go to e-mail 000024, it
20 says,
21 "It appears that the
22 ROUTE 66 application by the New
23 Jersey company in Class 9 has
24 been abandoned as of about a week
25 ago."

Page 161

1 And then it says,
2 "... I plan to respond to
3 the outstanding office actions,
4 now in each of the 3 soon to be
5 divided applications arguing lack
6 of confusing similarity with the
7 ROUTE 666 application."
8 Q. How did you respond? In writing or by
9 phone call? Do you remember?
10 A. Well, I'm sure it would have been in
11 writing. For a confusing similarity, I must have
12 responded in writing.
13 Q. And did you produce those documents?
14 A. I have no idea.
15 MR. HALLAM: I'm going to object again. I
16 think we've made it clear that we produced everything
17 that was already produced in the District Court
18 proceeding that's referred to here.
19 MS. HOLLAND: What was the Bates number,
20 Mr. Hallam, of the production?
21 MR. HALLAM: I don't have a clue. I didn't
22 come here having memorized thousands of pages of
23 Bates numbers.
24 We made a production, and we're not
25 about to repeat the production that we made

Page 162

1 previously in the District Court.
2 **MS. HOLLAND:** This was --
3 **MR. HALLAM:** I don't think we would be
4 obligated to if Mr. Mandell hadn't stipulated that
5 there would be no further discovery. But especially
6 in light of that stipulation by Mr. Mandell, which
7 was submitted to the TTAB in a pleading.
8 I think it's absurd for you to suggest
9 that we are obligated to go back and reproduce
10 everything that was previously produced in the
11 District Court. That's just... Talk about wasting
12 resources and vexatious litigation, I think that's
13 quintessential.
14 **MS. HOLLAND:** I haven't asked for that.
15 **Q.** Really, the answer to my question is
16 just: Did you bring with you today, Mr. Supnik, the
17 response that you prepared in writing to the January
18 office action?
19 **MR. HALLAM:** Mr. Supnik didn't bring documents
20 to this deposition. I brought them and produced them
21 on his behalf.
22 **MS. HOLLAND:** I'm just asking Mr. Supnik.
23 **Q.** Did you bring that with you today?
24 **A.** Did I bring an office action with me?
25 **No, I did not bring an office action with me.**

Page 163

1 **Q.** And you didn't bring your response to
2 the January office action with you either?
3 **A.** No. Personally, no.
4 **Q.** And neither did your attorney?
5 **MR. HALLAM:** Objection; no foundation.
6 **BY MS. HOLLAND:**
7 **Q.** Did he?
8 **A.** I don't have... I don't know whether
9 he did or didn't.
10 **MR. HALLAM:** I suggest you go back and look at
11 the thousands of pages of documents that were
12 produced to you in the District Court litigation.
13 **MS. HOLLAND:** I suggest that we have the right
14 to Mr. Supnik's files in response to a subpoena that
15 was served on him.
16 **MR. HALLAM:** I don't believe that you do. And
17 I have stated my reasons why.
18 **MS. HOLLAND:** I have stated our position, too.
19 I'm exploring what other documents are
20 out there. I'm entitled to do that.
21 And if you could identify them and
22 just describe them particularly, where I'm supposed
23 to find them, maybe that would be a sufficient meet
24 and confer.
25 **But you can't do that, and I am still**

Page 164

1 entitled to know what business records Mr. Supnik has
2 since his intent is at issue in this case.
3 **MR. HALLAM:** I'll give you all the Bates stamp
4 numbers of all the documents that we produced in the
5 District Court litigation, and then you can do your
6 homework and see what you've already got in your
7 file.
8 I'm not obligated to do that homework
9 for you.
10 **MS. HOLLAND:** That's not the way this works.
11 But I've heard --
12 **MR. HALLAM:** Apparently it works whichever way
13 you and Mr. Mandell decide, one day at a time, that
14 it's to work.
15 I'm sorry. But I make stipulations
16 with opposing counsel, and I expect them to keep to
17 their word. Especially when they file with the TTAB
18 in the form of a pleading. That's how it's supposed
19 to work, Ms. Holland.
20 **MS. HOLLAND:** I'm just going to move on.
21 **Q.** Referring to Page 27, Mr. Hallam
22 refers to,
23 **Our first sales anywhere of the DVD of**
24 **the Best of Route 66 Television Series at the**
25 **Route 66 Rendezvous on September 15th, 2005.**

Page 165

1 **Do you see that?**
2 **A.** Yes.
3 **Q.** Did he send you any samples or
4 specimens of the DVDs that he says were sold at that
5 rendezvous?
6 **A.** I don't recall.
7 **Q.** And then he says the first sales of
8 interstate commerce via web and Amazon were on
9 September 19th, 2005.
10 **Do you see that?**
11 **A.** Yes.
12 **Q.** Do you know if he sent you any
13 documents or records of any kind reflecting those
14 sales?
15 **A.** I don't recall.
16 **MR. HALLAM:** You've got tons of that in your
17 files, Ms. Holland, that were produced in the
18 District Court proceeding, that you obviously choose
19 to ignore, making frivolous allegations.
20 **BY MS. HOLLAND:**
21 **Q.** It says in this e-mail that Stephanie
22 will send you a couple of samples of the packaged
23 Route 66 DVDs.
24 **Do you know if you received those?**
25 **A.** I received packaged DVDs. I don't

Page 166

1 know if they were these.
2 Q. And you still have those at your
3 office, in the files?
4 A. I have one packaged DVD at the office
5 and one set of the packaged DVDs opened at home.
6 Q. Okay. On Page 28 of Exhibit 11,
7 responding to Mr. Hallam's e-mail, you say.
8 "I think that it is worth
9 the effort to do some research and
10 use the earlier date some 25 years
11 ago, since it is very difficult to
12 later allege an earlier date of use
13 if necessary."
14 Do you recall what you were referring
15 to there?
16 A. I mean, I don't specifically recall
17 this e-mail. But, you know, obviously I sent it,
18 yes.
19 Q. Okay. Were you asking Mr. Hallam to
20 do research to determine the first or earliest date
21 that the ROUTE 66 television series was sold on VHS?
22 A. I'm not sure specifically what I was
23 referring to. But I did want the first... I did
24 want to get the earliest date of first use that we
25 could reasonably allege.

Page 167

1 Q. And that would have been first use by
2 Bert Leonard or his company Sony? Is that what you
3 were referring to?
4 A. Let's see. Well, this is for Class 9,
5 so probably so.
6 Q. Okay. On VHS?
7 A. Probably so.
8 Q. All right. Okay. Looking at Page 33
9 of Exhibit 11. And I believe we previously marked
10 this as well, as Exhibit 4. So we're now looking at
11 what was also marked as Exhibit 4 in this deposition.
12 Okay. So your e-mail --
13 THE WITNESS: Can we take a break?
14 MS. HOLLAND: Oh, sure. Of course.
15 (WHEREUPON A RECESS WAS HELD
16 FROM 3:52 P.M. TO 3:56 P.M.)
17 BY MS. HOLLAND:
18 Q. So going to Page 33 now, in
19 Paragraph 2 of your e-mail there, your July 17th,
20 2006 e-mail to Mr. Hallam, you say,
21 "With respect to the
22 application in class 41 for
23 entertainment services, I plan to
24 submit an amendment changing the
25 identification of goods from

Page 168

1 entertainment services, namely,
2 title of an ongoing television
3 series to Entertainment in the
4 nature of on-going television program
5 in the field of drama, action and
6 adventure. Please confirm whether
7 or not distribution is of your own
8 show, or if it is distribution of
9 the series for others. If not for
10 others, then distribution needs to
11 be deleted."
12 So let me break this down here.
13 Why did you describe it as an ongoing
14 television program?
15 A. That was probably a request in an
16 office action, I would think.
17 Q. And what is an ongoing television
18 program, in your mind?
19 A. A television program that has more
20 than one episode.
21 Q. Even if it stopped being filmed 40
22 years before you filed the application, it's still
23 ongoing?
24 A. It was ongoing at one time. And the
25 fact that the broadcast of new episodes stopped does

Page 169

1 not necessarily mean that it's not ongoing.
2 Q. So programs that stopped having new
3 episodes many years ago can still be ongoing
4 television programs, in your mind?
5 A. In my mind.
6 The problem with this Class 41 in
7 reference to titles is that there is no good
8 explanation in the TMEP as to what this is all about.
9 And I have not been able to find any
10 good definitive answer to these types of questions.
11 Either for Class 41 or Class 9.
12 Q. Okay. And then you ask Mr. Hallam to
13 confirm whether the distribution is of your own show
14 or if it is distribution of the series for others.
15 Why did you ask for that
16 clarification?
17 A. Probably... And I don't know the
18 answer to this, because I don't have the office
19 action in front of me.
20 But a common rejection is, when you
21 have "distribution" in the application, the examining
22 attorney will often say: Is this distribution for
23 yourself or is it for others?
24 Just as in Class 35, they'll ask: Are
25 you doing your own advertising or you're doing it for

Page 170

1 others?

2 If you're doing advertising for your
3 own product, if you're distributing your own product,
4 you're not providing a distribution service and
5 therefore it doesn't belong there.

6 Q. So do you know if Roxbury
7 Entertainment was distributing the television series
8 for itself or for others?

9 A. My impression was it was really
10 probably distributing it for itself, and therefore I
11 thought the thing to do was to delete it from the
12 application.

13 Q. Do you know whether Roxbury
14 Entertainment had the right to license ROUTE 66 for
15 broadcast television in the United States back in
16 2006?

17 A. My impression was that it did, based
18 on general conversations with Mr. Hallam.

19 Q. And I said broadcast television. But
20 would that same understanding apply to any medium?

21 A. I would think that when you're saying
22 broadcast television, I would think it would include
23 broadcast, cable and syndication.

24 Q. Mr. Hallam responds, at the top of the
25 page, 33,

Page 172

1 MS. HOLLAND: Page 35, at the bottom.

2 MR. HALLAM: Thank you.

3 MS. HOLLAND: And I'm just noting that this
4 was previously marked earlier as Exhibit 5 to this
5 transcript as well.

6 Q. So after going over the prior e-mails,
7 is your recollection refreshed about your discussion
8 with the examining attorney, that's referenced on
9 Page 35?

10 A. I can't tell you whether or not it's
11 completely refreshed. In other words, I don't have a
12 specific recollection of that discussion.

13 But it seems entirely likely that this
14 is an e-mail that I sent, and that based on this
15 e-mail, I had a conversation with the examining
16 attorney about this subject.

17 Q. Okay. And then, as a result, you
18 asked her -- the examining attorney -- to drop the
19 "distribution services" from the description?

20 A. Yes.

21 Q. And what's the import of dropping
22 "distribution services" from the description?

23 A. If you haven't used a particular
24 service in an application, it shouldn't be there.

25 Also, it's possible the distribution

Page 171

1 "... I further confirm that
2 Roxbury Entertainment OWNS the
3 entire 116 episode television series
4 Route 66."

5 Did that answer your question about
6 whether distribution was of its own show or of the
7 series for others?

8 A. My sentence immediately following,
9 especially that they really weren't distributing for
10 others, they were just distributing on their own
11 behalf.

12 Q. And that understanding was based on
13 Mr. Hallam's statements to you?

14 A. Statements to me and, for example,
15 probably that e-mail.

16 Q. Okay. In writing and verbally?

17 A. Probably.

18 Q. Okay. And now we get to what we
19 previously marked as Exhibit 5, and that reference to
20 the conversation with the examining attorney about
21 Class 41 and distribution.

22 Do you see that?

23 A. Yes, I do.

24 MR. HALLAM: I'm sorry. You're looking now,
25 just for reference...

Page 173

1 might have been in a class other than Class 41. It
2 might have been Class 35, for example.

3 I don't know the answer to that
4 offhand.

5 Q. All right. Just for the record, on
6 Page 42, that is a trademark principal register for
7 ROUTE 66, registration number 3,189,543.

8 Correct?

9 A. Yes.

10 Q. And that shows that the mark has been
11 registered for pre-recorded DVDs and videocassettes
12 featuring drama, action and adventure, in Class 9.

13 Correct?

14 A. Yes.

15 Q. And this is for the word mark only?

16 A. Yes.

17 Q. And then, moving ahead to Page 47,
18 Page 47 of Exhibit 11 is the service mark principal
19 register for ROUTE 66 for entertainment services,
20 namely, entertainment in the nature of an ongoing
21 television program in the field of drama, action and
22 adventure television production services, in
23 Class 41.

24 Right?

25 A. Yes.

Page 174

1 Q. And then, again, it's for a word mark,
2 correct?
3 A. Yes.
4 Q. Do you know if the mark is still being
5 used in connection with an ongoing television series
6 as of today's date, 2011?
7 A. Well, I guess it goes back to the
8 definition of what you mean by "being used."
9 You mean is it currently being... Is
10 the show currently being broadcast or distributed...
11 Let's try that again.
12 Is the series being broadcast, cable
13 cast or used either in the United States or outside
14 the United States today?
15 And the answer is: I don't know.
16 MR. HALLAM: You haven't seen it on your local
17 TV? You're not looking carefully.
18 THE WITNESS: I don't watch a lot of
19 television.
20 MS. HOLLAND: They keep adding channels. Is
21 it on somewhere?
22 MR. HALLAM: It's on over 500 stations around
23 the country.
24 MS. HOLLAND: I haven't been looking. I
25 haven't looked for it either. I should look for it.

Page 175

1 MR. HALLAM: But I can't tell you what time
2 or, you know, what day.
3 MS. HOLLAND: I'm just looking to see if you
4 attached or provided the final registration with
5 these documents. And I don't see it, but I know we
6 have that. I just have a copy of it.
7 Q. But I do see a cover letter, document
8 58?
9 A. I see that -- oh, no. I was looking
10 at a cover letter. A different one.
11 Q. Document 58 references a trademark
12 registration registered September 11, 2007 for
13 ROUTE 66, in Class 9.
14 A. Yes.
15 Q. Is that the registration that relates
16 to the motion picture film series?
17 A. Actually, I don't know offhand.
18 Because we had the two Class 9 applications.
19 Yeah, that would be for the film
20 series.
21 Q. So the film series registration issued
22 September 11th, 2007?
23 A. According to this, yes.
24 Q. Okay. Looking at Page 62 -- well, 61
25 and 62 -- it's another e-mail, and it references some

Page 176

1 attachments which are not attached. 14 pictures,
2 JPG.
3 Do you see that?
4 A. Yes.
5 Q. Do you know if you retained copies of
6 those attachments?
7 A. It's possible.
8 Q. Where would you look to find out?
9 A. I'd look on my computer.
10 Q. Do you have a special file for your
11 work on ROUTE 66 registrations on your computer?
12 A. I have a file for Roxbury on my
13 computer, yes.
14 Q. Did you review that file in
15 preparation for your deposition today?
16 A. I might have simply clicked to see
17 what was there, but I didn't open up anything.
18 Q. Okay. Did you send any of the
19 documents in that file to Mr. Hallam?
20 A. I don't recall doing so.
21 MR. HALLAM: If you look in your file from the
22 production in the District Court case, you will find
23 that we produced those.
24 MS. HOLLAND: I mean, again, we're entitled to
25 get a production so that I can tell it's from

Page 177

1 Mr. Supnik's office. I need to be able to
2 distinguish the source of records.
3 And the fact that I have one copy of
4 something somewhere doesn't satisfy that requirement.
5 And I don't know whether I have these
6 or not, but assuming that we do have some version
7 somewhere, I'm still entitled to know what's in
8 Mr. Supnik's files, and I'm entitled to get a
9 response to a business records subpoena from
10 Mr. Supnik.
11 MR. HALLAM: And, again, I don't believe that
12 you are, because Mr. Mandell very clearly, in an
13 agreement that was confirmed to the TTAB in a
14 pleading, said that discovery has been concluded, we
15 are going to be limited to the discovery taken in the
16 District Court case, and we have given you more than
17 you are entitled to today.
18 MS. HOLLAND: I don't think one deposition
19 with an incomplete document production is more than
20 we're entitled to.
21 MR. HALLAM: It has to do with duplication of
22 all the discovery. I know you would, but that is not
23 what Mr. Mandell agreed to.
24 MS. HOLLAND: No, we didn't. We didn't depose
25 Mr. Supnik before. We never received his files.

Page 178

Page 180

1 That's all we want.

2 **MR. HALLAM:** Your choice, Counsel. Your
3 choice. That was your choice not to subpoena
4 Mr. Supnik in the District Court proceeding.

5 And I'm sure you have an explanation
6 of why tactically you chose not to, but...

7 **MS. HOLLAND:** We didn't think you were going
8 to use him as a witness. That's why. Because you
9 didn't disclose him. That's why.

10 We knew Mr. Supnik existed, of course,
11 just like we knew you as counsel existed. But we
12 didn't know he was going to be a percipient witness
13 until you submitted his declaration in support of the
14 summary judgment briefing.

15 **MR. HALLAM:** You chose to hide your head in
16 the sand. You knew he was a key witness. You were
17 given declarations for Mr. Supnik. You said he was
18 the attorney who handled all the trademark
19 applications and all the communications with the
20 examining attorney.

21 You were given that in the initial
22 stages of the litigation. And yet you chose not to
23 take his deposition or subpoena documents from him.

24 **MS. HOLLAND:** We're subpoenaing documents and
25 taking his deposition now, as is our right.

1 **BY MS. HOLLAND:**

2 **Q.** What we've marked as Exhibit 12 is the
3 Answer to the Amended Consolidated Petition to
4 Cancel, and it's signed by Paul D. Supnik.

5 Do you see that, Mr. Supnik?

6 **A.** Yes.

7 **Q.** Did you draft this document?

8 **A.** I don't believe so.

9 **Q.** Do you know who did?

10 **A.** My assumption is it was Mr. Hallam.

11 **Q.** But you know you didn't draft it?

12 **A.** No.

13 **Q.** Correct?

14 **A.** Correct.

15 **Q.** Okay. Well, you have just saved
16 yourself and me 20 pages of questions, I think, based
17 on this document. But let's look at the affirmative
18 defenses at the end, which begin on Page 25.

19 Okay. As one of the counsel of record
20 in this case, I would like for you to let me know
21 what facts you believe support the first affirmative
22 defense, which is that Petitioner's Amended Petition
23 to Cancel fails to state a claim upon which relief
24 can be granted.

25 **MR. HALLAM:** I am going to instruct the

Page 179

Page 181

1 **MR. HALLAM:** Well, you waived that right when
2 Mr. Mandell entered into that stipulation which was
3 confirmed in a pleading with the TTAB. And I've
4 heard nothing to explain that away.

5 **MS. HOLLAND:** If anything, the stipulation was
6 designed to avoid duplicative discovery.

7 This is not duplicative discovery.

8 This is a different witness, and possibly different
9 documents, and it will probably be easier just to
10 produce them since they're probably limited in volume
11 than it would be to brief it and wait for a ruling.

12 **MR. HALLAM:** I think we produced everything
13 either in the District Court litigation or today.

14 **MS. HOLLAND:** I have no way of verifying that,
15 Mr. Hallam, unless I have Mr. Supnik's file to
16 compare to the prior production. I have no way of
17 verifying that. I certainly can't do it with the
18 documents that you gave me today.

19 All right. I'm marking as Exhibit 12
20 the Answer to the Amended Consolidated Petition to
21 Cancel in this case.

22 (THE DOCUMENT REFERRED TO WAS
23 MARKED AS EXHIBIT 12 AND IS
24 BOUND UNDER SEPARATE COVER)

25 ///

1 witness not to answer, to the extent his answer will
2 disclose communications with me on the
3 attorney/client privilege basis, and advise the
4 witness that Ms. Holland is now asking a question
5 which, seems to me, is calling for your work product.

6 And all the rest of the questions that
7 she is going to ask you, based on my previous
8 experience with Ms. Holland, are going to all
9 likewise ask you for your work product; that is, your
10 opinion or view as to what facts and what legal
11 theories support this, that, or the other defenses.
12 All of which clearly call for your work product.

13 And on that basis, I would advise you
14 that you need not answer the question.

15 **MS. HOLLAND:** Okay. Well, I'm just going to
16 refer back briefly to the records. And then if
17 you're going to instruct him on all of these
18 defenses, we can shortcircuit this.

19 But in Exhibit 9 --

20 **MR. HALLAM:** Well, I advised him that... I
21 didn't instruct him not to answer. I instructed him
22 not to answer, to the extent that his answer would
23 disclose any communications with me on the
24 attorney/client privilege.

25 I advised him that I feel your

Page 182	Page 184
<p>1 question is calling for his work product, but that's</p> <p>2 his privilege to assert.</p> <p>3 MS. HOLLAND: Okay. Well, he's been</p> <p>4 identified as a witness with knowledge about the</p> <p>5 rules and guidelines in connection with the Patent &</p> <p>6 Trademark Office and the TTAB, specifically but not</p> <p>7 limited to the Trademark Manual of Examining</p> <p>8 Procedure of the TMEP, which will refute Petitioner's</p> <p>9 claims at issue.</p> <p>10 So that's a quote from your</p> <p>11 Registrant's initial disclosures, which we've marked</p> <p>12 as Exhibit 9.</p> <p>13 So Mr. Supnik's been designated as</p> <p>14 someone who is going to refute Petitioner's claims,</p> <p>15 and I just want to explore the scope of that</p> <p>16 testimony. And I was going to use the affirmative</p> <p>17 defenses as the framework to do that.</p> <p>18 MR. HALLAM: That's not what the initial</p> <p>19 disclosure says he's going to testify to. It doesn't</p> <p>20 say he's going to testify in support of each</p> <p>21 affirmative defense and provide all of the opinion</p> <p>22 testimony or factual evidence supporting affirmative</p> <p>23 defenses.</p> <p>24 It specifically says what he is going</p> <p>25 to testify to on those subject matters. And you're</p>	<p>1 And if you want to ask him on specific</p> <p>2 matters that he's been designated as testifying on</p> <p>3 and ask specific questions, then that's fine.</p> <p>4 But when you ask him to tell you all</p> <p>5 the facts supporting all the affirmative defenses,</p> <p>6 what you're doing is the same thing that you</p> <p>7 attempted to do with me in the District Court case,</p> <p>8 which is to delve into, in this case, Mr. Supnik's</p> <p>9 opinions, legal understanding, or his opinions and</p> <p>10 conclusions with respect to affirmative defenses.</p> <p>11 And to ask it in a catch-all way, just</p> <p>12 asking him to dump all of his work product onto the</p> <p>13 table, and I don't think he should do that. I would</p> <p>14 certainly advise him not to do that.</p> <p>15 If you want to ask him specific</p> <p>16 questions, again, about specific issues that are</p> <p>17 related to the applications and the issues in this</p> <p>18 proceeding, please do so.</p> <p>19 But not in a catch-all: Give me all</p> <p>20 of your opinions and conclusions as a lawyer with</p> <p>21 respect to an affirmative defense. That's not</p> <p>22 appropriate.</p> <p>23 MS. HOLLAND: Okay. So we've got our</p> <p>24 respective positions. We disagree. Et cetera. I'll</p> <p>25 just ask some questions and see how far we get.</p>
Page 183	Page 185
<p>1 more than welcome, as I think you have been, to ask</p> <p>2 him questions pertaining to those specific subject</p> <p>3 matters and specific questions.</p> <p>4 But when you just ask him in general:</p> <p>5 "Give me all the facts supporting the second</p> <p>6 affirmative defense," you are asking counsel of</p> <p>7 record in this petition to provide you with their</p> <p>8 work product.</p> <p>9 MS. HOLLAND: All right. I'll ask my</p> <p>10 questions and you can object or instruct, as is your</p> <p>11 right, and we'll disagree where we need to.</p> <p>12 But you've designated him as someone</p> <p>13 who is going to refute our claims, and I need to</p> <p>14 explore the scope of the testimony that he's going to</p> <p>15 provide on that issue.</p> <p>16 If you want to withdraw that</p> <p>17 designation, that's something that we can consider.</p> <p>18 But I need to know what he's going to testify about.</p> <p>19 MR. HALLAM: Again, the disclosure does not</p> <p>20 say and you cannot show me where it says that he is</p> <p>21 going to provide testimony to support all of our</p> <p>22 affirmative defenses.</p> <p>23 MS. HOLLAND: It didn't say that.</p> <p>24 MR. HALLAM: No, it doesn't. It says he is</p> <p>25 going to testify on specific matters.</p>	<p>1 Q. The first affirmative defense is:</p> <p>2 "Petitioner's Amended Petition to Cancel fails to</p> <p>3 state a claim upon which relief can be granted."</p> <p>4 Do you see that?</p> <p>5 A. Yes.</p> <p>6 Q. And this is, again, on the answer that</p> <p>7 you signed, right?</p> <p>8 A. Yes.</p> <p>9 Q. Do you have any factual information to</p> <p>10 support that affirmative defense?</p> <p>11 And for all of these questions, please</p> <p>12 exclude attorney/client privilege or work product.</p> <p>13 MR. HALLAM: Again, I would instruct you, to</p> <p>14 the extent that your answer would disclose any</p> <p>15 communications with me and based on attorney/client</p> <p>16 privilege.</p> <p>17 And I would advise you, with respect</p> <p>18 to the question in general, that it clearly calls for</p> <p>19 your work product, and it is your determination</p> <p>20 whether or not to disclose your work product. But</p> <p>21 you need not.</p> <p>22 THE WITNESS: Well, I think it's a two part.</p> <p>23 First, on advice of Counsel, I will</p> <p>24 not disclose work product in responding to this.</p> <p>25 Second, I don't even have, clearly in</p>

Page 186

1 my mind, Petitioner's petition to cancel at the
2 present time.
3 So it's a little difficult for me to
4 respond, even if I was not disclosing work product.
5 **MS. HOLLAND:** Okay. Well, I only marked the
6 answer because it actually repeats the whole petition
7 to cancel verbatim.
8 But I'll mark as Exhibit 13 the
9 Amended Petition to Cancel, just for clarify.
10 (THE DOCUMENT REFERRED TO WAS
11 MARKED AS EXHIBIT 13 AND IS
12 BOUND UNDER SEPARATE COVER)
13 **THE WITNESS:** Well...
14 **MS. HOLLAND:** So now you have the Amended
15 Petition to Cancel in front of you. I know you
16 haven't read the whole thing, because not enough time
17 has elapsed for you to do that.
18 **Q.** Do you have any facts supporting the
19 first affirmative defense?
20 **MR. HALLAM:** Again, I'm going to restate my
21 objection and my instruction and my advice.
22 Asking that question is not asking
23 Mr. Supnik for him to testify as to facts on which he
24 is a percipient witness. And that is the only basis
25 on which Mr. Supnik is here before us today.

Page 187

1 You're asking him as a lawyer who is
2 co-counsel in this petition or in opposition to this
3 petition to give all of his legal theories and
4 opinions, and the facts supporting those legal
5 theories and opinions that support the affirmative
6 defenses.
7 And that is wholly inappropriate. It
8 has nothing to do with specific questions of a
9 percipient witness. You're just trying to pry into
10 the legal opinions and conclusions of counsel of
11 record.
12 And you know, as well as I do, that
13 that is not appropriate.
14 And I would advise Mr. Supnik that it
15 is certainly within his prerogative to assert the
16 work product privilege and not to answer those types
17 of questions.
18 **BY MS. HOLLAND:**
19 **Q.** Are you refusing to provide the facts
20 supporting the first affirmative defense?
21 **A.** I am refusing to disclose work
22 product.
23 **Q.** So you're refusing to answer my
24 question?
25 **A.** That particular question, I am

Page 188

1 refusing to answer.
2 **Q.** Okay. The second affirmative defense
3 alleges that Petitioner, my client, lacks standing
4 under applicable provisions of the Lanham Act as it
5 lacks a real interest in the outcome of this
6 proceeding and a reasonable belief of damage,
7 et cetera.
8 Did you draft that language?
9 **A.** I don't believe so.
10 **Q.** Do you have any understanding of what
11 it means to have standing to assert a cancellation
12 claim in the trademark trial and appeal board?
13 **MR. HALLAM:** Same objection. Same instruction
14 and advice. It clearly calls for work product, and
15 nothing more.
16 **THE WITNESS:** That's a foundational question.
17 I'll answer it.
18 And, in some situations, probably.
19 **MS. HOLLAND:** Okay.
20 **Q.** What is your understanding of the
21 elements of standing for asserting a cancellation
22 claim?
23 **MR. HALLAM:** Same objection, instruction, and
24 advice.
25 You need not answer it if you don't

Page 189

1 care to disclose your work product.
2 **THE WITNESS:** I will not answer.
3 **BY MS. HOLLAND:**
4 **Q.** On the grounds of work product?
5 **A.** Work product. Yes.
6 **Q.** All right. And the third affirmative
7 defense refers to Federal Rules of Civil Procedure
8 9(b) and the Bose decision.
9 And it states that Petitioner's
10 cancellation claims based on alleged fraud fail to
11 set forth with sufficient particularity allegations
12 of fraud and mistake and special damages.
13 **A.** The same response.
14 **Q.** Same response of no answer?
15 **A.** That's correct.
16 **Q.** All right. Again, based on work
17 product and attorney/client privileges?
18 **A.** Yes.
19 **Q.** Can we agree that your response would
20 be the same, and the same refusal to answer, as to
21 the fourth, fifth, sixth, seventh, eighth and
22 ninth affirmative defenses?
23 **A.** Yes.
24 **MR. HALLAM:** If you asked him the same kind of
25 general question: What facts support that

Page 190

1 affirmative defense?

2 Or if you asked him specific questions
3 calling for his percipient knowledge relating to any
4 of these affirmative defenses. That's the
5 distinction I'm trying to get across here.

6 **MS. HOLLAND:** The witness said "Yes," and I'm
7 trying to shortcircuit this.

8 I've asked the question three or four
9 different ways. I get the same diatribe from you,
10 the same speaking objections that I've asked you not
11 to keep making.

12 **MR. HALLAM:** And I've asked you not to ask
13 absurd questions calling for work product, but you
14 continue to do it, even though you sat there at the
15 table of the deposition of Larry Sutton and made the
16 work product objection and instruction 147 times.

17 You sit here now, before me, and you
18 continue to ask questions calling not for any
19 percipient testimony, but for the work product of the
20 co-counsel in the case.

21 So, you know, don't tell me what
22 you've asked me not to do. I've asked you repeatedly
23 not to do that. But you insist.

24 I'm just trying to make it clear for
25 the record, my objections and my instructions are not

Page 192

1 And you have spent the last eight
2 hours delving in to those specific questions where
3 the witness has percipient knowledge. And we have no
4 objection to that.

5 But it's where you just choose to ask
6 him questions as the counsel of record in this
7 proceeding as to what, all facts and legal theories,
8 he has that support that affirmative defense.

9 That's not asking for percipient
10 testimony.

11 And really, break them down and go
12 through the allegations. But I think that's what
13 you've been doing the last eight hours. And ask him
14 where he was involved. Where he has percipient
15 testimony and firsthand knowledge. Not his theories.

16 **MS. HOLLAND:** I didn't ask him his theories.

17 And we haven't been here for eight
18 hours. We started after 10:00 o'clock. We took an
19 hour lunch break. And it's only 4:30 right now,
20 so...

21 **MR. HALLAM:** Well, I got here at 8:59, and I
22 have proof of that. My parking ticket.

23 **MS. HOLLAND:** So...

24 **MR. HALLAM:** And my client was here already,
25 waiting for me, so...

Page 191

1 the same. I don't have that objection or instruction
2 or advice if you were to ask specific questions
3 calling for this witness' percipient testimony; that
4 is, testimony about facts that he has firsthand
5 knowledge of.

6 But when you ask him to give you all
7 the theories that his client puts forth in support of
8 an affirmative defense, that's clearly work product
9 and not percipient testimony or anything on which you
10 have a right to inquire.

11 **MS. HOLLAND:** I think you've designated him as
12 a person with knowledge about our compliance with
13 rules and guidelines.

14 He's certainly designated with respect
15 to refuting our allegations of fraud, and I'm now
16 going affirmative defense by affirmative defense to
17 identify any facts that he may know and may be
18 testifying to, and you're not allowing him to answer.

19 And it's not the way I'm asking the
20 questions, Mr. Hallam, it's that you don't --

21 **MR. HALLAM:** No, it is. It is, Counsel.

22 **MS. HOLLAND:** -- want me to explore this area.

23 **MR. HALLAM:** You were permitted to ask him
24 specific questions about specific allegations of
25 fraud.

Page 193

1 **MS. HOLLAND:** Right. But the testimony has
2 been less than six hours. And the delay at the
3 beginning was because you provided documents that I
4 wanted to be able to copy, so we could move this
5 thing as quickly as possible.

6 **Q.** Do you have an understanding of the
7 equitable doctrine of unclean hands?

8 **MR. HALLAM:** Objection; calls for work
9 product, and I would advise you you need not give
10 your opinion or conclusions on that legal subject.

11 **THE WITNESS:** I decline to respond, on the
12 ground of work product.

13 **BY MS. HOLLAND:**

14 **Q.** You understand that part of the
15 petition to cancel is based on allegations that the
16 marks were not in continuous use and have been
17 abandoned.

18 Are you familiar with those
19 allegations?

20 **A.** Vaguely.

21 **Q.** Do you have an understanding of what
22 it means to abandon a trademark, in the legal sense?

23 **MR. HALLAM:** Again, I would state the same
24 objection, and advise you that you need not disclose
25 your work product if you don't care to.

Page 194

1 THE WITNESS: I will abide by that.
2 BY MS. HOLLAND:
3 Q. And you're not going to answer that
4 question?
5 A. That's right.
6 MR. HALLAM: If you want to ask him that
7 question reflecting his state of mind at the time
8 that he filed something, so it's percipient
9 knowledge, please...
10 MS. HOLLAND: I think --
11 MR. HALLAM: That's what we're here for.
12 MS. HOLLAND: I think I want to ask the
13 question I'm asking.
14 MR. HALLAM: And I'm going to continue to
15 state the objections where they're appropriate.
16 But I do want the record to be clear,
17 we have no problem with you asking him questions
18 about his state of mind when he filed those
19 applications and when he prosecuted those
20 applications, and even where they involve legal
21 concepts.
22 Because that's his percipient
23 knowledge that's relevant to these proceedings. Not
24 his opinions as co-counsel in defending this against
25 this cancellation petition.

Page 195

1 BY MS. HOLLAND:
2 Q. Are you aware that Registrant has
3 alleged that Petitioner, my client, has made
4 knowingly false assertions and contradictory
5 allegations regarding Registrant's date of first use
6 in connection with the sale of DVDs?
7 MR. HALLAM: Say that again. I'm sorry.
8 BY MS. HOLLAND:
9 Q. Are you aware that the Registrant,
10 Cloudstreet/Roxbury, claims that my client,
11 Penthouse, has made knowingly false statements about
12 the date of first use in connection with the sale of
13 ROUTE 66 DVDs? Are you aware that Roxbury alleges
14 that?
15 A. No.
16 MS. HOLLAND: Let me just finish up on the
17 rest of these.
18 I'm going to assume, based on your
19 answer earlier, that any further questions about the
20 affirmative defenses are going to result in
21 instructions, so I'll move on to some other
22 questions.
23 MR. HALLAM: Only if they're not specific
24 questions calling for this witness' percipient
25 firsthand knowledge rather than his opinions or

Page 196

1 conclusions as a lawyer.
2 MS. HOLLAND: I think we've got a record on
3 that.
4 Q. Just to wrap up, do you have any
5 personal knowledge that Roxbury or Cloudstreet
6 produced a motion picture film series, under the mark
7 ROUTE 66, as of May 22nd, 2007?
8 A. I'm not aware that Cloudstreet
9 produced a television film series other than the
10 existing television film series from the '60s.
11 Q. Okay. And do you have any personal
12 knowledge that Roxbury or Cloudstreet produced a
13 motion picture on film, under the ROUTE 66 mark, as
14 of May 22nd, 2007?
15 A. Say that again.
16 Q. Do you have any personal knowledge
17 that Roxbury or Cloudstreet produced a motion picture
18 on film, under the ROUTE 66 mark, as of May 22nd,
19 2007?
20 MR. HALLAM: Objection; asked and answered.
21 THE WITNESS: The answer is: No.
22 BY MS. HOLLAND:
23 Q. Do you have any personal knowledge
24 that Roxbury or Cloudstreet was using ROUTE 66 on
25 DVDs as of July 14th, 2006?

Page 197

1 A. I don't recall specifically the date,
2 but my understanding was that they were using the
3 mark in connection with DVDs somewhere in that time
4 frame. But I'm not sure what it is.
5 Q. And your understanding is based on
6 what?
7 A. Communications with Mr. Hallam and
8 probably the e-mails that we've seen here.
9 Q. Which were also communications from
10 Mr. Hallam, correct?
11 A. Yes.
12 Q. Does the ongoing TV program
13 registration rely on any other television program
14 other than the 116 episodes of the ROUTE 66
15 television series that first aired in approximately
16 1960?
17 A. Not to my knowledge.
18 Q. Okay. Do you have any personal
19 knowledge that the ROUTE 66 television show was being
20 aired as of July 6, 2005?
21 MR. HALLAM: Was being aired?
22 MS. HOLLAND: Yes.
23 THE WITNESS: Telephone conversations with
24 Mr. Hallam gave me the impression that somewhere it
25 was.

Page 198	Page 200
<p>1 MS. HOLLAND: Okay.</p> <p>2 Q. But other than the information you</p> <p>3 received from Mr. Hallam, did you have any personal</p> <p>4 knowledge?</p> <p>5 A. No.</p> <p>6 MS. HOLLAND: All right. Let me just take a</p> <p>7 five-minute break. I'm probably finished.</p> <p>8 (WHEREUPON A RECESS WAS HELD</p> <p>9 FROM 4:40 P.M. TO 4:49 P.M.)</p> <p>10 MS. HOLLAND: Back on the record.</p> <p>11 Our discovery cutoff is coming up in</p> <p>12 June, so what I'll propose with respect to this</p> <p>13 transcript is we'll order an expedited copy. And our</p> <p>14 court reporter has told me she can get that done by</p> <p>15 Friday.</p> <p>16 And then we would like to have a</p> <p>17 14-day turnaround on that, if that's possible,</p> <p>18 instead of a 30-day turnaround.</p> <p>19 Would that be okay with you guys?</p> <p>20 MR. HALLAM: I don't know. Can I confer with</p> <p>21 my client and get back to you on that? I just don't</p> <p>22 know with his time and my time.</p> <p>23 MS. HOLLAND: Yes.</p> <p>24 THE WITNESS: Oh, you mean in my reviewing it?</p> <p>25 MS. HOLLAND: Yes, in your reviewing it. If</p>	<p>1 Mr. Supnik so that he can go on his way.</p> <p>2 MS. HOLLAND: Okay.</p> <p>3 MR. HALLAM: And we won't take any more of his</p> <p>4 time.</p> <p>5 MS. HOLLAND: That's fine.</p> <p>6 And I will then ask you for</p> <p>7 Mr. Garland's address. We have not been able to</p> <p>8 locate him, and we need to speak with him.</p> <p>9 MR. HALLAM: And there is a lot of discovery</p> <p>10 issues we have. First and foremost, the stipulation</p> <p>11 of counsel, as we know it.</p> <p>12 MS. HOLLAND: Okay. Cathay, did you speak</p> <p>13 with Floyd?</p> <p>14 MS. SMITH: I did. We are all good in</p> <p>15 Chicago.</p> <p>16 MS. HOLLAND: Okay. We're all good in</p> <p>17 Chicago.</p> <p>18 So I'm reserving the right to continue</p> <p>19 this deposition and ask additional questions when I</p> <p>20 get the documents from your files, Mr. Supnik.</p> <p>21 I'm concluding it for today. I'm</p> <p>22 leaving it open. I think we still have time on the</p> <p>23 seven hours, and because the documents aren't here</p> <p>24 today, we can't conclude it in one day.</p> <p>25 But if we need more time than that,</p>
Page 199	Page 201
<p>1 we get you the --</p> <p>2 MR. HALLAM: Let's just you and I talk about</p> <p>3 that later.</p> <p>4 MS. HOLLAND: Okay. We'll table that for a</p> <p>5 moment.</p> <p>6 MR. HALLAM: There's going to be a lot of</p> <p>7 depositions taken in this case.</p> <p>8 MS. HOLLAND: And that's my other question.</p> <p>9 We have two depositions noticed for next week,</p> <p>10 Cloudstreet and yours, Mr. Hallam.</p> <p>11 Are you planning to appear for those?</p> <p>12 The 25th and 26th?</p> <p>13 MR. HALLAM: I'm not prepared to take up the</p> <p>14 reporter's time to talk about this on the record, but</p> <p>15 I'll be happy to talk to you about it off the record</p> <p>16 and after the deposition is concluded.</p> <p>17 MS. HOLLAND: Oh, we can go off the record</p> <p>18 now.</p> <p>19 MR. HALLAM: I don't want to take Mr. Supnik's</p> <p>20 time for that.</p> <p>21 MS. HOLLAND: I just need an answer today.</p> <p>22 MR. HALLAM: Okay.</p> <p>23 MS. HOLLAND: Can you give me an answer when</p> <p>24 we go off the record today?</p> <p>25 MR. HALLAM: Yes. After we have finished with</p>	<p>1 we'll make that part of our request for relief to the</p> <p>2 TTAB or the District Court. Wherever we need to go</p> <p>3 and file that motion to compel.</p> <p>4 And with that, I have requested that</p> <p>5 we agree to an accelerated review time for the</p> <p>6 transcript, since the discovery cutoff date is in</p> <p>7 June.</p> <p>8 MR. HALLAM: First of all, I do have some</p> <p>9 questions.</p> <p>10 MS. HOLLAND: Oh, you have questions? All</p> <p>11 right.</p> <p>12 MR. HALLAM: Yes, I do.</p> <p>13 And there will be very few, based on</p> <p>14 my understanding that in order to memorialize the</p> <p>15 testimony for presentation at the trial with the</p> <p>16 TTAB, we have to do this all over again, at some</p> <p>17 point. That is, take Mr. Supnik's deposition and ask</p> <p>18 him questions.</p> <p>19 But based upon that understanding, I</p> <p>20 only have a very few questions to, I think, address</p> <p>21 some issues on which there may have been some</p> <p>22 confusion during the course of this deposition today.</p> <p>23 ///</p> <p>24 ///</p> <p>25 ///</p>

Page 202

EXAMINATION

BY MR. HALLAM:

Q. Mr. Supnik, I would like you to look at what's been previously marked as Exhibit 2, which is your declaration in Support of Plaintiff's Motion for Summary Judgment, filed in the District Court proceeding.

And specifically, the exhibit which is attached thereto and is identified as Exhibit 1 to your declaration. And it bears the numbers in the upper right-hand corner of the page, 13 of 55 through page -- what does that say -- 19 of 55.

Can you tell us what this document which is Exhibit 1 within Exhibit 2 is?

A. Exhibit 1 is called an amendment to alleged use. Which is something that you would file to prove to the trademark office that the mark has actually been in use.

Q. And would you look at the third page, which says Page 15 of 55 to your declaration.

A. Yes.

Q. Can you tell, from anything on this page, when this document was submitted to the PTO?

A. Well, let's see. It's between

Page 203

July 14, 2006 and July 17, 2006.

But let me see if I can... Okay. Transmission date is July 14, 2006.

Q. Okay. And if you would, please, look at Page 18 of 55 to your declaration, which is Exhibit 2.

A. Yes.

Q. Can you tell us what this is?

A. It is a DVD packaging and insert. And that is the thing that goes between the plastic on the outside of the DVD box, and it's inserted, and it basically tells you what is inside, and it's essentially the packaging. Exterior packaging.

Q. And did you submit those pages, 18 and 19 of 55, as specimens of use for this amendment to alleged use?

A. Well, I don't have a specific recollection of submitting two copies of this. Because there is a Page 18 and 19.

But based on the amendment to alleged use, it essentially refreshes my recollection that I must have submitted a JPEG of this particular image to the trademark office.

Q. And what did you understand that this image represented, as far as a specimen of use?

Page 204

A. It was proof that the mark was used in connection with the sale of DVDs using the mark ROUTE 66.

Q. And do you recall receiving an actual packaged DVD that had this artwork on it?

A. I know I have two DVDs with packaging. Now, if those DVDs are the same one, yes, unless there was a subsequent DVD.

I don't recall.

Q. All right. And when you submitted this as a specimen of use in connection with the amendment to alleged use for the Class 9 registration, did you understand that this was a product or represented a specimen of a product that was first sold in 2005?

MS. HOLLAND: Objection; leading. Lacks foundation. Assumes facts.

BY MR. HALLAM:

Q. Well, if you would look at Page 18 of 55, and on the left side, in the bottom, where it says "ROXBURY ENTERTAINMENT COPYRIGHT 2005," do you remember seeing that at the time you submitted this specimen of use?

MS. HOLLAND: Objection; leading. Assumes facts.

Page 205

THE WITNESS: I don't have a specific recollection of looking at that copyright note. But I would have been surprised if I didn't.

I mean, when I get a specimen to send in to the trademark office, I usually look at it reasonably carefully. And there wasn't that much to it. So I would think that I would have seen that.

MR. HALLAM: Okay.

Q. And when you prepared the application for Class 41, television services for the ROUTE 66 mark, it contained certain allegations of prior use of the mark in connection with television services?

MS. HOLLAND: Objection; leading. Assumes facts. Lacks foundation.

THE WITNESS: I didn't understand what the question is.

MR. HALLAM: Okay.

Q. Do you recall being asked questions by Ms. Holland about whether the mark, ROUTE 66, was in continuous use in the 1960s and '70s in connection with the Class 41 application in television services?

A. Yes.

Q. Did you have an understanding -- any understanding -- at the time that you submitted the application for the Class 41 mark for ROUTE 66 as to

Page 206

Page 208

1 whether there had been continuous use since 1960?

2 A. I don't think it mattered so much.

3 MS. HOLLAND: Move to strike; nonresponsive.

4 BY MR. HALLAM:

5 Q. Was it your opinion or your belief,
6 when you submitted the application for the Class 41
7 television services mark, that whether or not there
8 had been continuous use was material or immaterial to
9 the PTO in issuing the mark?

10 MS. HOLLAND: Leading. Calls for an expert
11 opinion. Assumes facts.

12 THE WITNESS: My understanding was that the
13 application required use. But it didn't require
14 continuous use from the date of first use alleged in
15 the application.

16 It's not a basis upon which the office
17 would grant or not grant an application.

18 BY MR. HALLAM:

19 Q. And, your understanding at that time,
20 what was the material basis with respect to a date of
21 use or continuous use?

22 MS. HOLLAND: Leading. Calls for a legal
23 conclusion. Calls for an expert opinion. Assumes
24 facts.

25 THE WITNESS: My understanding is that the

1 conclusion and calls for an expert opinion.

2 MR. HALLAM: I'm just asking you for your
3 belief at the time that you submitted or that you
4 prepared the application.

5 THE WITNESS: At the time, my sense was that
6 the overall collection of facts, whatever they might
7 be, was sufficient to file an application for
8 Class 41, based on actual use.

9 BY MR. HALLAM:

10 Q. And at the time that you filed the
11 application for the Class 41 mark for television
12 services, did you have a belief or opinion as to
13 whether abandonment of the mark or potential
14 abandonment of the mark in the 1970s or '80s was a
15 material consideration to the PTO in deciding whether
16 to issue that registration?

17 MS. HOLLAND: Leading. Calls for a legal
18 conclusion.

19 THE WITNESS: Well, my sense was that there
20 were several aspects to that.

21 First, if there was an abandonment --
22 and I don't think there was -- if there was an
23 abandonment, as long as the mark was being used prior
24 to the filing of the application, that would be okay.
25 And that was my sense of the situation.

Page 207

Page 209

1 mark needed to have some sort of use somewhat around
2 the time that the application was filed.

3 BY MR. HALLAM:

4 Q. And was it your understanding at the
5 time the application was filed for the Class 41 mark
6 for television services that there was use at or
7 before the time the application was submitted?

8 MS. HOLLAND: Leading. Calls for a legal
9 conclusion.

10 THE WITNESS: Well, my understanding based on
11 my communication with you is that the mark had been
12 in use, based on what I understood.

13 And I think I had questioned you on
14 this. That the mark had been used in part based on
15 the fact that there was international licensing that
16 had been going on.

17 And that the mark shows it had been
18 distributed or, let's say, had been aired at various
19 points in time after the 1960 date.

20 BY MR. HALLAM:

21 Q. And did you have a belief or opinion
22 at that time as to whether that was the material
23 consideration for the PTO in issuing or not issuing
24 that registration?

25 MS. HOLLAND: Leading. Calls for a legal

1 I don't think that there was an
2 abandonment, because I think as I mentioned before,
3 we've got an iconic television series. Frankly, you
4 know, one of the top -- probably, at least in my
5 mind -- one of the top four or five television series
6 of the era; right up there with Twilight Zone and
7 Hitchcock.

8 It was a really significant television
9 series. And the residual goodwill of that just
10 doesn't disappear.

11 And my sense also is that that
12 goodwill follows the owner of the series. The
13 copyright and the series. That's where the goodwill
14 resides.

15 So that's my sense of that. That the
16 mark was existing at the time the application was
17 filed.

18 MR. HALLAM: I have no further questions,
19 based on my understanding that, as I said, we will
20 have to do this all over again, to obtain
21 Mr. Supnik's testimony for use at the trial in this
22 matter.

23 MS. HOLLAND: Okay. And I'm not going to
24 follow up on those questions.

25 I've already stated that I just am

Page 210

1 leaving the deposition open pending the resolution of
2 the issues associated with the document production,
3 and the instructions not to answer various questions
4 during my questioning that I think we're entitled to
5 answers to.
6 And then I'll reiterate my request
7 that we agree to an expedited review of the
8 transcript. And I'm proposing a 14-day turnaround,
9 based on a transcript being prepared by Friday.
10 Is that acceptable to you?
11 **MR. HALLAM:** Well, since you insisted on doing
12 it on the record, and I want to do it off the record,
13 after Mr. Supnik is done...
14 **MS. HOLLAND:** I thought you needed to speak
15 with him.
16 I'm asking both of you, does 14 days
17 work? If it doesn't, we can maybe agree to something
18 else.
19 **MR. HALLAM:** What is the rush, from your
20 standpoint?
21 **MS. HOLLAND:** We have an order. I'll give you
22 a copy. I have an extra copy.
23 **MR. HALLAM:** That's okay.
24 **MS. HOLLAND:** It's just that the discovery
25 cutoff date is June 10th. And since we need to make

Page 211

1 a motion, we wanted to get the transcript finalized.
2 And we'll make a motion with the
3 transcript as it is, but we wanted to get it
4 finalized sooner, so that we could get it on file and
5 not at the last minute with the TTAB.
6 **MR. HALLAM:** Well, I will take up your request
7 with Mr. Supnik and get back with you on that.
8 Obviously Mr. Supnik's time and restrictions are a
9 paramount concern, as well as mine.
10 **MS. HOLLAND:** Okay. Then, I guess, if we
11 can't agree to stipulate to what we do with the
12 transcript, that has ramifications for where the
13 original resides, and you'll probably have to review
14 it at the court report's office or whatever happens
15 when people can't stipulate.
16 **MR. HALLAM:** Well, you're holding that hostage
17 for us to agree? Which I said we will take into
18 consideration.
19 **MS. HOLLAND:** Usually people agree right now.
20 That's the thing. I don't know. You're here. Just
21 tell me how much time you need.
22 **MR. HALLAM:** We need to sit down and we need
23 to look at his calendar and my calendar over the next
24 14 days. And we will do that and get back to you
25 expeditiously.

Page 212

1 If you don't want to stipulate that
2 we're relieved of the obligation for Mr. Supnik to
3 come and look at it at the court reporter's office, I
4 guess I can't persuade you otherwise, but that
5 certainly won't help expedite things. That's for
6 sure.
7 **THE REPORTER:** Do you want to go off for a
8 minute?
9 **MS. HOLLAND:** Yes. Let's go off the record.
10 (DISCUSSION HELD OFF THE RECORD)
11 **MS. HOLLAND:** So we've agreed to a
12 stipulation:
13 The court reporter will be relieved of
14 her duties of retaining the original.
15 She will send the original to
16 Mr. Hallam's office. My office has requested a copy.
17 Mr. Hallam and Mr. Supnik will review
18 it and will endeavor to get us their changes, if any,
19 within 14 days.
20 If I don't hear from you guys with
21 changes or a request for an extension, we're going to
22 assume that the transcript is final and it can be
23 used for all purposes in this case.
24 **MR. HALLAM:** Well, I didn't agree to that
25 stipulation. I said we will try to get it done in

Page 213

1 14 days. But we're not stipulating that you can use
2 it if we don't.
3 And what I had suggested was you let
4 us talk about it and get back to you on whether we
5 can get it done in 14 days.
6 **MS. HOLLAND:** Okay. When will you be able to
7 get back to me on that?
8 **MR. HALLAM:** By tomorrow.
9 **MS. HOLLAND:** All right. That's fine. Okay.
10 And then I think I've preserved my
11 record on all of that. And with that, I am happy to
12 conclude the deposition for today.
13 Thank you very much.
14
15 (AT THE HOUR OF 5:12 P.M.
16 THE DEPOSITION WAS ADJOURNED
17 SINE DIE)
18
19
20
21
22
23
24
25

Page 214

1 DECLARATION

2
3
4
5
6
7 I HEREBY DECLARE I AM THE DEPONENT IN THE
8 WITHIN MATTER; THAT I HAVE READ THE FOREGOING
9 DEPOSITION AND KNOW THE CONTENTS THEREOF, AND I
10 DECLARE THAT THE SAME IS TRUE OF MY KNOWLEDGE EXCEPT
11 AS TO THE MATTERS WHICH ARE THEREIN STATED UPON MY
12 INFORMATION OF BELIEF, AND AS TO THOSE MATTERS, I
13 BELIEVE IT TO BE TRUE.

14 I DECLARE UNDER THE PENALTIES OF PERJURY OF
15 THE STATE OF CALIFORNIA THAT THE FOREGOING IS TRUE AND
16 CORRECT.

17 EXECUTED ON THE ____ DAY OF _____,
18 2011, AT _____, CALIFORNIA.

19
20
21
22
23 _____
24 PAUL D. SUPNIK
25

Page 215

1 I, KIMBERLY WILDISH, CSR NO. 8078, A
2 CERTIFIED SHORTHAND REPORTER FOR THE STATE OF
3 CALIFORNIA DO HEREBY CERTIFY:
4 THAT PRIOR TO BEING EXAMINED, THE WITNESS
5 NAMED IN THE FOREGOING DEPOSITION WAS BY ME DULY
6 SWORN TO TESTIFY THE TRUTH, THE WHOLE TRUTH,
7 AND NOTHING BUT THE TRUTH, PURSUANT TO SECTION NO. 2093
8 OF THE CODE OF CIVIL PROCEDURE;

9 THAT SAID DEPOSITION WAS TAKEN BEFORE ME AT
10 THE TIME AND PLACE THEREIN SET FORTH, AND WAS TAKEN
11 DOWN BY ME IN SHORTHAND AND THEREAFTER REDUCED TO
12 TYPEWRITING VIA COMPUTER-AIDED TRANSCRIPTION UNDER MY
13 DIRECTION;

14 I FURTHER CERTIFY THAT I AM NEITHER COUNSEL
15 FOR, NOR RELATED TO, ANY PARTY TO SAID ACTION, NOR IN
16 ANYWISE INTERESTED IN THE OUTCOME THEREOF;

17 IN WITNESS WHEREOF, I HAVE HEREUNTO
18 SUBSCRIBED MY NAME THIS 21ST DAY OF APRIL, 2011.

19
20
21
22 _____
23 KIMBERLY WILDISH
24 CSR NO. 8078
25

EXHIBIT I

Holland, Kristin L.

From: Smith, Cathay Y. N.
Sent: Thursday, April 07, 2011 8:31 AM
To: Kirk Hallam
Cc: Paul Supnik; Mandell, Floyd A.; Holland, Kristin L.
Subject: RE: Penthouse v. Cloudstreet, TTAB Cancellation No. 92049926: Subpoena to James Rosin
Attachments: Stipulation Between The Parties (3).DOC; DOC

Dear Kirk:

As discussed during our Rule 26(f) conference, our client agrees that any and all discovery used in the district court proceeding may be used in this cancellation proceeding. In that regard, please review and sign the attached draft stipulation that I sent to you on March 24, 2011 so that the parties' agreement may be officially noted in the TTAB, and so that the parties do not need to re-issue or re-notice discovery that they have already obtained in the district court action.

Additionally, thank you for confirming that you will be representing Mr. Rosin at his deposition. As you know, Mr. Rosin signed a declaration in the district court proceeding and has also been identified by your client in its initial disclosures in this proceeding on January 11, 2011 as having knowledge of "Registrant's continuous use of the mark as the title of the television service from the 1960s to the present; and the lack of abandonment of Registrant's mark." We do not believe you have any legitimate basis to prevent him from being subpoenaed in this case nor do we believe that you will be able to prevent him from being deposed. Accordingly, unless you provide us with agreeable alternative dates for Mr. Rosin's deposition, I will be at Hangle Aronchick Segal & Pudlin on April 13 at 1pm with a court reporter for Mr. Rosin's noticed deposition. If Mr. Rosin does not appear at his deposition, we will have no choice but to proceed against Mr. Rosin pursuant to Rule 45(e). Please pass this along to your client.

We look forward to hearing from you today, as I plan to finalize my flight and hotel reservations for Philadelphia by the end of the day.

Thank you -

Cathay

CATHAY Y. N. SMITH

Attorney

Katten Muchin Rosenman LLP

525 W. Monroe Street / Chicago, IL 60661-3693

p / (312) 902-5252 f / (312) 577-4506

cathay.smith@kattenlaw.com / www.kattenlaw.com

From: Kirk Hallam [mailto:kmhallam@aol.com]
Sent: Wednesday, April 06, 2011 11:35 PM
To: Smith, Cathay Y. N.
Cc: Paul Supnik; Mandell, Floyd A.; Holland, Kristin L.
Subject: Re: Penthouse v. Cloudstreet, TTAB Cancellation No. 92049926: Subpoena to James Rosin

Cathay,

I will be representing Mr. Rosin and intend to hold your client and Mr. Mandel to their agreement to limit discovery to that taken in the district court proceeding, with the exception of Mr. Supnik's deposition. I will pursue the formal procedures in this regard when I return to the office on Monday.

Regards
Kirk Hallam
Counsel for Roxbury Entertainment

Sent from my iPhone

On Apr 6, 2011, at 1:23 PM, "Smith, Cathay Y. N." <cathay.smith@kattenlaw.com> wrote:

Dear Paul:

Please let us know whether you and/or Kirk plan to attend the deposition of Mr. Rosin, currently scheduled for April 13, 2011 in Philadelphia, as we will need to enter your name(s) with security in the building. I plan to reach out to Mr. Rosin directly to confirm his attendance at his deposition unless you or Kirk are representing Mr. Rosin. If this is the case, please let me know ASAP.

Thank you -

Cathay

CATHAY Y. N. SMITH

Attorney

Katten Muchin Rosenman LLP

525 W. Monroe Street / Chicago, IL 60661-3693

p / (312) 902-5252 f / (312) 577-4506

cathay.smith@kattenlaw.com / www.kattenlaw.com

From: Cole, Shirley

Sent: Monday, March 28, 2011 5:02 PM

To: paul@supnik.com; kmhallam@aol.com

Cc: Mandell, Floyd A.; Holland, Kristin L.; Smith, Cathay Y. N.

Subject: Penthouse v. Cloudstreet, TTAB Cancellation No. 92049926: Subpoena to James Rosin

Counsel:

Attached please find a Subpoena to James Rosin (incl. Ex. A) in relation to the *Penthouse v. Cloudstreet* TTAB cancellation proceeding which was served on Mr. Rosin on March 26, 2011.

Regards,

SHIRLEY COLE

Secretary to Floyd A. Mandell, Kristin J. Achterhof, Carolyn M. Passen and Cathay Y.N. Smith

Katten Muchin Rosenman LLP

525 W. Monroe Street / Chicago, IL 60661-3693

=====

CIRCULAR 230 DISCLOSURE: Pursuant to Regulations Governing Practice Before the Internal Revenue Service, any tax advice contained herein is not intended or written to be used and cannot be used by a taxpayer for the purpose of avoiding tax penalties that may be imposed on the taxpayer.

=====

CONFIDENTIALITY NOTICE:

This electronic mail message and any attached files contain information intended for the exclusive use of the individual or entity to whom it is addressed and may contain information that is proprietary, privileged, confidential and/or exempt from disclosure under applicable law. If you are not the intended recipient, you are hereby notified that any viewing, copying, disclosure or distribution of this information may be subject to legal restriction or sanction. Please notify the sender, by electronic mail or telephone, of any unintended recipients and delete the original message without making any copies.

=====

NOTIFICATION: Katten Muchin Rosenman LLP is an Illinois limited liability partnership that has elected to be governed by the Illinois Uniform Partnership Act (1997).

=====

<3-24-11 Letter to Mr. James Rosin.PDF>

<Subpoena -- James Rosin.PDF>

<Exhibit A to J. Rosin Subpoena.pdf>

<Certificate of Service.pdf>

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

PENTHOUSE DIGITAL MEDIA)	
PRODUCTIONS INC.,)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92049926
)	
CLOUDSTREET, INC.)	
d/b/a ROXBURY ENTERTAINMENT,)	
)	
Registrant.)	

**STIPULATION CONCERNING
DISCOVERY EXCHANGED IN THE RELATED CIVIL ACTION**

In the matter of Cancellation No. 92049926 (the “Cancellation Proceeding”), Petitioner Penthouse Digital Media Productions Inc. (“Petitioner”) and Registrant Cloudstreet, Inc. dba Roxbury Entertainment (“Registrant”) hereby stipulate to the following:

1. Any discovery requests, including document requests, interrogatories, and requests to admit, served by any party in the related civil action between the parties entitled *Roxbury Entertainment v. Penthouse Media Group, Inc. et al.*, Case No. 2:08-cv-3872, in the Central District of California (hereinafter, the “Related Civil Action”), may be used in this Cancellation Proceeding as if such discovery had been served in this Cancellation Proceeding.

2. Any responses to discovery requests, including responses and objections to document requests, answers and objections to interrogatories, and responses and objections to requests to admit, served by any party and/or nonparty in the Related Civil Action may be used in this Cancellation Proceeding as if such responses to discovery requests had been served in this Cancellation Proceeding.

3. Any depositions taken in the Related Civil Action by any party, and any deposition testimony given by any party or nonparty in the Related Civil Action, may be used in this Cancellation Proceeding as if such depositions had been taken in this Cancellation Proceeding and as if such deposition testimony had been given in this Cancellation Proceeding.

4. Any objections to discovery made by any party in the Related Civil Action, and any rulings on any objections to discovery obtained by any party in the Related Civil Action, shall be preserved in this Cancellation Proceeding as if such objections or rulings had been made in this Cancellation Proceeding. Nothing in this paragraph shall be construed to imply that any such objections were substantively appropriate unless ruled upon in the Related Civil Action.

5. The parties enter into this Stipulation Concerning Discovery Exchanged In The Related Civil Action ("Stipulation") in the interest of judicial economy and efficiency and in order to avoid duplication of either party's efforts in discovery in this Cancellation Proceeding.

6. This Stipulation is without prejudice to any rights that either party may have to challenge the authenticity or admissibility of any discovery. However, the parties agree not to challenge the authenticity or admissibility of any discovery based on the argument that such discovery was originally obtained and/or given in the Related Civil Action.

Dated: March __, 2011

By: _____

Paul D. Supnik
Paul D. Supnik Law Office
9401 Wilshire Blvd, Suite 1250
Beverly Hills, CA 90212

Kirk M. Hallam
Law Offices of Kirk M. Hallam
201 Wilshire Boulevard, 2nd Floor
Santa Monica, California 90401
Tel: 310.393.4006
Fax: 310.393.4662
Email: kmhallam@aol.com

Attorneys for Registrant

By: _____

Floyd A. Mandell
Cathay Y. N. Smith
Katten Muchin Rosenman LLP
525 W. Monroe Street
Chicago, IL 60661-3693
Telephone: 312.902.5200
Facsimile: 312.902.1061

Kristin L. Holland
Katten Muchin Rosenman LLP
2029 Century Park East, Suite 2600
Los Angeles, CA 90067
Telephone: 310.788.4400
Facsimile: 310.788.4471

Attorneys for Petitioner